

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : IDEXX Laboratories, Inc. Law Office : 120
Serial No. : 88/335,584 Examiner : Benjamin Rosen, Esq.
Filed : March 12, 2019
Mark : **PRE-TIME CARE**

RESPONSE TO OFFICE ACTION

This is in response to the Office Action dated May 29, 2019 issued in connection with Application Serial No. 88/335,584 of the mark PRE-TIME CARE.

I. Amendment of Goods Description.

The Examining Attorney has requested clarification of the term “kits” in Class 10 on the basis that the term is indefinite and must be clarified. Specifically, the Examining Attorney argues that “kits” requires clarification so that it complies with the standards listed in the Office Action, namely:

For kits consisting of a group of components that share a common theme, the identification should specify the theme followed by the wording “comprising” or “comprised of” and a list of the components that make up the kit, with all of the components in the predominant class listed first. See *id.* Generally, a kit is classified in the same international class as the majority of the components in the kit. See *id.* For example, “nail care kits comprised of nail polish, nail polish remover, false nails, nail files, and printed instructions” are in International Class 3, the class of the kits’ primary components which are listed first in the kits’ components (with “nail files” in International Class 8, and “printed instructions” in International Class 16 listed after the International Class 3 components).

Applicant respectfully disagrees, and requests reconsideration of this refusal on the basis that the recitation of goods complies with these standards.

The applied for goods read as follows:

Class 10: Veterinary specimen collection kit comprising of a collection spoon and cup for submission of samples of biological material for testing.

Here, it is clear that the “kits” are for veterinary specimen collection, and that the kits are made up of a spoon for collecting the veterinary specimen and a cup for submission (for veterinary

testing purposes) of the veterinary biological material that was collected. Applicant submits that this recitation of goods complies with the standard set forth in the Office Action and as such does not require further clarification.

Applicant submits that the foregoing amendment should satisfactorily address the Examining Attorney's concerns regarding the goods description.

II. Request for Information.

In response to the Examining Attorney's request for information, Applicant responds as follows:

Question 1: What is the significance of the wording "PRE-TIME" in applicant's mark?
Answer 1: "PRE-TIME" has no established meaning in the veterinary industry.

Question 2: Do applicant's competitors use the wording PRE-TIME to advertise similar goods and/or services?

Question 2: Applicant is unaware of any competitors using the wording PRE-TIME to advertise similar goods and/or services.

With Applicant's response to the Examining Attorney's inquiries, Applicant respectfully submits that the requests for information have been satisfied.

III. Disclaimer Request.

The Examining Attorney has requested that Applicant disclaim the term "CARE" on the basis that it is not inherently distinctive because "CARE" is at best "merely descriptive of an ingredient, quality, characteristic, function, feature, purpose, or use of applicant's goods and/or services." To support this refusal, the Examining Attorney has submitted evidence showing that "CARE" means "painstaking or watchful attention" and "to give care," as in "care for the sick."

The TTAB has held that a term is descriptive if it *immediately* describes an ingredient, quality, characteristic, or feature thereof, or if it *directly* conveys information regarding the nature, function, purpose, or use of the goods or services to which it is applied. *Plyboo America*

Inc. v. Smith & Fong Co., 51 USPQ.2d 1633, 1640 (T.T.A.B. 1999); *In re MetPath Inc.*, 223 USPQ 88, 89 (TTAB 1984). Further, a term is merely descriptive if it tells the potential customer **only** what the goods are, their ingredients, qualities, or characteristics. *In re Quik-Print Copy Shops, Inc.*, 616 F.2d 523, 527 n. 7, 205 USPQ 505, 507 n. 7 (CCPA 1980) (noting that “merely” is considered to be “only”). Further, it is well established that the burden is on the Examining Attorney to prove descriptiveness (*See, e.g., In re Merrill, Lynch, Pierce, Fenner & Smith*, 828 F.2d 1567, 4 U.S.P.Q.2d 1141, 1143 (Fed. Cir. 1987).), and that doubts are to be resolved in favor of the Applicant. *See, e.g., In re Rank Organization, Ltd.*, 22 U.S.P.Q. 324, 326 (TTAB 1984).

In this case, there has been no evidence submitted that the term “CARE” **immediately** describes a characteristic of Applicant’s goods. Nor does it **directly** convey information regarding the nature of Applicant’s goods. And it certainly does not tell a consumer **only** what Applicant’s goods and services are.

Further, given that the line between a descriptive and a suggestive term can be tenuous, the TTAB has stated that any doubt as to the degree of distinctiveness of the mark should be resolved in favor of the Applicant. *See In re Donell, Inc.*, 2004 TTAB LEXIS 597, *4 (T.T.A.B. 2004); *In re On Technology Corp.*, 41 U.S.P.Q.2d 1475, 1477 (T.T.A.B. 1977); *In re Gourmet Bakers, Inc.*, 173 U.S.P.Q. 565 (T.T.A.B. 1972); *In re Rank Organization Ltd.*, 222 U.S.P.Q. 324 (T.T.A.B. 1984).

Finally, it is well established that the Examining Attorney is required to support a refusal with appropriate evidence. TMEP §1209.02. The burden of showing that a term is merely descriptive lies solely with the Examining Attorney. Applicant respectfully submits that the Examining Attorney has not presented any evidence showing that the term “CARE” is a

commonly used or recognized descriptive term for the goods and services provided by Applicant. As such, Applicant respectfully submits that the Examining Attorney has not met his burden.

Given all of the above, it is clear that the term “CARE” is not merely descriptive, and is at worst suggestive of Applicant’s goods and services. Applicant respectfully requests that the Examining Attorney withdraws the request for disclaimer of the term “CARE.”

IV. Conclusion.

It is submitted that the application is in condition for publication, and early favorable action is requested.