

## REMARKS

### **I. Response to Applicant's Mark being Merely Descriptive – Section 2(e) Refusal**

#### **A. Applicant's Mark is not Merely Descriptive**

Applicant respectfully submits that for the reasons set forth below, Applicant's mark is not merely descriptive.

The question of whether or not a particular designation is merely descriptive must not be determined 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. *In re Bright-Crest, Ltd.*, 204 U.S.P.Q. 591 (TTAB 1979); *Q-Tips Inc. v. Johnson & Johnson*, 95 U.S.P.Q. 264 (D.N.J. 1952).

#### **B. Applicant's Applied for Mark is SL not SLIM LINE**

As a preliminary matter, Applicant would like to clarify that the applied for mark is SL only. Applicant is not applying for the word mark SLIM LINE. Applicant is already the owner of U.S. Registration No. 2,259,146 for the mark SLIM-LINE, which was registered on the Principle Register on July 6, 1999. In this regard, Applicant is only attempting to register the mark SL, and is not trying to re-register the terms SLIM LINE.

#### **C. SL is at Most Suggestive in Relation to the Applicant's Goods**

In order to be suggestive, a trademark as applied to the goods or services must require imagination, thought, or perception to reach a conclusion as to the nature thereof. Whether a particular designation is merely descriptive must be determined by considering the meaning it is likely to have in the context in which it is used and when encountered by prospective purchasers in the marketplace. *In re Abcor Development Corp.*, 200 U.S.P.Q. 215 (CCPA 1978). Furthermore, the Board has emphasized that an immediate idea must be forthwith conveyed in order for the mark to be descriptive. *R.J. Reynolds Tobacco Company v. Brown & Williamson Tobacco Corp.*, 226 U.S.P.Q. 169, 177 (TTAB 1985).

Under the well-accepted test for distinguishing between suggestive and merely descriptive marks, the mark must describe Applicant’s goods and services with particularity in order to be descriptive. *In re House Store Ltd.*, 221 U.S.P.Q. 92, 93 (TTAB 1983); *In re TMS Corporation of the Americas*, 200 U.S.P.Q. 57, 58 (TTAB 1978). In *House Store*, the TTAB reversed the refusal of the registration of the mark “The House Store” for retail store services in the field of furniture and housewares. The TTAB reasoned that the mark was “too broad to describe such services with immediacy and particularity and, consequently, should be viewed as suggestive rather than impermissibly descriptive.” *House Store*, 221 U.S.P.Q. at 93.

As was the situation in the case listed above, the SL wording of Applicant’s mark (even if viewed as an acronym for the terms “slim line”) is at most suggestive of a feature or aesthetic and/or functional attribute of Applicant’s goods. Along these lines, the SL mark does not immediately tell potential purchasers that Applicant’s goods are “*filtered shower heads*.” Rather, such mark may connote an aesthetic feature of Applicant’s goods, i.e., filtered shower heads with a slender profile. In the present instance, products used in connection with the applied for mark are filtered shower heads, however, the subject mark could just as easily be used in connection with a variety of goods, including *cordless beard trimmers* as shown in Exhibit A and *adult diapers* as shown in Exhibit B, or really any product that has a slim silhouette.

Along these lines, Applicant submits that there are already several marks on the Principle Register for “SLIM LINE” derivative marks for use in connection with a variety goods. An exemplary listing of these marks is highlighted below and attached as Exhibit C.

SLIMLINE	Reg. No. 2,069,650
SLIMLINE	Reg. No. 3,724,924
SLIMLINE	Reg. No. 4,298,437
SLIM LINE	Reg. No. 3,992,278
SLIM LINE	Reg. No. 4,858,640
SLIMLINE	Reg. No. 1,805,392

In view of the existing registrations highlighted above and additionally considering Applicant’s prior SLIM-LINE registration, it is apparent that to the average consumer, that the

neither term “SL” or “SLIM LINE” immediately conveys the proposed function and nature of Applicant’s goods, and is at most, only suggestive of the same.

Indeed, as to “SL” standing alone, Applicant also notes the common use of that designation in the automotive field, e.g., the widespread use of the “SL” designation by Mercedes-Benz in conjunction with a prescribed class of its vehicles. For these vehicles, “SL” is an acronym for “super light.” Applicant respectfully submits that it strains credibility to conclude that, based on the consideration of the totality of the disparate uses of “slim line” and “SL” in the existing marketplace as highlighted above, consumer would only view either of these as identifying Applicant’s “*filtered shower heads*.”

It is well established that suggestiveness is not a bar to registration on the Principal Register. Moreover, even the fact that persons in the trade are capable of analyzing the terms or recognizing its suggestion does not render the mark merely descriptive. *Audio Fidelity Inc., v. London Records Inc.*, 141 U.S.P.Q. 792 (CCPA 1964) (AUDIO FIDELITY not merely descriptive of phonographic records). Furthermore, the CCPA has held that a mark may even go so far as to possess a “descriptive connotation” that conveys an impression of goods or services. “The simple presence of that type of descriptive connotation, like the presence of suggestiveness, will not preclude registration where the mark is not merely descriptive of the goods.” *Coca Cola Company v. Seven-Up Company*, 182 U.S.P.Q. 207, 209 (CCPA 1974) (Uncola not merely descriptive of non-cola soft drinks); *Independent Nail Packaging Co. v. Stronghold Screw Products, Inc.*, 205 F.2d 921, 98 U.S.P.Q. 172 (7th Cir. 1953), *Cert. denied*, 346 U.S. 886 (1953) (STRONGHOLD not merely descriptive of nail products even though suggestive of one attribute of nail products).

In this case, the terms “SLIME LINE” may indeed have some connotation relative to Applicant’s goods, or at least to a greater degree than the applied for SL mark, but certainly do not merely describe such goods for the reasons highlighted above. As such, Applicant respectfully submits that the mark SL is at most arguably suggestive of Applicant’s goods.

**D. Any doubt about descriptiveness should be resolved in Applicant’s favor**

In addition, any doubt as to whether the present mark is merely descriptive must be resolved in Applicant’s favor according to controlling case law authority. *In re Rank Organisation Ltd.*, 222 U.S.P.Q. 324, 326 (TTAB 1984). *In re Noble Company*, 225 U.S.P.Q.

749, 750 (TTAB 1980) ([I]f there was any doubt about whether the term ... is merely descriptive ... that doubt should be resolved in favor of the Applicant); *In re Mobile Ray Inc.*, 224 U.S.P.Q. 247, 248 (TTAB 1984) (“[W]hen there is doubt in the matter, the doubt should be resolved in Applicant’s behalf and the mark should be published for opposition”).

The same should be true for this application.

## **II. Conclusion**

In summary, the refusal to register Applicant’s mark under Section 2(e) should be withdrawn based upon the fact that Applicant’s mark is not merely descriptive of the goods offered by Applicant. To the extent the Examining Attorney has any questions, requires additional information, or has any suggestions to expedite the resolution of any outstanding matters that may exist, the Examining Attorney is invited to contact Applicant’s counsel.

# EXHIBIT A

# ANDIS PROFESSIONAL SLIMLINE PRO LI CORDLESS CLIPPER TRIMMER CLIPPER #32400 by Andis

★★★★☆ 22 customer reviews | 3 answered questions



eBeautyInc

Price: ~~\$64.00~~ **\$64.00** ✓prime


Pay ~~\$64.00~~ \$0.00 after using available American Express Membership Rewards points.

FREE Delivery **Thursday** if you order within 18 hrs 48 mins. [Details](#)

**In Stock.** Sold by Diamonds Trading and Fulfilled by Amazon.


📍 Deliver to Andrea - Coto De Caza 92679

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## About the product

- ANDIS PROFESSIONAL

# EXHIBIT B

# Tranquility Slimline Original Adult Disposable Brief - MD - 96 ct by Tranquility

★★★★★ 19 customer reviews



## About the product

- Adult Diapers/Briefs designed for heavy levels of urinary incontinence (10 oz to 24 oz capacity, varying by size)
- Kufguards (inner leg cuffs) channel fluids to the core to contain large urine episodes and bowel, or fecal, incontinence
- Wetness indicator turns from yellow to blue, clearly indicating when a change is due
- Available in six sizes, ranging from Junior (XXS) to XL, all with refastenable tabs and latex-free
- Peach Mat Guarantee ensures skin dryness, reduces odor, neutralizes pH, and inhibits bacterial growth

Price: **\$58.26** (\$0.61 / count) & **FREE Shipping**


**Note:** Not eligible for Amazon Prime.

**In Stock.** Ships from and sold by Engoloids Medical LLC.

Get it Thu, Aug 29 - Tue, Sep 3

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Qty: 1 ▼

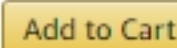
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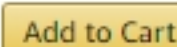
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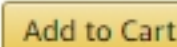
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Sold by: OZ Medical

**\$61.16** (\$0.64 / count) + Free Shipping 

Sold by: DHS Med



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## Typed Drawing

**Word Mark** SLIMLINE

**Goods and Services** IC 010. US 026 039 044. G & S: dental apparatus for use with ultrasonic equipment, namely, inserts in the nature of scalers for teeth, for prophylaxis treatment. FIRST USE: 19920210. FIRST USE IN COMMERCE: 19920210

**Mark Drawing Code** (1) TYPED DRAWING

**Serial Number** 75126133

**Filing Date** June 27, 1996

**Current Basis** 1A

**Original Filing Basis** 1A

**Published for Opposition** March 18, 1997

**Registration Number** 2069650

**Registration Date** June 10, 1997

**Owner** (REGISTRANT) DENTSPLY INTERNATIONAL INC. CORPORATION DELAWARE 570 West College Avenue York PENNSYLVANIA 174050872  
(LAST LISTED OWNER) DENTSPLY SIRONA INC. CORPORATION DELAWARE 221 WEST PHILADELPHIA STREET YORK PENNSYLVANIA 17401

**Assignment Recorded** ASSIGNMENT RECORDED

**Attorney of Record** Douglas J. Hura

**Type of Mark** TRADEMARK

**Register** PRINCIPAL

**Affidavit Text** SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20170511.



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# SLIMLINE

<b>Word Mark</b>	SLIMLINE
<b>Goods and Services</b>	IC 010. US 026 039 044. G & S: orthopedic seat cushions. FIRST USE: 19960000. FIRST USE IN COMMERCE: 19960000
	IC 012. US 019 021 023 031 035 044. G & S: vehicle seat cushions. FIRST USE: 19960000. FIRST USE IN COMMERCE: 19960000
	IC 020. US 002 013 022 025 032 050. G & S: seat cushions. FIRST USE: 19960000. FIRST USE IN COMMERCE: 19960000
<b>Standard Characters Claimed</b>	
<b>Mark Drawing Code</b>	(4) STANDARD CHARACTER MARK
<b>Serial Number</b>	77714752
<b>Filing Date</b>	April 15, 2009
<b>Current Basis</b>	1A
<b>Original Filing Basis</b>	1A
<b>Published for Opposition</b>	September 29, 2009
<b>Registration Number</b>	3724924
<b>Registration Date</b>	December 15, 2009
<b>Owner</b>	(REGISTRANT) Supracor Inc. CORPORATION CALIFORNIA 2050 Corporate Court San Jose CALIFORNIA 95131
<b>Attorney of Record</b>	Michael K. Bosworth
<b>Type of Mark</b>	TRADEMARK
<b>Register</b>	PRINCIPAL-2(F)
<b>Affidavit Text</b>	SECT 15. SECT 8 (6-YR).
<b>Live/Dead Indicator</b>	LIVE



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# SLIMLINE

**Word Mark** SLIMLINE  
**Goods and Services** IC 010. US 026 039 044. G & S: Blood tubing for hemodialysis. FIRST USE: 20121025. FIRST USE IN COMMERCE: 20121025  
**Standard Characters Claimed**  
**Mark Drawing Code** (4) STANDARD CHARACTER MARK  
**Serial Number** 77815099  
**Filing Date** August 28, 2009  
**Current Basis** 1A  
**Original Filing Basis** 1B  
**Published for Opposition** December 6, 2011  
**Registration Number** 4298437  
**Registration Date** March 5, 2013  
**Owner** (REGISTRANT) NIPRO CORPORATION CORPORATION JAPAN 9-3, Honjo-nishi 3-chome, Kita-ku Osaka JAPAN 531-8510  
**Attorney of Record** Sarah G. Voeller  
**Type of Mark** TRADEMARK  
**Register** PRINCIPAL  
**Affidavit Text** SECT 15. SECT 8 (6-YR).  
**Live/Dead Indicator** LIVE

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# SLIM LINE

**Word Mark** **SLIM LINE**

**Goods and Services** IC 011. US 013 021 023 031 034. G & S: plumbing fittings, namely, check valves. FIRST USE: 20140928. FIRST USE IN COMMERCE: 20140928

**Standard Characters Claimed**

**Mark Drawing Code** (4) STANDARD CHARACTER MARK

**Serial Number** 86593681

**Filing Date** April 10, 2015

**Current Basis** 1A

**Original Filing Basis** 1A

**Published for Opposition** September 8, 2015

**Registration Number** 4858640

**Registration Date** November 24, 2015

**Owner** (REGISTRANT) Flomatic Corporation CORPORATION NEW YORK 15 Pruyn's Island Drive Glens Falls NEW YORK 12801

**Attorney of Record** Brett M. Hutton,

**Type of Mark** TRADEMARK

**Register** PRINCIPAL

**Live/Dead Indicator** LIVE

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## Typed Drawing

**Word Mark** SLIMLINE  
**Goods and Services** IC 025. US 039. G & S: ladies foundation garments; namely, bras, girdles, and pants. FIRST USE: 19911000. FIRST USE IN COMMERCE: 19911000  
**Mark Drawing Code** (1) TYPED DRAWING  
**Serial Number** 74801438  
**Filing Date** August 15, 1991  
**Current Basis** 1A  
**Original Filing Basis** 1B  
**Published for Opposition** July 7, 1992  
**Registration Number** 1805392  
**Registration Date** November 16, 1993  
**Owner** (REGISTRANT) Wacoal America, Inc. CORPORATION NEW YORK 136 Madison Avenue New York NEW YORK 11016  
 (LAST LISTED OWNER) WACOAL AMERICA, INC. CORPORATION BY MERGER DELAWARE 136 MADISON AVE NEW YORK NEW YORK 10016  
**Assignment Recorded** ASSIGNMENT RECORDED  
**Attorney of Record** LAWRENCE E ABELMAN  
**Type of Mark** TRADEMARK  
**Register** PRINCIPAL  
**Affidavit Text** SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20130802.  
**Renewal** 2ND RENEWAL 20130802  
**Live/Dead Indicator** LIVE