

Response to Office Action

This is in response to the Office Action dated May 13, 2019. The Examining Attorney has requested that the applicant disclaim “BREATHE” on the grounds that he believes that it merely describes a characteristic of applicant’s goods—specifically that the fabrics can “breathe.” Applicant respectfully disagrees and maintains for the reasons herein that “BREATHE” is not merely descriptive of applicant’s goods. Instead, the term BREATHE within applicant's mark indirectly hints at qualities of applicant’s goods—that use of applicant's fabrics allow consumers to 'breathe easy' or not worry. Moreover, prior USPTO practice and treatment of other “BREATHE” trademarks further illustrate that this word is not descriptive, and that a disclaimer should not be required.

Descriptive trademarks immediately convey information to consumers about those ingredients, qualities, or characteristics. *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 791 (5th Cir. 1983); *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 963 (Fed. Cir. 2007). On the other hand, suggestive trademarks only indirectly hint at ingredients, qualities, or characteristics of the claimed goods or services. *Zatarains, Inc.*, 698 F.2d at 791. The determination of whether a mark is merely descriptive must be made in relation to the goods or services for which registration is sought. *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300 (Fed. Cir. 2012) (citing *In re Bayer Aktiengesellschaft*, 488 F.3d at 963). When determining if a mark is descriptive or suggestive, the “imagination test” is frequently utilized. *Zobmondo Entm't, LLC v. Falls Media, LLC*, 602 F.3d 1108, 1116 (9th Cir. 2010). If a consumer must exercise “imagination, thought, and perception” to arrive at the nature of the claimed goods, the mark is suggestive. *Id.* (citing *Stix Prod., Inc. v. United Merchants & Mfrs., Inc.*, 295 F. Supp. 479, 488 (S.D.N.Y. 1968)). Moreover, to be characterized as “descriptive,” a term

cannot be indirect or vague, but must directly give some reasonably accurate or tolerably distinct knowledge of the characteristics of a product. 2 McCarthy on Trademarks and Unfair Competition § 11:19 (5th ed.). Furthermore, the faster and easier the association is for the consumer between the mark and a quality of the goods, the more likely a mark is descriptive. *Cross Commerce Media, Inc. v. Collective, Inc.*, 841 F.3d 155, 162 (2d Cir. 2016) (holding that COLLECTIVE is suggestive for business software to facilitate marketing.).

In the Office Action, the Examining Attorney asserts that “BREATHE” refers to fabrics with breathable qualities, and concludes that “BREATHE” merely describes this quality of the goods and should be disclaimed. However, breathability is neither the primary characteristic of applicant’s fabrics nor a feature or characteristic that applicant touts in its marketing. Instead, consumers encountering the mark BREATHE BY MILLIKEN must use some imagination, thought, or perception to reach a conclusion as to the nature of goods recited in the application. Therefore, the mark should be considered suggestive, and a disclaimer of BREATHE is not required.

For example, a consumer seeing the mark BREATHE BY MILLIKEN in association with applicant's fabrics for use in furniture upholstery would not immediately arrive at an idea of the attributes of the claimed goods. Specifically, the applicant offers upholstery fabrics that are designed to be environmentally friendly because they: (a) incorporate natural, renewable, and/or recycled materials, (b) utilize a plant-based, water-repellent that is fluorine-free for repelling stains and spills, and (c) have been certified to meet low chemical emissions limits. Furthermore, such fabrics are durable and easy to clean.


In this sense, consumers can 'breathe easy' because of the low chemical emissions; and can also 'breathe easy' knowing the applicant's fabric is durable and easy to care for in the event of spills or stains. Applicant highlights this suggestive use of "breathe" in marketing materials by stating, for example:

- "[T]he fabrics are designed from the very beginning to withstand wear and tear, repel everyday stains and clean easily. You'll *breathe easy*, knowing you can clean easy." (emphasis added)
- "[The fabrics provide] a fabric innovation that truly allows you to relax, knowing that when a drink gets spilled or your sofa becomes a trampoline, *breathe easy*. All is well." (emphasis added)
- "Breathe fabrics are able to provide stain-resistance and more peace of mind enabling you to *breathe easier* in your home." (emphasis added)



Please see the included screenshots (web pages accessed November 13, 2019) of some of applicant's online marketing materials. Thus, "BREATHE" within applicant's mark is suggestive, not descriptive, because imagination is required to arrive at attributes of the goods. Rather than immediately and merely describing a feature of the goods, the term "BREATHE" suggests 'peace of mind' in connection with applicant's fabrics.

In addition to the reasons above, a disclaimer should also not be required due to prior USPTO practice and treatment of other "BREATHE" marks. Specifically, there are many third-party trademark registrations on the Principal Register consisting of "BREATHE," alone or in combination with other words, identifying clothing, apparel, or fabric in Classes 24 and 25, in

which disclaimers were not entered (see enclosed TSDR printouts). If “BREATHE” in the below marks was not considered by the USPTO to be merely descriptive for the claimed fabrics or apparel, neither should such term be considered descriptive or disclaimed in the applicant's mark.

Mark	Reg. No.	Goods
BREATHE DEEP	5422887	Class 25 for Hats; Shirts; Hooded sweat shirts; Hoodies; Jackets; Short-sleeved or long-sleeved t-shirts; Sweat shirts; T-shirts (Owner: Breathe Deep LLC)
BREATHE LOVE	5108594	Class 25 for Clothing, namely, tops, bottoms, footwear (Owner: Troy Thomas, individual)
JUST BREATHE	5632347	Class 25 for t-shirts, t-shirts for adults and babies (Owner: Brittany Slay, individual)
BREATHE ACTIVEWEAR <i>(disclaimer of ACTIVEWEAR)</i>	4981373	Class 25 for Bikini tops and bikini bottoms for beach volleyball players; Swimwear; Women's activewear, namely, shorts, pants, shirts, tops, jackets, socks, headbands, hats, caps and sports bras; activewear in the nature of athletic pants, shirts and shoes (Owner: DRAKEROD DESIGNS INC.).
JUST BREATHE	5065093	Class 25 Clothing, namely, yoga pants, yoga shirts, sports bras, yoga shorts, sweatpants, sweatshirts, socks, hats, headbands, shoes, sneakers (Owner: Ujjayi Studios, Inc.)
BREATHE BEAUTIFULLY	4553236	Class 25 for Bras; undergarments (Owner: Chico's Brands Investments, Inc.)
BREATHE BELIEVE BATTLE	4754112	Class 25 for Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; Shirts (Owner: Troy Tanner, Individual)
BREATHE. RELAX. SLEEP.	4452354	Class 24 for mattress covers and pillow covers (Owner: Fabrictech 2000, LLC)
SPIRO BREATHE TO PERFORM	4482933	Class 24 for textiles (Owner: Result Clothing Limited)
 Breathe Weave <i>(disclaimer of WEAVE)</i>	3323909	Class 25 for Cotton base <u>mixed woven fabric</u> sold a [sic] an integral component of athletic clothing, namely pants, shirts, shorts, skirts, halter tops, hooded tunics and panties (Owner: Be Present, Inc.)

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	5588565	Class 25 for Graphic T-shirts; Hooded sweat shirts; Shirts; Shirts and short-sleeved shirts; Short-sleeved or long-sleeved t-shirts; Short-sleeved shirts; T-shirts; Tee shirts; Wearable garments and clothing, namely, shirts (Owner: Aldrin Festejo, individual)
 (disclaimer of LIGHT)	3455824	Class 24 for Nonwoven fabrics made from polyolefins (Owner: Chicopee, Inc.)

Finally, any doubt as to whether a mark is suggestive or merely descriptive should be resolved in favor of the applicant. This is because there can be only a thin line separating a suggestive mark from a descriptive one, and any such characterization of a mark is inherently subjective. See, e.g., *In Re the Stroh Brewery Co.*, 34 U.S.P.Q.2d 1796, 1797 (T.T.A.B. 1994) (noting that “[w]hen doubts exist as to whether a term is descriptive as applied to the goods or services for which registration is sought, it is the practice of this Board to resolve doubts in favor of the applicant and pass the mark to publication”).

It is accordingly submitted that this mark is entitled to registration without a disclaimer. Favorable reconsideration and passage to publication are respectfully requested.