

ARGUMENT

The Examining Attorney refuses registration of the LION'S ROOT trademark (the "Mark") on the basis that the mark and phrase "Lion's Root" primarily merely describes an ingredient of Applicant's goods. Applicant respectfully submits that the refusal is improper because, as more fully explained below: (1) the phrase "Lion's Root" is fanciful, not merely descriptive, as applied to Applicant's goods, (2) the Examining Attorney's evidence is insufficient to establish that consumers immediately understand the phrase "Lion's Root" to have any descriptive meaning in relation to Applicant's goods; and (3) any doubt with respect to the descriptiveness of the phrase must be resolved in favor of Applicant.

I. The Phrase "Lion's Root" is Fanciful as Applied to Applicant's Goods.

A trademark or term is "primarily merely descriptive" within the meaning of section 2(e)(1) of the Lanham Act only "if it *forthwith* conveys an *immediate* idea of the ingredients, qualities or characteristics of the goods." In re Stroh Brewery Co., 34 USPQ2d 1796, 1797 (TTAB 1995) (emphasis in original); see also, In re Remacle, 66 USPQ2d 1222, 1224 n.1 (TTAB 2002). In contrast, a fanciful mark or term are those that have been invented for the sole purpose of functioning as trademarks. TMEP §1209.01(a).

Applicant submits that it coined the Mark as a combined reference to Lion's Mane mushroom, which the goods contain – the "LION'S" component -- and to how grounded the Applicant's Founder's daughter feels upon consuming the goods – the "ROOT" component. As such the Mark and phrase LION'S ROOT is unlikely to convey anything specific regarding the ingredients of the goods and is therefore not primarily descriptive of them.

II. The Cited Evidence Does Not Support Descriptiveness.

Applicant respectfully submits that the evidence presented by the Examining Attorney in support of the descriptiveness refusal does not establish the descriptiveness of the Mark. The Examining Attorney bears the burden of demonstrating the descriptiveness of a mark or term for

which registration is sought. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987); see also TMEP § 1209.02 (“If the examining attorney refuses registration, he or she should support the refusal with appropriate evidence.”). The Examining Attorney has presented no evidence that consumers or prospective consumers of Applicant’s goods would immediately perceive the phrase “Lion’s Root” as *merely* describing an ingredient of Applicant’s goods. Rather, the Examining Attorney’s evidence consists of two relatively obscure and dated reference books supporting the proposition that “Lion’s Root” primarily means in the minds of consumers an indigenous U.S. herbal plant also known by its Latin name “*nabalus serpentaria*.” Applicant respectfully asserts that the evidence made of record is insufficient to demonstrate that consumers are even aware that there is such a thing as “*nabalus serpentaria*” let alone its other purported name “Lion’s Root.” Applicant notes that there is no evidence of this purportedly commonly-known plant being used as an ingredient in any consumable good. Given the billions of searchable Internet web pages, the fact that only two reference books even identify this plant by the name “Lion’s Root” is simply not enough evidence to prove that consumers immediately recognize the phrase as a potential ingredient of edible products, let alone Applicant’s goods.

In further support of this contention, Applicant makes of record as **Exhibit A**, a printout of the results of a search of the CISION® Media Database, which contains 1.4 million individual media references, for the period from August 1, 2017 to July 31, 2019 for instances of use of the phrase “Lion’s Root.” Of the 104 results, none refer to an herb or plant of any kind. The highlighted results reflect those instances not associated with Applicant’s own use of the Mark, and are best summarized as separate uses of the term “Lion” adjacent to the term “Root,” such as “Which team should the Lion’s root for?” and Southgate burst with pride for Lions. Root won’t think about records.” Given the vast number of *contemporary* media sources represented in the CISION® database, this evidence strongly suggests that the consuming public is not

associating the phrase “Lion’s Root” with anything and it cannot possibly forthwith convey an immediate idea in the minds of consumers a potential ingredient of Applicant’s goods.

In light of the above, Applicant respectfully submits that the evidence cited by the Examining Attorney does not establish that the Mark is merely descriptive of any ingredient of Applicant’s goods and, in fact, it is not.

III. Any Doubts Should Be Resolved in Applicant’s Favor.

The Trademark Trial and Appeal Board in In re Gourmet Bakers, Inc. held that:

there is no easy applicable objective test to determine whether or not a particular mark, as applied to specific goods, is merely descriptive or merely suggestive. The distinction between marks which are ‘merely descriptive’ and marks which are ‘suggestive’ is so nebulous that more often than not it is determined largely on a subjective basis with any doubt in the matter being resolved in applicant’s behalf ...

173 USPQ 565, 565 (TTAB 1972) (emphasis added); see also In re Grand Metropolitan Foodservice, Inc., 30 USPQ2d 1974, 1976 (TTAB 1994); In re Merrill Lynch, 4 USPQ2d 1141 (Fed. Cir. 1987); In re Shutts, 217 USPQ 363 (TTAB 1983). Applicant’s arguments in favor of registration and the lack of evidence of descriptiveness of the Mark are more than sufficient to create the requisite doubt, and that doubt should be resolved in Applicant’s favor.

CONCLUSION

In light of the foregoing arguments, Applicant respectfully requests that the Examining Attorney withdraw the descriptiveness refusal and approve the application for the Mark for publication and subsequent registration.