A. Section 2(e)(1) Refusal

The Examining Attorney has refused to register Applicant's GLITTER BEACH mark under Section 2(e)(1). To be refused registration on this basis, Applicant's mark must be found to "possess nothing more than a descriptive significance or, immediately, without the need for conjecture or surmise, describe an essential attribute of the goods or services in connection with which they are used." In re Hunter Publishing Co., 204 U.S.P.Q. 957,962 (TTAB 1979). Furthermore, the mark must immediately convey information as to the goods or services with a degree of particularity." Plus Products v. Medical Modalities Associates, Inc., 211 U.S.P.Q. 1199, 1204-1205 (TTAB 1981); Holiday Inns, Inc. v. Monolith Enterprises, 212 U.S.P.Q. 949, 952 (TTAB 1981).

Applicant's GLITTER BEACH mark does not fit within the narrow description of merely descriptive marks, as the mark does not immediately call to mind Applicant's goods, namely, swimwear and coverups. Rather, Applicant's mark conjures up a fictional or mythical beach, with glittering sun, sand and water. It takes another logical step to connect the function of Applicant's goods to this fictional location.

Longstanding practice at the USPTO regarding the component terms of Applicant's mark further support the view that Applicant's mark is not merely descriptive. In particular, a search of the USPTO's TESS and TSDR databases for active registrations and allowed applications located the following marks relevant to this issue:

- 454 BEACH-formative marks identifying goods in International Class 25, none of which disclaim exclusive rights to the term BEACH; and

- 75 BEACH-formative marks identifying goods in International Class 25, none of which disclaim exclusive rights to the term BEACH and all of which specifically identify swimwear;
- 9 GLITTER-formative marks identifying goods in International Class 25, none of which disclaim exclusive rights to the term GLITTER; and
- 20 records for marks identifying goods in International Class 25 that include either the term SEQUIN or SPARKLE, but do not disclaim those terms.

Applicant has attached the full references for the 75 active registrations and allowed applications for BEACH marks that identify swimwear (Exhibit 1); the 9 active registrations and allowed applications for GLITTER marks in Class 25 (Exhibit 2); and 20 active registrations and allowed applications for SEQUIN and SPARKLE marks in Class 25 (Exhibit 3). If the Examining Attorney requires the full USPTO records for the 454 BEACH-formative active registrations and allowed applications in Class 25 that do not disclaim the term "Beach," Applicant will provide them.

The absence of a disclaimer in so many active registrations and allowed applications for BEACH- and GLITTER-formative marks for goods in Class 25 reflects the USPTO's longstanding view that these terms are no, in fact, merely descriptive for these goods. That conclusion is similarly reflected in the USPTO's registration and allowance of marks for similar goods that include either the term SEQUIN or SPARKLE, which are similar in meaning and commercial impression to the term GLITTER in Applicant's mark. Indeed, the registration and allowance of so many BEACH- and GLITTER-formative marks reflects the USPTO's conclusion that consumers must use

some degree of imagination to connect the marks to the goods they identify, making Applicant's mark suggestive and not merely descriptive.

In view of the USPTO's records establishing that BEACH and GLITTER are not merely descriptive terms, Applicant's combination of these marks should similarly not be deemed merely descriptive. Accordingly, Applicant requests that the Examining Attorney withdraw the Section 2(e)(1) refusal and approve this application for publication.