

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of Opus 12, Inc
Serial No. 88302916
Trademark: CARBON NEGATIVE
Filing Date: Feb. 15, 2019

RESPONSE TO OFFICE ACTION

COMES NOW, the Applicant Opus 12, Inc (hereinafter “Applicant”) and respectfully requests the Examining Attorney to withdraw the refusal to register the instant application on the grounds of Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); 37 C.F.R. §2.64(a), stating as follows:

**ARGUMENT IN SUPPORT OF REGISTRATION
Refusal under Section 2(e)(1) of the Trademark Act of 1946**

The Examining Attorney refused registration based upon a finding that the mark is merely descriptive of the Applicant’s Goods. Insofar as Applicant’s proposed mark is not merely descriptive of the Goods identified in the application, Applicant respectfully submits that there is no basis to maintain the instant refusal and that registration of the Applicant’s trademark is appropriate.

Matter that "merely describes" the goods or services on or in connection with which it is used is not registrable on the Principal Register. TMEP § 1209. As noted in *In re Abcor Development Corp.*, 588 F.2d 811, 813, 200 USPQ 215, 217 (CCPA 1978):

The major reasons for not protecting such marks are: (1) to prevent the owner of a mark from inhibiting competition in the sale of particular goods; and (2) to maintain freedom of the public to use the language involved, thus avoiding the possibility of harassing infringement suits by the registrant against others who use the mark when advertising or describing their own products.

However, to be refused registration on the Principal Register under §2(e)(1) of the Trademark Act (hereinafter “the Act”), 15 U.S.C. §1052(e)(1), a mark must be *merely descriptive* of the goods or services to which it relates. TMEP § 1209.01(b). A mark is considered merely descriptive only if, in its entirety, it describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods or

services. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987) (APPLE PIE held merely descriptive of potpourri); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986) (BED & BREAKFAST REGISTRY held merely descriptive of lodging reservations services); *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984) (MALE-P.A.P. TEST held merely descriptive of clinical pathological immunoassay testing services for detecting and monitoring prostatic cancer); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979) (COASTER-CARDS held merely descriptive of a coaster suitable for direct mailing).

The determination of whether or not a mark is merely descriptive must be made in relation to the goods or services for which registration is sought, not in the abstract. TMEP § 1209.01(b)(*emphasis added*). This requires consideration of the context in which the mark is used or intended to be used in connection with those goods or services, and the possible significance that the mark would have to the average purchaser of the goods or services in the marketplace. *Id.* See also *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985).

In determining whether a particular mark is merely descriptive of a product, a reviewer is tasked with considering the mark in its entirety, with a view toward “what the purchasing public would think when confronted with the mark as a whole.” *In re Hutchinson Technology Inc.* 852 F.2d 552, 552-54 (Fed. Cir. 1988). To the extent that there may be doubt as to whether applicant’s mark is merely descriptive or suggestive of its goods, an examining attorney should resolve any doubt in the applicant’s favor and publish the mark for opposition. *In re Morton-Norwich Products, Inc.* 209 USPQ 791 (TTAB 1981); *In re Gourmet Bakers Inc.*, 173 USPQ 565 (TTAB 1972).

Returning to the trademark at issue, in consideration of the above Applicant respectfully submits that the instant mark is suggestive of the Applicant’s Goods and not merely descriptive as originally contended by the Examining Attorney.

If a consumer must exercise “mature thought or follow a multi-stage reasoning process” to determine the characteristics of a product or service, the mark is suggestive and not descriptive. *In re*

Tennis in the Round, Inc. 199 USPQ 496, 498 (TTAB 1978) (“This association of applicant’s mark with the phrase ‘theater-in-the-round’ creates an incongruity...,” thus TENNIS IN THE ROUND is not merely descriptive of tennis facilities.). *See also, Blisscraft of Hollywood v. United Plastics Co.* 294 F.2d. 694, 131 USPQ 55 (2d. Cir. 1961) (POLY PITCHER not merely descriptive of polyethylene pitchers; suggestive of Molly Pitcher of Revolutionary time); *In re Colonial Stores, Inc.* 394 F.2d 549, 157 USPQ 382 (CCPA 1968) (SUGAR & SPICE not merely descriptive of bakery products; suggestive of nursery rhyme); *Douglas Laboratories Corp. v. Copper Tan, Inc.* 210 F.2d 453, 100 USPQ 237 (2d Cir. 1954), cert. denied 347 U.S. 968, 101 USPQ 505 (1954) (finding COPPERTONE for sun tan oil suggestive, not descriptive); *In re Realistic Co.* 440 F.2d 1393, 169 USPQ 610 (CCPA 1971) (finding CURV for permanent wave solution suggestive, not descriptive); and, *Colgate-Palmolive Co. v. House for Men, Inc.* 143 USPQ 159 (TTAB 1964) (finding RAPID- SHAVE for shaving cream suggestive, not descriptive).

In *Equine Technologies Inc. v. Equitechnology Inc.* 68 F.3d 542 (1st Cir. 1995), the court was required to determine whether the mark EQUINE TECHNOLOGIES was descriptive or suggestive when used in connection with high-tech hoof pads for horses. The court cited authorities indicating that the hallmark of the descriptive term is a specific identification of the marked good. *Id.* at 544. In holding the mark EQUINE TECHNOLOGIES to be correctly characterized as suggestive rather than descriptive, the court noted that while there is no dispute that the term “equine” is descriptive of horses, the question is whether the mark, in its entirety, is merely descriptive of the plaintiff’s product — hoof pads for horses. *Id.* at 545. In this case, the court found that the mark itself does not convey information about the plaintiff’s products or its intended consumers. Rather, it requires imagination to connect the term “Equine Technologies” to hoof care products in general, and to the plaintiff’s product in particular.

In *Ex Parte Club Aluminum Products Co.* 105 USPQ 44 (Commissioner 1955), the mark COOK-N-LOOK was held registrable for transparent glass covers for cooking utensils. The mark was somewhat suggestive of a property the goods might have, but like Applicant’s mark, did not describe the goods *per se*:

The mark is a compound word mark which describes what one who uses the covers can do, *i.e.* look into the utensil to see the cooking process, but this does not make the mark descriptive of the covers. The necessity for analysis removes it from the category of mere descriptiveness.

Id

In *Independent Nail & Packing Co. v. Stronghold Screw Products, Inc.* 205 F.2d 921, 925 (Cir. 1953), cert. denied 346 U.S. 491 (1953), the court held that STRONGHOLD as applied to ribbed nails was not descriptive, stating that:

Although the word ‘stronghold’ is suggestive of one of the attributes of plaintiff’s nail with the annular thread, it is not descriptive of a nail, let alone that type of nail. A person unaware of the particular product of the manufacturer, upon seeing or hearing the name ‘stronghold’ would find it virtually impossible to identify the product to which it might have been applied.

Id.

In *Worthington Foods, Inc. v. Kellogg Co.* 732 F. Supp. 1417, 1435 (S.D. Ohio 1990), the court found that a multi-stage reasoning process was necessary before a consumer could understand the message conveyed by the mark HEARTWISE, that is, food which is healthful for the heart. The court also noted that assuming HEARTWISE meant “wise for one’s heart,” it might refer to a large number of goods or services such as running shoes, a treadmill, a calorie counter, or an Ann Landers newspaper column. The court held that HEARTWISE was a suggestive rather than descriptive mark as the consumer could not directly cull a message concerning the healthful characteristics of the goods simply from looking at the mark.

A brief review of other suggestive marks helps clarify this dichotomy:

(1) SUGAR & SPICE for use on bakery products held to be suggestive not descriptive.

In re Colonial Stores, Inc. 394 F.2d 549, 157 USPQ 382 (CCPA 1968).

(2) 100 YEAR NITE-LITE for light with life expectancy of 500 years held to be suggestive not descriptive. *Donsky v. Bandwagon, Inc.* 193 USPQ 336 (D. Mass. 1976).

(3) TENNIS IN THE ROUND held not descriptive of tennis facilities. *In re Tennis in the Round, Inc.* 199 USPQ 496 (TTAB 1978).

(4) RAILROAD SALVAGE for sale of goods from bankruptcy liquidations and discontinued goods held to be suggestive. *Railroad Salvage of Conn., Inc. v. Railroad Salvage, Inc.* 561 F.Supp. 1014 (D.R.I. 1983).

(5) UNDERNEATH IT ALL for undergarment products held to be suggestive in *Maidenform, Inc. v. Munsingwear, Inc.* 195 USPQ 297 (SDNY 1977).

(6) CITIBANK for urban banking services held to be suggestive in *Citibank, N.A. v. Citibanc Group, Inc.* 724 F.2d 1540 (11th Cir. 1984).

(7) CHARRED KEG for bourbon whiskey held to be suggestive, even though bourbon is an American-type whiskey that is made in part by aging carried out in new charred oaken containers. *In re Majestic Distilling Co., Inc.* 164 USPQ 386 (CCPA 1970).

(8) LONGTONG for barbecue tongs held to be suggestive in *Ex parte Nixdorff Krein Mfg Co.*, 115 USPQ 362 (Comm. Pat. 1957).

(9) BRAKLEEN for a brake parts cleaner held to be suggestive and not descriptive in *C.J. Webb, Inc.* 182 USPQ 63 (TTAB 1974).

(10) DRI-FOOT held to be suggestive of foot deodorant in *In re Pennwalt Corp.* 173 USPQ 317 (TTAB 1972).

(11) CHEW ‘N CLEAN was held not to be descriptive of tooth powder in *In re Colgate-Palmolive Company* 160 USPQ 733 (CCPA 1969).

(12) COPPERTONE was found not to be descriptive of a suntan preparation in *Douglas Lab Corp. v. Copper Tan, Inc.* 210 F.2d 453, 100 USPQ 237 (2d Cir. 1954), cert denied 347 U.S. 968 (1954).

In the present case, the “mental link” between the trademark CARBON NEGATIVE and the Applicant’s Goods as identified in the application is neither immediate nor instantaneous.

Applicant’s Trademark is Suggestive Under the TTAB’s Three-Part Test

The Trademark Trial and Appeal Board has adopted a three-part test to help determine whether a mark is descriptive or suggestive:

- (1) The degree of imagination necessary to understand the product;
- (2) A competitor’s need to use the same terms; and
- (3) Competitors’ current use of the same or similar terms.

See No Nonsense Fashions, Inc. v. Consolidated Food Corp., 226 USPQ 502 (TTAB 1985).

(1) Degree of Imagination

Under the degree of imagination test, the greater the number of “imaginative steps” required for a consumer to arrive at a tolerably accurate or direct description of the product or service from the mark

itself, the more likely the term is accurately characterized as “suggestive” and not “merely descriptive”. *See Railroad Salvage of Connecticut, Inc. v. Railroad Salvage, Inc.*, 561 Fed. 1014 (DCRI 1983). Since there is no instantaneous connection as to the nature of the Goods provided by the Applicant, it is far more likely that the trademark is correctly deemed suggestive rather than descriptive. *See Stix Products, Inc. v United Merchants and Manufacturers, Inc.*, 295 Fed. Supp. 479 (SDNY 1968).

(2) Competitor’s Need to Use Applicant’s Trademark

Next, we consider Applicant’s competitor’s need to use Applicant’s Trademark. Provided that alternative wording exists this part of the test favors registration of the Applicant’s trademark. In the instant case, it is clear that Applicant’s competitors have numerous choices in regard to alternative language that can be used to identify their own respective Goods.

Specifically, Applicant’s competitors could use the following: C Counter, C Refusal. Accordingly, in consideration of this second factor, it is again far more likely that the trademark is accurately categorized as suggestive rather than descriptive.

(3) Competitor’s Current Use of Applicant’s Trademark

Finally, we consider Applicant’s actual competitor’s current use of the trademark at issue. There is little evidence of such use. Moreover, the use, if any, that has been provided, should not be deemed persuasive as those competitors are, in the Applicant’s view, making unauthorized use and potentially infringing upon Applicant’s trademark and may soon have to answer to Applicant for these transgressions.

That being said, it is requested that the evidence provided, limited in nature, and most likely simply of infringing activity, should also not be considered to support a finding of descriptiveness.

Combined Terms Evoke a Non-Descriptive Commercial Impression

When two or more descriptive terms are combined to create a new, non-descriptive commercial impression, the combined mark is not considered descriptive for the purposes of analysis under Section 2(e)(1) of the Act.

In the instant case, Applicant's Trademark is as follows: CARBON NEGATIVE. Although arguably descriptive in-and-of-themselves, when combined to create Applicant's Trademark the terms evoke a new, non-descriptive commercial impression, in that true.

Wherefore, following from the above it is submitted that this new commercial impression created by the combined terms is additional evidence that the Applicant's Trademark is correctly characterized as suggestive and not merely descriptive as has been contended.

CONCLUSION

In sum, applying the Trademark Trial and Appeal Board's tests and relevant standards to the refusal at hand, the relevant consuming public would not form an immediate impression of the features, functions, qualities or characteristics of the goods claimed by Applicant by mere sight of the trademark at issue. In view of the above arguments, Applicant believes that the proposed mark is entitled to registration on the Principal Register.

If, however, the Examining Attorney remains unsure, the Office is respectfully reminded that because of the thin line between suggestive and descriptive marks, it is the practice of the USPTO to resolve doubt in Applicant's favor and publish the mark for opposition. *See In re Morton-Norwich Products, Inc.* 209 USPQ 791 (TTAB 1981); and *In re Grand Metropolitan Foodservice Inc.* 30 USPQ2d 1974, 1976 (TTAB 1994).

WHEREFORE the Applicant Opus 12, Inc respectfully requests the Examining Attorney to reconsider the refusal under Section 2(e)(1) of the Trademark Act of 1946 and allow the publication of CARBON NEGATIVE on the Principal Register.

Respectfully submitted this 20th day of August 2019

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