

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Mark: SMILE DIRECT CLUB  
Serial No.: 88/356,711  
Filing Date: March 26, 2019  
Int. Class: 35  
Applicant: SmileDirectClub, LLC  
Attention: Rebecca Eubank  
Examining Attorney  
Law Office 116

**RESPONSE TO OFFICE ACTION DATED JUNE 7, 2019**

This responds to the Office Action dated June 7, 2019 concerning the application for SMILE DIRECT CLUB (the “**Mark**”), Serial No. 88/356,711 (the “**Application**”) by SMILEDIRECTCLUB, LLC (the “**Applicant**”). First, the Examining Attorney requested an amendment to the applied-for services. Second, the Examining Attorney requested a disclaimer of the wording “DIRECT CLUB” used in the Mark. Each objection is addressed in turn below.

**REMARKS**

**Amendment**

Applicant is amending the Class 35 services on the electronic response form in the following manner (additions in **bold** and deletions in ~~strikethrough~~):

- Retail outlets featuring dental impression kits, orthodontic and dental supplies, giftware, and ~~access to~~ **also coordinating treatment by** licensed dental professionals **through teledentistry**; online retail store services featuring dental impression kits, orthodontic and dental supplies, giftware, gift cards, and clothing and accessories.

(The “Applied-For Services”)

Applicant believes this amendment is sufficiently specific and that it clarifies the identification without expanding or adding to the services. *See* 37 C.F.R. § 2.71(a). Thus, Applicant respectfully requests that the amended identification of services be accepted.

### **Disclaimer**

Applicant seeks to register the mark SMILE DIRECT CLUB in Class 35 for the Applied-For Services. The Examining Attorney has requested that Applicant disclaim the wording “DIRECT CLUB” as descriptive of a quality, characteristic, function, feature, purpose, or use of Applicant’s services. In response, Applicant respectfully submits that the phrase “DIRECT CLUB” is suggestive, rather than merely descriptive, when used in the context of the Applied-For Services. Applicant explains its position more fully below.

**a. The Phrase “DIRECT CLUB” Does Not *Directly and Immediately* Describe Applicant’s Services.**

A mark is deemed to be merely descriptive only if it conveys a direct and immediate idea of an ingredient, quality, characteristic, feature, function, purpose, or use of the goods or services. *See, e.g., In re Abcor Development Corp.*, 588 F.2d 811, 814 (C.C.P.A. 1978). If, on the other hand, one must “follow a *multi-stage* reasoning process in order to determine what product or service characteristics the term indicates, the term is *suggestive* rather than merely descriptive.” *In re Tennis in the Round Inc.*, 199 U.S.P.Q. 496, 498 (T.T.A.B. 1978) (holding TENNIS IN THE ROUND not descriptive of tennis facilities) (emphasis added). Applicant respectfully submits that the phrase DIRECT CLUB does not directly and immediately describe the purpose or function of Applicant’s services.

The critical element in this standard is “directly and immediately.” It is axiomatic that one may be informed by suggestion as well as description. *See, e.g., In re George Weston Ltd.*, 228 U.S.P.Q. 57, 58 (T.T.A.B. 1985) (SPEEDI BAKE is suggestive, not merely descriptive, of

desirable characteristic of dough that quickly bakes into bread); *Jeno's Inc. v. Commissioner of Patents and Trademarks*, 227 U.S.P.Q. 227, 228 (D.Minn. 1985) (PIZZA ROLLS suggestive of snack rolls); *In re Shutts*, 217 U.S.P.Q. 363, 365 (T.T.A.B. 1983) (SNO RAKE suggestive of snow removal hand tool); *In re Pennwalt Corp.*, 173 U.S.P.Q. 317, 319 (T.T.A.B. 1972) (DRI-FOOT suggestive of applicant's goods). If, however, some operation of imagination, thought, or perception is necessary to reach a conclusion as to the nature or quality of the goods or services, the mark (or portion thereof) is suggestive, not merely descriptive. *In re George Weston Ltd.*, 228 U.S.P.Q. at 58.

Here, the phrase DIRECT CLUB is not merely descriptive because some operation of imagination or thought is required for consumers to discern the nature or qualities of Applicant's services. The phrase DIRECT CLUB when used as part of the Mark as a whole does not directly or immediately inform consumers that Applicant offers retail services featuring dental impression kits, orthodontic and dental supplies, giftware, or that Applicant coordinates treatment by licensed dental professionals through teledentistry, or that Applicant provides online retail store services featuring the same or similar goods or services. It would not be immediately or directly clear to the average purchaser what the phrase DIRECT CLUB in the context of the Mark as a whole conveys with respect to the Applied-For Services. Instead, consumers viewing the phrase within the Mark as a whole must engage in a "multi-stage reasoning process" to make a connection between the literal meaning of the entire Mark and the Applied-for Services.

As an initial matter, Applicant respectfully notes that the nature of the Applied-For Services offered under the Mark have not been accurately portrayed in the Office Action. The Office Action suggests that the Mark is used on services sold by "a commercial organization offering subscribers special benefits." That is incorrect, however. Applicant does *not* require

individuals to join any sort of club or mailing list – or even to sign up to receive Applicant’s clear aligners – before they can access or utilize Applicant’s applied-for retail services. Instead, any visitors to Applicant’s website or physical retail locations may access the Applied-For Services, because there is no actual “club” involved with the provision of the Applied-For Services. Applicant’s Mark is intended to suggest to its consumers that associating with Applicant will allow them to show they are part of the proverbial “in crowd,” who are (or who plan to) increase their confidence and appearance with straighter teeth. Applicant’s urging of consumers to “join the club” is a conceit, employing the bandwagon propaganda advertising technique. The Mark suggests that by utilizing Applicant’s retail store services to purchase dental impression kits, orthodontic and dental supplies, giftware, or to coordinate treatment by licensed dental professionals through teledentistry, etc. consumers can join the cool crowd of others who wish to – or are – straightening their teeth.

To support the idea that the phrase DIRECT CLUB is descriptive, the Examiner relies on the Merriam-Webster Dictionary and the Oxford Dictionary for the definitions of “direct” and “club” respectively. Instead of proving that “DIRECT CLUB” as a whole is descriptive of the Applied-For Services, however, the identified definitions underscore the suggestive nature of the phrase when used with the Applied-For Services. The dictionaries show that both of the terms “direct” and “club” can have a variety of different meanings in business, mathematics, science, sports, and astronomy (among others) – none that directly or immediately describe Applicant’s Applied-For Services. Notably, neither dictionary provides a definition for the combination of terms “direct” and “club,” let alone one that directly or immediately relates to the applied-for retail store services.

Simply because the Applied-For Services are available to consumers from Applicant's website or physical locations does not mean that its services are any more "direct" than those of any other on-line retailer, or, indeed, any store that one enters to purchase similar items directly from the manufacturer. Further, because Applicant does not actually run or maintain a club, or offer club membership services, the use of "club" in the mark is vague and requires some thought and imagination to understand. Consumers may have any number of reasons for engaging with Applicant's services, and may have no common interest in Applicant's other services available to others, refuting the idea that the Applicant's business is a "club."<sup>1</sup>

Beyond this, the list of meanings submitted in support of the Office Action underscores the myriad of meanings for the word "club," none of which point directly or immediately to Applicant's Applied-For Services. For example, "club" can refer to an entertainment venue, a sports team, a weapon, or a suit of playing cards. Meanwhile, the list of definitions for "direct" indicates that it can mean "proceeding by the shortest way" as well as "natural; straightforward." These alternative definitions could have just as much, if not more, relation to Applicant's brand and the Applied-For Services (*e.g.*, Applicant's services allow customers to tell their friends in a direct, "straightforward" way about how and where they can straighten their teeth, or tell their friends about how they can reach towards the goal of perfect teeth directly or in the shortest amount of time). The sheer number of possible meanings that *could* be attributed to Applicant's use of "direct" in combination with "club" means that a multi-step process will be required for consumers

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<sup>1</sup> Applicant respectfully notes that in other instances, the Office has allowed registration of CLUB-formative marks **without a disclaimer of "club."** where the applied-for goods and services were not in the nature of club services. These prior (recent) registrations are instructive here. *See, e.g.*, Reg. No. 5,703,169 (DIGITAL FIGHT CLUB for entertainment services); Reg. No. 5,697,067 (EAU CLUB for robes); Reg. No. 5,696,700 (RANG CLUB for hats and t-shirts); Reg. No. 5,689,794 (EASY SUNDAY CLUB & design for blankets and bedding); Reg. No. 5,679,467 (BITTERS CLUB & design for alcoholic bitters); Reg. No. 5,439,493 (THE A.V. CLUB for entertainment services); Reg. No. 5,704,895 (PATRIOTS CLUB for on-line retail and wholesale services); all included at Composite **Exhibit A**.

to determine how the phrase DIRECT CLUB within the Mark as a whole relates to Applicant's services. Consumers will have to stop, recall the number of possible meanings for both the terms "direct" and "club," reason through a number of possible connotations for the combined phrase DIRECT CLUB within the context of the Mark as a whole, and consider how those connotations relate to the Applied-For Services in order to reach the precise connotation conveyed by the Mark. This undoubtedly requires a multi-step cognitive process.

The bottom line is that none of the identified definitions for "club" or "direct," on their own, or when seen in the context of the full SMILE DIRECT CLUB mark, immediately or directly describe Applicant's services in *any* way. Instead, consumers will have to make the rather sizeable leap from "direct club" to the applied-for retail store services.

**b. Competitors Do Not Need to Use the Phrase "DIRECT CLUB" to Describe Similar Services.**

The Board has held that if a competitor does not need to make use of a particular turn of phrase to describe competitive goods or services, then the phrase is generally deemed suggestive, rather than descriptive, for trademark purposes. *See, In re Minnesota Mining & Manufacturing Co. v. Johnson & Johnson*, 172 U.S.P.Q. 491 (T.T.A.B. 1972) (the term SKINVISIBLE for transparent medical adhesive tape not needed by competitors); *In re Reynolds Metal Co.*, 178 U.S.P.Q. 296 (C.C.P.A. 1972) (BROWN N' BAG is suggestive for plastic bags and would not prevent competitors from informing buyers that goods may be browned in bags). Moreover, the fact that others in the industry do not use a particular phrase to describe their own goods or services is evidence (albeit by omission) that the term is suggestive rather than descriptive. *See, e.g., In re T.B.G., Inc.*, 229 U.S.P.Q. 759 (T.T.A.B. 1996); *Firestone Tire & Rubber Co. v. Goodyear Tire & Rubber Seal*, 186 U.S.P.Q. 557 (T.T.A.B. 1975); *In re Sweet Victory, Inc.*, 228 U.S.P.Q. 959, 961 (T.T.A.B. 1986). Here, the record is devoid of any evidence that competitors in the business of

providing retail services relating to dental impression kits, orthodontic and dental supplies, giftware, and coordinating treatment by licensed dental professionals through teledentistry, etc. use the phrase DIRECT CLUB to describe, or inform consumers about, their own services.

**c. Applicant Owns a Number of Other US Filings that do not Disclaim DIRECT CLUB.**

A review of the USPTO trademark register supports Applicant’s contention that DIRECT CLUB is at least suggestive and not merely descriptive of the Applied-For Services. Applicant owns at least the following US registrations or approved US applications for SMILE DIRECT CLUB word or design marks that **do not** include a disclaimer or a partial claim of acquired distinctiveness for the phrase DIRECT CLUB. Copies of the registration certificates and TSDR records for the filings set out below are attached hereto as **Exhibit B**.

<b>SMILE DIRECT CLUB Active Registrations/Approved Applications Without a Disclaimer or Partial 2(f) Claim for DIRECT CLUB</b>	
<b>Mark &amp; Reg./App. No.</b>	<b>Class &amp; Goods and Services</b>
SMILE DIRECT CLUB Reg. No. 5926755	09: Portable selfie lights for use in mobile phone photography; magnetically encoded gift cards; downloadable gift cards for digital delivery 14: Rubber or silicone wristbands in the nature of a bracelet 25: Clothing, namely, T-shirts, sweatshirts and hoodies
SMILE DIRECT CLUB Reg. No. 5827012	18: Tote bags
SMILE DIRECT CLUB Reg. No. 5866425	21: Insulated containers for food or beverage for domestic use; coffee mugs; water bottles sold empty
SMILE DIRECT CLUB Reg. No. 5848278	44: Consultation services in the field of dentistry and orthodontia; providing information in the field of orthodontics; orthodontic scanning services; 3D scanning services using dental apparatus for dimensional measurement; dental and orthodontic evaluation and assessment services; web-based dental and orthodontic assessment services, namely, a series of dental-related questions for response from the user that result in a report providing a recommended course of orthodontic treatment and treatment information; teledentistry services
SMILE DIRECT CLUB Reg. No. 5848360	40: Custom manufacture of teeth aligners; custom manufacture of orthodontic retainers

<p>SMILE DIRECT CLUB Reg. No. 5848277</p>	<p>05: Dental impression materials</p>
<p><b>smile</b> DIRECT CLUB</p> <p>SMILE DIRECT CLUB &amp; design Reg. No. 5904249</p>	<p>40: Custom manufacture of teeth aligners; custom manufacture of orthodontic retainers</p>
<p><b>smile</b> DIRECT CLUB</p> <p>SMILE DIRECT CLUB &amp; design Reg. No. 5866424</p>	<p>21: Insulated containers for food or beverage for domestic use; coffee mugs; water bottles sold empty</p>
<p><b>smile</b> DIRECT CLUB</p> <p>SMILE DIRECT CLUB &amp; design Reg. No. 5904213</p>	<p>44: Consultation services in the field of dentistry and orthodontia; providing information in the field of orthodontics; orthodontic scanning services; 3D scanning services using dental apparatus for dimensional measurement; dental and orthodontic evaluation and assessment services; web-based dental and orthodontic assessment services, namely, a series of dental-related questions for response from the user that result in a report providing a recommended course of orthodontic treatment and treatment information; teledentistry services</p>
<p><b>smile</b> DIRECT CLUB</p> <p>SMILE DIRECT CLUB &amp; design Reg. No. 5904212</p>	<p>05: Dental impression materials</p>
<p><b>smile</b> DIRECT CLUB</p> <p>SMILE DIRECT CLUB &amp; design Reg. No. 5827013</p>	<p>18: Tote bags</p>



<p><b>smile</b> DIRECT CLUB</p> <p>SMILE DIRECT CLUB &amp; design Reg. No. 5926756</p>	<p>09: Portable selfie lights for use in mobile phone photography; magnetically encoded gift cards; downloadable gift cards for digital delivery 14: Rubber or silicone wristbands in the nature of a bracelet 25: Clothing, namely, T-shirts, sweatshirts and hoodies</p>
<p>SMILE DIRECT CLUB App. No. 87908507 Status: Notice of Allowance Issued</p>	<p>09: Downloadable software in the nature of a mobile application for collecting and tracking patient data, interacting with patients, scheduling appointments for orthodontic treatment and assessment, and providing patient account details, treatment plans and information related to courses of orthodontic treatment; Downloadable software in the nature of a mobile application for photo editing and providing customized previews of results to be expected from orthodontic treatment plans</p>
<p><b>smile</b> DIRECT CLUB</p> <p>SMILE DIRECT CLUB &amp; design App. No. 87927042 Status: Notice of Allowance Issued</p>	<p>09: Downloadable software in the nature of a mobile application for collecting and tracking patient data, interacting with patients, scheduling appointments for orthodontic treatment and assessment, and providing patient account details, treatment plans and information related to courses of orthodontic treatment; Downloadable software in the nature of a mobile application for photo editing and providing customized previews of results to be expected from orthodontic treatment plans</p>
<p>SMILE DIRECT CLUB App. No. 88268864 Status: Published for Opposition</p>	<p>41: Providing a website featuring blogs, non-downloadable videos and non-downloadable publications in the nature of articles and posts in the fields of lifestyle, beauty, health, diet, wellness, orthodontia and oral health; training and educational services, namely, providing classes, online non-downloadable educational videos, and in-person training programs in the fields of dentistry and orthodontia and distributing educational materials in connection therewith</p>
<p><b>smile</b> DIRECT CLUB</p> <p>SMILE DIRECT CLUB &amp; design App. No. 88270716 Status: Published for Opposition</p>	<p>41: Providing a website featuring blogs, non-downloadable videos and non-downloadable publications in the nature of articles and posts in the fields of lifestyle, beauty, health, diet, wellness, orthodontia and oral health; training and educational services, namely, providing classes, online non-downloadable educational videos, and in-person training programs in the fields of dentistry and orthodontia and distributing educational materials in connection therewith</p>

These US registrations and approved applications demonstrate that the Trademark Office regularly treats Applicant's wording DIRECT CLUB in the Mark to be suggestive rather than descriptive of Applicant's various goods and services. The same should be the case for the Applied-For Services, especially considering the Applied-For Services encompass a number of the goods and services already registered or approved for registration under SMILE DIRECT CLUB marks without a disclaimer or partial acquired distinctiveness claim for DIRECT CLUB. *See* 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 11:69 (4th ed. 2016) (stating that other marks may in some cases support the argument that a designation is not descriptive and that the fact that the USPTO registered a number of other marks containing the same designation without requiring proof of secondary meaning is some evidence that the USPTO considers the designation not descriptive). And, although each case must be decided on its own merits, Applicant respectfully requests that the Examining Attorney act consistently with the USPTO's prior decisions and deem the phrase DIRECT CLUB suggestive rather than descriptive to ensure uniform treatment in assessing the registrability of Applicant's marks. *See In re Nett Designs, Inc.*, 236 F.3d 1339, 1342, 57 U.S.P.Q.2d 1564, 1566 (Fed. Cir. 2001) ("Needless to say, this court encourages the PTO to achieve a uniform standard for assessing registrability of marks.").

**d. Doubts Should Be Resolved in Applicant's Favor**

The line between marks that are suggestive and those that are merely descriptive is often a fine one. *In re conductive Systems, Inc.*, 220 U.S.P.Q. 84, 86 (T.T.A.B. 1983). For this reason, the Board takes the position that the "suggestive" threshold is relatively low. *In re Southern Nat'l Bank of North Carolina*, 219 U.S.P.Q. 1231 (1983) (holding test requires only "some degree of imagination"; finding MONEY 24 suggestive for "automated teller services"; reversing refusal of registration). Furthermore, the Board has noted that if there is any doubt as to whether a mark is

merely descriptive, “it is clear that such doubts are to be resolved in favor of applicants.” *In re Shutts*, 217 U.S.P.Q. 363, 365 (T.T.A.B. 1983). While Applicant believes that no doubts should remain as to whether the phrase DIRECT CLUB is suggestive rather than descriptive, especially considering all of the prior SMILE DIRECT CLUB filings approved without a disclaimer for DIRECT CLUB, Applicant respectfully submits that any doubts the Examining Attorney may have be resolved in its favor.

### **CONCLUSION**

For the foregoing reasons, Applicant believes it has addressed all of the issues raised in the Office Action, and respectfully requests that this Application be placed in the publication queue.

*Signature page follows*

December 7, 2019

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