

Dear Examiner Rebecca Eubank,

We write in response to the Office Action dated September 5, 2019 for Applicant's U.S. Trademark Application No. 88/464,072 for "SAMPLESTREAM" (hereinafter referred to as "Applicant's Mark"). Applicant hereby responds to the issues raised in the Office Action as follows.

SECTION 2(e)(1) REFUSAL – MERELY DESCRIPTIVE

The September 5, 2019 Office Action refused registration of Applicant's Mark under Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1); TMEP §§ 1209.01(b), 1209.03 et seq. because it is claimed that Applicant's Mark merely describes the purposes of the goods applied-for.

Applicant respectfully disagrees with this assertion for the two following reasons: (1) Applicant's Mark is not Merely Descriptive and does not merely describe a purpose of the goods offered under SAMPLESTREAM and (2) other Trademarks have been registered on the Principal Register that are more suggestive of the goods and services provided, but were not considered merely descriptive by the Trademark Examiner.

Applicant's Mark Is Not Merely Descriptive And Does Not Merely Describe A Purpose Of The Goods Offered In Connection With The SAMPLESTREAM Trademark

Whether a mark is weak and descriptive or strong and distinctive can be determined only by reference to the goods or services that it identifies, not in the abstract. To determine if a mark is weak or strong, one must examine the mark in its entirety, not piece by piece. *See California Cooler, Inc. v. Loretto Winery, Ltd.*, 774 F. 2d 1451, 1455 (9th Cir. 1985).

Unlike Merely Descriptive and Generic Trademarks, a Trademark that is Fanciful, Arbitrary, or Suggestive is considered to be inherently distinctive, and thus qualifies for trademark protection in the Principal Register basis under 15 U.S.C. §1051. A Merely Descriptive Mark is one that describes an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant's goods (TMEP §1209.01 (b)) whereas a Suggestive Mark is one which, when applied to the goods or services at issue, requires imagination, thought, or perception to reach a conclusion as to the nature of those goods or service. Therefore, "if a consumer must use imagination or any type of multistage reasoning to understand the Mark's significance, then the Mark does not describe the product's features, but suggests them". See *Kendall-Jackson Winery, Ltd. v. E. & J. Gallo Winery*, 150 F.3d 1042, 1047 n. 8, 9th Cir. 1998. In other words, Suggestive Marks are the ones that "connote, without describing, some quality, ingredient, or characteristic of the product". See *OBX-Stock*, 558 F.3d at 340.

Applicant's Mark is for use with goods in International Class 009 for "*Scientific apparatus configured to filter, concentrate, and purify substances using an accompanying membrane having particular selectivity qualities; Automated scientific apparatus configured to filter, concentrate, and purify substances using an accompanying membrane having particular selectivity qualities*".

It is logical for certain words or terms to be generic or merely descriptive of Applicant's goods, such as "filtration device", "purification device", "concentration device", "membrane-based processor", and other terms that inform an observer as to what the goods do or how they function. None of these descriptive and generic terms are used by the Mark. Instead, Applicant uses a single word consisting of the words "SAMPLE" and "STREAM" combined to brand its apparatus that processes, filters, concentrates, and purifies various molecules based on molecular characteristics.

The Office Action indicates that the definition of “SAMPLE” is “a representative part or a single item from a larger whole or group essentially when presented for inspection or shown as evidence of quality”. The Office Action defines “STREAM” as “an unbroken flow, as of gas or particles of matter”. However, Applicant’s SAMPLESTREAM apparatus, although it does process a SAMPLE” is not a “sample stream” and does not use or process a “sample stream” or “stream of samples”, as alleged by the Office Action.

As detailed in Applicant’s Miscellaneous Statement, which provides the information requested by the Office Action about Applicant’s goods, the substances entered into Applicant’s goods are “analytes”, not a sample stream. Applicant’s apparatus operates on discrete boluses of injected matrices containing analytes (combined, referred to as a “sample”), not a continuous flow of matrix containing an analyte. In other words, there is a sample, but it is not in a stream and there is no stream of samples. Applicant’s apparatus does not operate in modes analogous to conventional filtration techniques where a continuous feed stream is processed. Applicant’s apparatus operates on discrete volumes that are introduced is an injection event, followed by a processing event, followed by an elution event. Each of these steps is functionally disconnected. The system does not operate on a continuous “stream”.

The most expansive reading as to what the apparatus actually does with respect to “sample streams” is that it interacts with what the Office Action argues is a sample stream. In actuality, the solution flowing through the apparatus is not properly described as a “sample stream”, but more fairly described as a solution comprising molecules that a user may wish to isolate or remove from the solution. Thus, it takes a mental leap for a potential consumer to observe the SAMPLESTREAM Mark and jump to a conclusion as to what the product might be.

In addition, the terms “sample” and “stream” have many other definitions that are not related to the goods offered under SAMPLESTREAM. Indeed, the Merriam-Webster also defines the term “SAMPLE” as a test, an illustration, and a musical sound of short duration digitally stored in a synthesizer for playback. The term “STREAM” has also the meaning of a narrow river, a video or audio material transmitted or received over the Internet. None of these words are related to the goods offered under SAMPLESTREAM. For example, the Google Search for “sample stream”, attached as Exhibit 1, shows websites for movie streaming. Thus, when the average consumer searched for “sample stream” on the Internet, the first thing they might encounter is not an apparatus that filters, concentrates, and/or purifies substances, but websites that allow them to watch movies online. To highlight the difference between “sample stream” and SAMPLESTREAM, when “SAMPLESTREAM” is entered into Google, the searcher will find articles concerning the goods offered under SAMPLESTREAM, as shown in the attached Exhibit 2. There is no link that leads to products or services offered by other entities using the terms “sample” or “stream” because other entities are simply not using these terms to describe their products. Thus, not only is SAMPLESTREAM not merely descriptive of the goods offered thereunder, but SAMPLESTREAM is already distinct from the words “sample” and “stream” separated by a space. For all these reasons, “SAMPLESTREAM” is not descriptive of the goods offered thereunder.

Moreover, SAMPLESTREAM as a composite word has no definition, it is a term created by Applicant. Applicant has used thought, imagination, and perception to choose this term. Accordingly, it takes thought, imagination, and perception for consumers to reach the conclusion that SAMPLESTREAM is an apparatus that comprises a solid rigid body, a hollow inner portion, a membrane, and is configured to allow a solution to be pumped through the apparatus and across the membrane.

Accordingly, it is simply improper to conclude that the term SAMPLESTREAM is merely descriptive of the goods offered thereunder.

Applicant respectfully suggests that it might be best if Applicant Disclaim the word SAMPLE, since it is arguably descriptive, and then the Applicant be allowed to register on the Principal Register.

Other Suggestive Trademarks that are More Descriptive than Applicant's Mark have been Registered on the Principal Register

Numerous Trademarks that are descriptive of the goods and/or services applied-for, and that are moreover more descriptive of the goods and services than Applicant's Mark is of the goods offered thereunder, have been registered on the Principal Register and therefore were found by the Trademark Office to be not merely descriptive, but rather suggestive.

First, the Mark EXTEND YOUR BEAUTY, Reg. No. 3,320,377 used for eyelash extensions, attached hereto as Exhibit 3, has been viewed as suggestive. Indeed, even if "EXTEND" describes a function of the product applied-for, namely, extending eyelashes, none of the words "EXTEND", "YOUR" and "BEAUTY" relate to eyelash enhancements. Moreover, the three-word mark, viewed as a whole, has no dictionary meaning and has even less the meaning of eyelash enhancement. EXTEND YOUR BEAUTY for eyelash extensions therefore suggests the function of eyelash extensions, namely, improving physical appealing, but does not directly describe the function of eyelash extensions. It takes a mental leap for consumers to reach this conclusion. Therefore, just like EXTEND YOUR BEAUTY, SAMPLESTREAM should also be viewed as suggestive rather than descriptive.

A second example, WET ONES, Reg. No. 2,634,716 for hand wipes, attached hereto as Exhibit 4, has been found to be suggestive. Even though the words "WET" and "ONES" describe attributes of the moist towelette products offered thereunder, the term "WET ONES" does not itself evoke the image or impression of a moist

towelette, but could describe a wide variety of products. Therefore, WET ONES is suggestive and not descriptive. This same reasoning applies to SAMPLESTREAM.

A third example, ZEN HABITAT, Reg. No. 5,690,393 for providing spiritual and philosophical guidance in the field of personal lifestyle and organizing personal and home space, attached hereto as Exhibit 5, is also suggestive. Although it does not require a wide mental leap to reach the conclusion that ZEN HABITAT relates to creating a relaxing, spiritually peaceful home, ZEN HABITAT was registered on the Principal Register, as a Suggestive Mark and not a Descriptive Mark. The same reasoning applies to SAMPLESTREAM, which is suggestive rather than descriptive, and should therefore be granted Registration on the Principal Register.

Yet another example is WITE-OUT, Reg. Nos. 0,978,134 and 2,261,228 for correction pens, tapes and fluids, attached hereto as Exhibit 6. “The name WITE-OUT could be descriptive of correction products in that most of WITE-OUT products are white in color and used to take “out” a mistake. However, although the name WITE-OUT is logically related to its use, the phrase without more does not imply a correction product”. *BIC Corp. v. Far Eastern Source Corp., No. 99 Civ. 11385, 2000 U.S. Dist. LEXIS 18226, at *8 (S.D.N.Y. Dec. 19, 2000)*. Therefore, just like WITE-OUT, although the name SAMPLESTREAM may be related to samples, the phrase without more does not imply an apparatus that filters, concentrates, and/or purifies molecules and should therefore be seen as suggestive and allowed to Register on the Principal Register.

Another example, GLASS DOCTOR, Reg. No. 4,767,822 for window repair is attached hereto as Exhibit 7. Despite the fact that “GLASS DOCTOR” is very suggestive of window replacement and repairing services, the GLASS DOCTOR Mark is Registered on the Principal Register. Thus, “GLASS DOCTOR” is not merely descriptive. Therefore, Applicant’s Mark, which is less descriptive than

“GLASS DOCTOR” is also not merely descriptive and should be allowed to Register on the Principal Register.

There are also examples of Registered Trademarks that are a combination of words, which are more descriptive of their goods or services than the Applicant’s Mark is of Applicant’s goods. For example, NOBURST, Reg. No. 1,366,106 for liquid antifreeze and rust inhibitor for hot-water-heating systems, is submitted as Exhibit 8. NOBURST is found to suggest a desired result of using the product rather than immediately informing the purchasing public of a characteristic, feature, function, or attribute of the product. Therefore, NOBURST is suggestive and not descriptive. Just like NOBURST, SAMPLESTREAM suggests a purpose of the products applied-for and does not directly describe their purpose, so SAMPLESTREAM is suggestive rather than descriptive.

CONCLUSION

Applicant respectfully requests reconsideration of the registration of the mark and requests that it be allowed to pass for publication in the Official Gazette in light of the foregoing. To the extent that Examiner is not persuaded to allow registration on the Principal Register, Applicant requests an invitation to amend to the Supplemental Register. The Examiner is invited to contact Applicant’s undersigned counsel by e-mail at Marc@HankinPatentLaw.com or by telephone at (310) 892-1613 to expedite the prosecution of this case should there be any unresolved matters remaining.

Respectfully submitted,

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