

The Examining Attorney has refused registration of the application on the grounds that Applicant's mark is merely descriptive of the services. Applicant respectfully disagrees with the Examining Attorney's descriptiveness refusal and responds as follows:

Applicant's Mark Has Acquired Distinctiveness Through Continuous Use in Commerce

Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f), provides that "proof of substantially exclusive and continuous use" of a designation "as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made" may be accepted as *prima facie* evidence that the mark has acquired distinctiveness as used with the applicant's goods in commerce. The applied-for mark has been continuously used in commerce since at least as early as August 1, 2005.

Applicant's Mark Is Not Merely Descriptive as a Whole, But Rather Is At Worst Suggestive.

Suggestive terms may shed light upon, but do not directly describe, the characteristics of the goods or services. When applied to the goods or services, suggestive terms involve an element of incompleteness and require the effort of imagination on the part of the observer. General Shoe Corp. v. Rosen, 111 F.2d 94, 45 U.S.P.Q. 196 (4th Cir.), *reh. denied*, 112 F.2d 561, 45 U.S.P.Q. 590 (4th Cir. 1940). Indeed, that a consumer may understand the suggestion implied by the mark does not render the mark merely descriptive. See In re Nalco Chemical Co., 228 U.S.P.Q. 972, 973 (T.T.A.B. 1986) (holding that VERI-CLEAN is suggestive, and not merely descriptive, of the applicant's cleaning additives.) See also, 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); In re Shutts, 217 U.S.P.Q. 363, 365 (T.T.A.B. 1983) (SNO-RAKE is suggestive, not merely descriptive, of snow removal hand tool); In re Pennwalt Corp., 173 U.S.P.Q. 317, 319 (T.T.A.B. 1972) (DRI-FOOT is suggestive, not merely descriptive, of foot anti-perspirant); In re Pointcast Inc., 1999 WL 651584 (T.T.A.B. 1999) (SMART SCREEN for computer software for composing a dynamic animation screen saver, as the mark was not descriptive. "In the case now before us, applicant did not apply for the mark SMARTSCREENSAVER for its goods or for the mark SMART SCREEN for screens for computer video monitors."); In re Casino Data Systems, 1998 WL 663311 (P.T.O. 1998) (DATAPORT not merely descriptive of computer hardware for gaming machines. The Examining Attorney's evidence that the words "data port" were used in relatively close proximity to the word "microcontroller" was insufficient to show that the mark was merely descriptive of the applicant's goods).

Any Doubts Regarding the Question of Whether a Mark is Descriptive or Suggestive Should Be Resolved in Applicant's Favor.

Any doubts regarding the question of whether a mark is descriptive or suggestive should be resolved in Applicant's favor. "[T]here is a thin line between a suggestive and a merely descriptive designation, and where reasonable men 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 Morton-Norwich Products, Inc., 209 U.S.P.Q. 791 (TTAB 1981). The reason for this was explained by the Board in In re Gourmet Bakers, Inc.:

It has been recognized by this and other tribunals 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 on the theory that any person who believes that he would be damaged by the registration will have an opportunity under Section 13 to oppose the registration of the mark and to present evidence, usually not present in the *ex parte* application, to that effect. In re Gourmet Bakers, Inc., 173 U.S.P.Q. 565 (TTAB 1972).

With the above parameters in mind, Applicant believes that Applicant's Mark qualifies to be classified with a "suggestive" designation and thus should be registrable on the Principal Register.

It is well settled that where there is any doubt as to the character of the mark in question, that doubt must be resolved in favor of the Applicant. See In re Bel Paese Sales Co., 1 U.S.P.Q. 2d 1233, 1235-1236 (T.T.A.B. 1986); In re Bed-Check Corp., 226 U.S.P.Q. 946, 948 (T.T.A.B. 1985); In re Rank Organization Ltd., 222 U.S.P.Q. 324, 326 (T.T.A.B. 1984). Doubt is properly resolved by publishing the mark and allowing any person who believes he or she would be damaged by the registration of the mark to file an opposition. In re Bel Paese Sales Co., 1 U.S.P.Q. 2d at 1235. Therefore, if there is any doubt as to whether Applicant's Mark is merely descriptive, that doubt should be resolved in favor of Applicant, and the application should be published for opposition.

Finally, the Trademark Office has the burden of establishing the propriety of a refusal to register a mark. Hawes, *Trademark Registration Practice*, § 7:3, at 7-10; In re Leatherman Tool Group Inc., 32 U.S.P.Q. 2d 1443 (T.T.A.B. 1994); In re Gourmet Bakers, Inc.. For descriptiveness refusals, the Trademark Office must establish a *prima facie* case that the term sought to be registered is descriptive. See In re Etablissements Darty et Fils, 759 F.2d 15, 225 U.S.P.Q. 652, 653 (Fed. Cir. 1985). Here, Applicant submits that the Examining Attorney has not met the Trademark Office's burden, and that Applicant's Mark should be approved for publication.