

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of)
BLISTEX INC .)
Serial No. 88/382,984)
Filed: April 12, 2019)
For: MOISTURE MOUSSE)

Examiner :
Kyle D. Simcox
Law Office : 122

RESPONSE TO OFFICE ACTION NO. 1

The Applicant herein responds to the above referenced Office Action of the Trademark Attorney Examiner.

RESPONSE TO TMEP 1209 OBJECTION

The application of record has been preliminarily refused registration on the Principal Register on the basis that the mark, when applied to the goods, is considered "merely descriptive " TMEP 1209. Applicant submits that based upon the relevant facts and the legal issues involved, the Applicant's mark is sufficiently distinctive to be registrable. The mark is at most suggestive, not merely descriptive and is thereby registrable .

Section 2 (e) (1) of the Trademark Act provides that no mark shall be refused registration unless the mark, when applied to the goods, is "merely descriptive" (emphasis added) "The term 'merely' is to be taken in its ordinary meaning of 'only' or 'solely'--that is, when considered with the particular goods or services, the mark, because of its meaning, does nothing but describe them." TMEP 1209. Applicant's mark does not identify any specific product. Thus, at most it is only suggestive of Applicant's goods and, as such, is registrable. TMEP 1209. The Applicant's mark MOISTURE MOUSSE does not solely describe the goods. The Applicant's mark does not tell the consumer what products are involved, or that even products, rather than a procedure or services are actually involved. Moreover, consumers would not know whether packaging, a product, an aspect of a product or aspects of a combination of all of the above are involved. An element of incongruity would exist and the overall mark should not be considered as merely descriptive or non-registrable.

Suggestive marks are those that, when used in

association with the goods or services at issue, require imagination, thought, or perception to reach a conclusion as to the nature of those goods or services. Suggestive terms which are registrable differ from descriptive terms, which immediately tell something about the goods or services. See In re George Weston Ltd., 228 USPQ 57 (TTAB 1985) (SPEEDI BAKE for frozen dough found to fall within the category of suggestive marks because it only vaguely suggests a desirable characteristic of frozen dough, namely, that it quickly and easily may be baked into bread); In re The Noble Co., 225 USPQ 749 (TTAB 1985) (NOBURST for liquid antifreeze and rust inhibitor for hot-water-heating systems found to suggest a desired result of using the product rather than immediately informing the purchasing public of a characteristic, feature, function, or attribute); and a particularly analogous case dealing with footwear would be the case of In re Pennwalt Corp., 173 USPQ 317 (TTAB 1972) (DRI-FOOT held suggestive of anti-perspirant deodorant for feet because it is not the usual or normal manner in which the purpose of an anti-perspirant or deodorant for the feet would be described, and due in

part to the singular nature of the mark).

Incongruity is a strong indication that a mark is suggestive rather than merely descriptive. In re Tennis in the Round Inc., 199 USPQ 496, 498 (TTAB 1978) (TENNIS IN THE ROUND held not merely descriptive for providing tennis facilities, the Board finding that the association of applicant's marks with the phrase "theater-in-the-round" created an incongruity. The Board considers incongruity in a mark as "one of the accepted guideposts in the evolved set of legal principles for discriminating the suggestive from the descriptive mark," and has considered that the concept of mere descriptiveness "should not penalize coinage of previously unused and somewhat incongruous word combinations whose import would not be grasped without some measure of imagination and mental pause." In re Shutts, 217 USPQ 363, 365 (TTAB 1983) (SNO-RAKE held not merely descriptive for a snow-removal hand tool); see In re Vienna Sausage Mfg. Co., 156 USPQ 155, 156 (TTAB 1967) (FRANKWURST held not merely descriptive for wieners) as the combination of the terms is considered incongruous and results in a mark that is no more than suggestive of the nature of the goods); In

re John H. Breck, Inc., 150 USPQ 397, 398 (TTAB 1966)
(TINT TONE held suggestive for hair coloring, the Board finding that the words overlap in significance and their combination is somewhat incongruous or redundant and does not immediately convey the nature of the product); *cf.* In re Getz Found., 227 USPQ 571, 572 (TTAB 1985) Suggestive marks are registrable on the Principal Register without proof of secondary meaning. Therefore, a designation does not have to be devoid of all meaning in relation to the items identified in an application to be registrable upon the Principal Trademark Register [TMEP §1209.01 (a)].

Simply because the mark may suggest a function or characteristic of the Applicant's goods, it is not "merely descriptive," since it serves as an indication of source. Application of the Realistic Company, 440 F.2d 1393 (CCPA 1971), reversing a Sec. 2 (e) (1) rejection of CURV for permanent wave curling solutions; In re Frank J. Curran Co., 189 USPQ 560 (TTAB 1975), reversing a Sec. 2 (e) (1) rejection of CLOTHES FRESH for clothes and shoe spray deodorant.

In the present case, the mark at issue, MOISTURE MOUSSE, is no more descriptive of products used in

connection with the mark than was the mark "Cook-N-Look" in Ex Parte Club Aluminum Product Company, 105 USPQ 44 (Comm .Pat . 1955), for transparent glass covers . Both marks can be said to be suggestive of possible product attributes , but neither mark can be said to be merely descriptive for the actual products or packaging involved. In the present case, the Applicant 's mark should not be considered as a merely descriptive mark.

The present case can be compared to Price Baking Powder Co . v . Fyfe, 45 F . 799 (CCD Minn . 1891) . In Price Baking, a registration was permitted for the word "Cream". The registration for "Dr . Price 's Cream Baking Powder" was allowed , since "Cream" is often used to designate the best part of a particular thing but , not the thing itself, as, for instance, the "cream of a story". In the present case, the mark MOISTURE MOUSSE does not identify the actual products involved or even that a product is involved , but only suggests a myriad of possible products , services or alternative combinations, or other possibilities . The Applicant 's mark does not identify whether a product , packaging or a service is involved . The mark "MOISTURE MOUSSE"

represents an overall phrase or words where creative thinking is necessary for the overall application of the mark to any specific product where no specific product is identified, and the mark is at most suggestive for the types of products listed in the application at issue. Applying the rationale of Price Baking Powder Company, supra, the Applicant's mark should be passed to publication .

Many suggestive terms have been approved as valid by the courts . General Shoe Corp . v . Rosen , 11 F.2d 95, 98 (4th Cir. 1940), reh . den . 112 F.2d 561 (4th Cir. 1940). Some courts have held that a word qualifies as suggestive if, though "... it may be suggestive of certain characteristics it is not descriptive to the extent of defining any particular quality of the goods to which it is applied ." Arkell Safety Bag Co . v . Safe Pack Mills , 533 App DC 318, 189 F. 616, 617 (1923) .

A review of several other cases specifically pertaining to, for instance, other personal care products, reveals marks which were considerably more descriptive than the Applicant 's mark could be considered, and which were held to be valid trademarks .

For instance, in La Maur, Inc. v. Revlon, Inc., 146 USPQ 654 (4th Cir. 1965), the marks "Style" and "Set and Style" were held suggestive and not descriptive when applied to hair sprays and hair setting lotions. The Court found the marks suggestive even though the term "Set" is a word commonly employed as part of a trademark when speaking of hair setting lotions or products used in setting the hair. In Wella Corp. v. La Maur, Inc., 136 USPQ 453 (CCPA 1963), the registrant, Wella, in an apparent attempt to show the descriptiveness of the mark "Style", relied on its own registration of "Style-Tex" and eleven third-party registrations which contained the word "Style" in various forms. The Court held that "Style" was not descriptive of hair setting and holding spray products. Certainly the mark at issue in the present case is even more distinctive than the marks discussed in the Wella Corp. v. La Maur case, supra.

Even whole phrases or slogans have been held to be sufficiently distinctive for registration. For instance, the mark "Sportswear for Everwear" was held distinctive, In re David Crystalk, Inc., 145 USPQ 95 (TTAB 1965), and the mark "Only Silk is Silk" was held distinctive in In

re International Silk Association (USA), Inc., 152 USPQ 779 (TTAB 1967). Even though the term "Preformed" is descriptive, the laudatory mark "You Can Look Up To Preformed" was held distinctive in In re Preformed Line Products Co., 359 F.2d 907, 149 USPQ 569 (CCPA 1966); and "Home of the Whopper" was held distinctive in In re Burger King of Florida, Inc., 136 USPQ 396 (TTAB 1963).

The phrase "Your Financial Security is Our Business" for insurance planning services was held by the Trademark Board to be a merely suggestive, non-descriptive mark eligible for registration. In the present situation, the mark at issue, it is submitted, should be held sufficiently non-descriptive and eligible for registrability.

Applicant's mark does not merely describe. It cannot be reasonably maintained that the mark merely describes the goods. What is meant by the Applicant's mark MOISTURE MOUSSE in connection with the goods at issue in the present application? The mark does not convey any immediate answer to the question. Something is suggested, but it certainly does not say what that the products are in the Applicant's application. Further inquiry must be

made to determine what products or services are intended by the Applicant 's mark since no definition exists for the overall mark as shown in the application .

Furthermore, even if some or even all of the words of the Applicant 's mark were considered descriptive a combination of descriptive words could be registrable . If a mark consists of a combination of an arbitrary portion and a descriptive portion then the combination should be considered as distinctive Nissom Trampoline v . American Trampoline, Co ., 193 F Supp . 745 (CDS Iowa 1961). Cases have gone a step further in indicating that a combination of two descriptive terms could convert a mark into being distinctive, so even if the words in the Applicant 's mark were viewed as descriptive , the mark could still be registrable . In re Colonial Stores, Inc ., 394 F2d (CCPA, 1968). Courts have even held words which could not individually become a trademark may become one when taken together . Application of Standard Elektrik, 371 F2d 870, 152 USPQ 563 (CCPA 1967); Food Fair Stores, Inc. v . Food Fair, Inc ., 177 F2d 177, 83 USPQ 14 (1st Cir. 1949).

If a prospective purchaser reads an advertisement for

the mark MOISTURE MOUSSE, the consumer would certainly not be able to identify what product is actually involved, but the mark might be considered to literally suggest some positive attributes for a product or service . When a mark prompts inquiries of this nature, it is suggestive, not merely descriptive . Thus, some creative thinking and more is required on the part of a prospective consumer to determine what is actually being suggested by the Applicant's mark . Applicant's mark possesses a degree of ingenuity which makes it distinctive and helps distinguish the Applicant 's goods from those of others . Thus, the mark is registrable . In re Wilderness Group, Inc., 189 USPQ 44 (TTAB 1975)

The foregoing demonstrates that, at the very least, there is strong doubt that the Applicant 's mark is descriptive . Where doubt exists as to whether a mark is suggestive or merely descriptive , the doubt should be resolved in Applicant 's favor . In In re Penwalt Corp., 173 USPQ 317 (TTAB 1972), reversing a Sec . 2 (e) (1) rejection of DRI-FOOT for an antiperspirant deodorant for feet and this case dealing with foot care is particularly

applicable to the present case .

A review of several other cases reveals marks which are of a less suggestive and more descriptive nature than the Applicant 's mark were held to be valid trademarks. In In re Morton-Norwich Products Inc., 209 USPQ 791, 792 (TTAB 1981), the mark COLOR CARE for a laundry bleach which would not harm dyes in colored fabrics was held suggestive, in that the Board held "a precise meaning attributable to the term COLOR CARE as used on a laundry bleach is somewhat nebulous", and the Board further held that "... the mark in question intimates or suggests a characteristic of the product rather than being merely descriptive thereof."

The mark MR . CLEAN for a household cleaner was held suggestive in Proctor & Gamble Co . v . Citrus Resources, Inc., 189 USPQ 112 (TTAB 1975), and the mark GLASS WAX for a liquid glass and metal cleaner was held suggestive in Gold Seal Co . v . Weeks , 129 F.Supp . 928 (D.C . 1959), aff 'd sub nom . S.C . Johnson & Son Inc . v . Gold Seal Co ., 230 F .2d 832 (D.C . Cir . 1956). Additionally, the mark COTTON TIPS for cotton-tipped applicators was held distinctive in Q-Tips , Inc . v . Johnson & Johnson , 108 F.Supp . 845 (DC NJ 1952). Certainly, in the present

situation the Applicant 's mark must be considered to convey considerably less information about the specific products involved than any of the above trademarks considered distinctive for the types of products described above .

A composite mark should be considered in its entirety such as THE AMERICAN GIRL for shoes which was also not considered descriptive . Hamilton-Brown Shoe Co . v . Wolf Bros . & Co . , (1916) 240 U.S. 251, 60 L Ed 629, 36 S Ct . 269 .

Even if this application were still considered a close case on the issue of the suggestiveness of an Applicant 's mark , the mark should still be passed to publication . The Board has recognized that there is a thin line between a suggestive and a merely descriptive designation , and where reasonable people may differ , it is the Board 's practice to resolve the doubt in the Applicant 's favor and publish the mark for opposition . In re The Gracious Lady Service , Inc . , 75 USPQ 380 (TTAB 1972) and In re Gourmet Bakers , 173 USPQ 565 (TTAB 1972) .

The combination of distinctive words into a distinctive overall slogan or phrase further enhances the

registrability of the Applicant's mark.

CONCLUSION

The Applicant's mark should be considered registrable because it represents a composite mark which for the goods involved is sufficiently vague and without any specific, consistent or recognized meaning, without further inquiry being necessary. The phrase is also capable of having many different meanings. The overall composite word mark consisting of a slogan or phrase should be considered as registrable. The combination of the above factors provides for an even more compelling case that the mark is not merely descriptive. As supported by case law, the Trademark Manual of Examining Procedure, and each of the foregoing reasons, it is submitted that passage to publication is appropriate.

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I hereby certify that this paper is being electronically filed with the United States Patent and Trademark Office on this 29th day of November, 2019.

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