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Office Action Response re: Section 2(e)(1) Descriptiveness Refusal of Applicant's LANDED mark (88319904)

I. Introduction

Applicant has submitted an application for trademark protection for the mark "LANDED", Serial Number 88319904, in international class 036 for: "*Mortgage financing services; Real estate financing and mortgages services for civil servants, educators, teachers, professors and school staff; Financial services, namely, providing down payments to homebuyers, educators, teachers, and school staff; Financial investment in the field of real estate; Providing information in the field of real estate via the Internet; Real estate investment services; Financing services providing option contracts secured by an interest in the underlying residential property that enable homeowners to share home equity appreciation with investors; Providing cash to homeowners in return for a share in home equity appreciation*," (hereinafter "Applicant's Services"). It should be noted that the Applicant's description of services never uses the terms "LAND" or "LANDED".

In the Non-Final Office Action dated May 16, 2019, ("Office Action") the Examining Attorney issued a refusal of Applicant's application on the grounds that: (1) the mark was primarily descriptive of the Applicant's services; and (2) the mark "appears to be" generic in connection with the identified services. Applicant respectfully disagrees with the Examining Attorney's findings and puts forth here arguments that establish that the mark should proceed with registration on the Principal Register. Namely the phrase "LANDED" is not descriptive of Applicant's services because there exists no commonly held association with the phrase

“LANDED” and mortgage financing services. Indeed, “LANDED” requires an imaginative step to try and deduce what exactly is being referred to, if anything specifically. Additionally, the Examiner has not met their burden of proof with regard to the allegations that the mark is generic because they provided no evidence whatsoever in support of its assertion.

II. “LANDED” Is Not Generic or Merely Descriptive of Applicant’s Services Because It Suggests Many Different Possible Things But Describes None.

A descriptiveness refusal is appropriate only if the Examining Attorney can establish that the mark is “merely descriptive” of the Applicant's goods or services. 15 U.S.C. § 1053(e)(1) (emphasis added). The determination of whether a mark is suggestive or descriptive is made through the view of what the prospective purchasers of the products think and whether they would find the mark suggestive or descriptive. *Zobmondo Entm’t, LLC v. Falls Media, LLC,* 602 F.3d 1108 (9th Cir.2010); McCarthy § 11:70. The “fact-finder is not the designated representative of the purchasing public, and the fact-finder's own perception of the mark is not the object of the inquiry.” *Zobmondo*, 602 F.3d at 1113. “Rather, the fact-finder’s function is to determine, based on the evidence before it, what the perception of the purchasing public is.” *Id.*

In making this determination, the Examiner must consider “the mark in its entirety, with a view toward ‘what the purchasing public would think when confronted with the mark as a whole.’” *Solmetex, LLC v. Dentalez, Inc*., 150 F. Supp. 3d 100, 115 (D. Mass. 2015) (quoting *Equine Techs., Inc. v. Equitechnology, Inc*., 68 F.3d 542, 545 (1st Cir. 1995). One test to determine if a mark is merely descriptive asks “whether a person without actual knowledge of the services provided would have difficulty in determining their nature; if so, the mark is less likely to be descriptive.” *H. Jay Spiegel & Associates, P.C. v. Spiegel*, 652 F. Supp. 2d 639, 647 (E.D. Va. 2009), aff'd, 400 F. App'x 757 (4th Cir. 2010). A mark is descriptive if it “defines a particular characteristic of the product in a way that does not require any exercise of the

imagination." *Yellow Co. of Sacramento v. Yellow Cab of Elk Grove, Inc*., 419 F.3d 925, 927 (9th Cir.2005). On the other hand, a suggestive mark is one that "connote[s], rather than describe[s], some quality or characteristic of a product or service." *U.S. Search, LLC v. U.S. Search.com Inc*., 300 F.3d 517, 523 (4th Cir. 2002). "Generally speaking, if the mark imparts information directly, it is descriptive. If it stands for an idea which requires some operation of imagination to connect it with the goods [or services], it is suggestive." *Id*.

Ultimately, "a mark is suggestive if, when the goods or services are encountered under the mark, a multi-stage reasoning process, or the utilization of imagination, thought or perception is required in order to determine what attributes of the goods or services the mark indicates*." In re Health Facts, Inc*., 2001 TTAB LEXIS 16 (TTAB 2001) (citing *In re Abcor Dev. Corp*., 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978)); *see also West & Co., Inc. v. Arica Institute, Inc*., 557 F.2d 338, 195 USPQ 466 (2d Cir. 1977); *see also* Kendall-Jackson Winery, Ltd. v. E. J. Gallo Winery, 150 F.3d 1042, 1047 n. 8 (9th Cir. 1998) (explaining a suggestive mark is one for which "a consumer must use imagination or any type of multistage reasoning to understand the mark's significance . . . the mark does not describe the product's features, but suggests them.").

By contrast, "a merely descriptive mark 'describes the qualities or characteristics of a good or service.'" *Zobmondo*, 602 F.3d at 1114 (quoting *Park `N Fly, Inc. v. Dollar Park and Fly, Inc*., 469 U.S. 189, 194 (1985). A merely descriptive mark "defines qualities or characteristics of a product in a straightforward way that requires no exercise of the imagination to be understood." *Zobmondo*, 602 F.3d at 1114. Descriptive marks merely describe the haracteristics of the products like "After Tan post-tanning lotion, 5 Minute glue, King Size men's clothing, and the Yellow Pages telephone directory" however "[s]uggestive marks, . . . do not describe a product's features but merely suggest them." *Choice Hotels Int'l, Inc. v. Zeal, LLC*,

135 F. Supp. 3d 451, 461 (D.S.C. 2015), *reconsideration denied*, No. CV 4:13-01961-BHH, 2016 WL 4055023 (D.S.C. July 29, 2016).

An example of the distinction between a mark that only serves to be illustrative of the product and one that requires actual multi-step reasoning can be seen in a case from the Sixth Circuit about the mark "5-hour ENERGY." *See Innovation Ventures, LLC v. N.V.E., Inc*., 694 F.3d 723 (6th Cir. 2012). The Court in that instance recognized that "the '5–hour ENERGY' mark could be characterized as merely descriptive, in the sense that it simply describes a product that will give someone five hours of energy." *Id*. at 730. But the Court did not stop there:

> [T]hat is not the end of such an inquiry. The first question one would ask is how would the energy be transferred? Through food? Through drink? Through injections? Through pills? Through exercise? Also, one would ask what kind of energy is the mark referring to? Food energy (measured in Calories)? Electrical energy? Nuclear energy? With some thought, one could arrive at the conclusion that the mark refers to an energy shot. But it is not as straightforward as [the defendant] suggests. ***Such cognitive inferences are indicative of "suggestive" rather than descriptive marks***.

Id. (emphasis added).

The "LANDED" mark falls under this category of "suggestive" marks, much like 5-hour Energy, because the mark requires that a reasonable and prudent consumer goes through a thinking process that requires both multistep reasoning and imaginative thinking to determine the exact nature of the Applicant's Services. The Examining Attorney's entire argument rests on a single piece of evidence. A screenshot of an online dictionary that provides only two definitions for the term "landed": (1) "having an estate in land," and (2) consisting in or derived from land or real estate.

The Examiner believes that its Internet evidence, a sole dictionary attachment, makes clear that the wording is descriptive of Applicant's Services. Applicant respectfully disagrees because there are other definitions for the term "landed" that Examiner has not acknowledged.

See **Exhibit 1** at 4 (using "landed" to mean arriving at a destination, securing a record deal, and successfully lining up interviewees). Even the Examiner's own evidence is inconsistent in the definition it references. Directly below the definitions of landed provided by the Examiner is a section entitled "Examples of *landed* in a Sentence." The first example provided refers to China successfully "landing" on the moon. If you access the same page today one of the two examples refers to the "landed" value of goods. See **Exhibit 2**. In addition, "landed" also commonly refers to a fish that is caught. See **Exhibit 3** (journal article titled "Mean Size of the Landed Catch," which repeatedly refers to species of fish being "landed"). The Examiner does not explain, and Applicant fails to understand, how any of these taken alone or in combination equates to its mark being descriptive.

To the general consuming public, there exists no commonly held association with the phrase "LANDED" and mortgage financing services. Indeed, "LANDED" requires an imaginative step to try and deduce what exactly is being referred to, if anything specifically. Does it refer to a plane? A boat? A fish? Goods that have arrived at a buyer's location? A consumer would not know that "LANDED" would refer to any kind of mortgage financing services. Accordingly, an imaginative step is necessary to deduce exactly what is being referred to.

In addition, "in terms of establishing a term's likely meaning to consumers, evidence of the current usage may carry more weight than an older dictionary meaning." TMEP § 1209.03(b) (citing *In re Well Living Lab Inc*., 122 USPQ2d 1777, 1781 (TTAB 2017) (finding modern-day usage of "well-living" more significant than archaic dictionary definition). In *In re Well Living*, the TTAB found that the "modern-day usage of the term 'well-living' has more significance and probative value than the dictionary meaning in terms of the likely perception of consumers." 122

USPQ2d at 1781. The term "landed," as in the "landed gentry," is archaic, having been used, according to Merriam Webster, since the 15th century. By contrast—as Exhibits 1-3 indicate—it is much more common today to hear "landed" in relation to airplanes, goods, or fish. The Examiner has erred in ignoring evidence of diverse modern day usage in favor of focusing on the dictionary definition of an archaic usage.

Just as a consumer seeing 5-hour ENERGY "in isolation would [not] know that the term refers to an energy shot rather than, for example, a battery for electronics, an exercise program, a backup generator, or a snack for endurance sports," a consumer seeing "LANDED" would not automatically know it refers to "*Mortgage financing services; Real estate financing and mortgages services for civil servants, educators, teachers, professors and school staff; Financial services, namely, providing down payments to homebuyers, educators, teachers, and school staff; Financial investment in the field of real estate; Providing information in the field of real estate via the Internet; Real estate investment services; Financing services providing option contracts secured by an interest in the underlying residential property that enable homeowners to share home equity appreciation with investors; Providing cash to homeowners in return for a share in home equity appreciation.*" *See Innovation Ventures, LLC*, 694 F.3d at 730. Indeed, even using the single definition provided by the Examining Attorney, it requires an imaginative leap from mortgage financing services to one actually becoming "landed," i.e., a person having an estate in land. The mark "LANDED", therefore, does not immediately signify to consumers that it is for "mortgage financing services" as the Examiner states in the Office Action. Accordingly, the mark does not make an immediate connection to the consumer's mind and is deserving registration as suggestive rather than descriptive.

III. Competitors Do Not Need the Term "LANDED" to Describe Their Services.

Another test used to determine descriptiveness is the "competitors' needs test" which focuses on the extent to which competitors would need to use the mark to identify their goods. *Seal Shield, LLC v. Otter Products, LLC*, No. 13-CV-2736-CAB (NLS), 2014 WL 11350295, at *8–9 (S.D. Cal. Nov. 4, 2014). "In determining whether a word has a descriptive or suggestive significance as applied to a commercial service, it is proper to take notice of the extent to which others in a similar commercial context use the word." *Spin Master, Ltd. v. Zobmondo Entm't*, LLC, No. CV 06-3459 ABC PLAX, 2012 WL 8134012, at *16 (C.D. Cal. Apr. 27, 2012), on reconsideration in part, No. CV 06-3459 ABC PLAX, 2012 WL 8134014 (C.D. Cal. July 6, 2012). The "competitors' use test" "measures the extent which other competitors have used the name to describe similar products [because] if others are using the term to describe their products, an inference of descriptiveness can be drawn." *Riggs Mktg. Inc. v. Mitchell*, 993 F. Supp. 1301, 1308–09 (D. Nev. 1997); *See* McCarthy §11:69.

Competitors can describe their services without using the words found in Applicant's mark. Indeed, Applicant could not find, nor did the Examiner submit, evidence of *any* competitor that uses the term "LANDED" anywhere in their marketing materials or websites. This further supports that the mark "LANDED" serves a suggestive function rather than a descriptive one.

IV. The Mark is Not Generic for Applicant's Services.

The examining attorney has the burden of proving that a term is generic by clear evidence. *In re Nordic Naturals, Inc*., 755 F.3d 1340, 1344, 111 USPQ2d 1495, 1498 (Fed. Cir. 2014; *In re Merrill Lynch, Pierce, Fenner & Smith Inc.,* 828 F.2d 1567, 1571, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). Evidence of the public's understanding of a term can be obtained from any competent source, including dictionary definitions, research databases, newspapers, and

other publications. *See In re Cordua Rests., Inc.,* 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016. The test for genericness is the same whether the mark is a compound term or a phrase, and the examining attorney should include, if available, evidence showing use of the mark as a whole in the record. *See Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 968, 114 USPQ2d 1827, 1832 (Fed. Cir. 2015) (citing *In re Am. Fertility Soc'y*, 188 F.3d 1341, 1348-49, 51 USPQ2d 1832, 1837 (Fed. Cir. 1999)).

In this case, the Examiner has offered nothing except the conclusory statement that the mark "appears to be" generic in connection with the identified services if not descriptive. Accordingly, the Examiner's burden of proving that the mark is generic has not been met.

V. Any Doubts as to Whether Applicant's Mark Can be Registered on the Principal Register, Such Doubts Must Be Resolved in Applicant's Favor.

In the case there should be any doubt as to whether Applicant's mark should be registered, "it is the Board's practice to resolve the doubt in the applicant's favor and publish the mark.*" In Re Morton-Norwich Products, Inc*., 209 U.S.P.Q. (BNA) ¶ 791 (P.T.O. Jan. 23, 1981); *See In re The Gracious Lady Service, Inc.*, 175 USPQ 380 (TTAB, 1972); *In re Gourmet Bakers, 173 USPQ 565* (TTAB, 1972). Should the Examining Attorney have any doubts as to whether Applicant's mark is primarily descriptive, the Examining Attorney should resolve such doubts in Applicant's favor and allow the mark to proceed with registration.

VI. Conclusion

Based on the arguments above, Applicant respectfully submits that the objections in the Office Action should now be withdrawn. Prompt publication for public opposition is solicited.