

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Mark : OATIES
Serial No. : 88455173
Owner : Dr. Praeger's Sensible Foods, Inc.
Examining Attorney : Midge F. Butler
Law Office : 107

RESPONSE TO OFFICE ACTION DATED AUGUST 28, 2019

In the Office Action dated August 28, 2019, the Examining Attorney refused registration of the OATIES trademark as descriptive under Trademark Act Section 2(e)(1). Dr. Praeger's Sensible Foods, Inc. ("Dr. Praeger's" or "Applicant") respectfully submits that this refusal is in error because the applied-for mark is suggestive in relation to the goods claimed in the application, as amended.

As amended, the OATIES application ("Application") covers "*Grain based-breakfast foods, namely, cereal bars and French toast sticks.*" These amendments clarify that Dr. Praeger's goods are not solely focused on oats or oatmeal. Rather, Dr. Praeger's products are cereal bars and French toast sticks that contain a variety of ingredients that may not even include oats. Further, as discussed with the Examiner previously, it is clear that cereal bars and French toast sticks are often made of a variety of ingredients other than oats, indicating that OATIES is suggestive, rather than descriptive, of the goods covered in the application.

In the refusal, the Examining Attorney found that the term "OATIES" merely describes the ingredients used in Dr. Praeger's breakfast food goods covered by the Application. However, "OATIES" is an undefined term despite containing "oat" within it, and it can be used in a variety of suggestive ways, rather than just to describe one particular type of good or ingredient in the

baking community. The Examiner's own evidence indicates that the term is not linked to one ingredient, as the evidence shows it is used with a variety of different foods, including biscuits, cookies, dog treats, and baked goods. Since "OATIES" appears to be used in such a variety of ways, and because Applicant's cereal bars and French toast sticks obviously contain ingredients other than oats, the term "OATIES" is in fact suggestive of the goods covered by the application and functions properly as a source identifier.

The Trademark Trial and Appeal Board (the "Board") has stated the "concept of mere descriptiveness should not penalize coinage of...unused and somewhat incongruous word[s]...whose import would not be grasped without some measure of imagination and 'mental pause'". TMEP §1209.01(a), citing In re Schutts, 217 USPQ 363, 364-65 (TTAB 1983) (holding that SNO-RAKE was not merely descriptive of a snow removal hand tool). In addition, a mark does not have to be devoid of all meaning in relation to the goods offered thereunder in order to be registrable. TMEP §1209.01(a). Here, "OATIES" is an undefined term that only vaguely suggests the nature of the goods in the application. "If information about the product or service given by the designation is indirect or vague, requiring imagination and thought to get information about the product or service, then this indicates that the term is being used in a 'suggestive,' not descriptive, manner." J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS, §11:19. A consumer would have to exercise imagination and thought, after a mental pause, to determine the different ways that the term "OATIES" can be used in regards to cereal bars and French toast sticks. Given the lack of one clear definition for the term "OATIES" and the Examiner's evidence, which demonstrates its use with more than just oat, oatmeal, and grain-based foods, the OATIES mark is being used in a suggestive manner.

Instructive here is In re George Weston Ltd., 228 USPQ 57 (TTAB 1985), wherein the mark SPEEDI BAKE for frozen dough was found to be suggestive because it only vaguely suggested a desirable characteristic of frozen dough, namely, that it quickly and easily may be baked into bread. Also analogous is In re The Noble Co., 225 USPQ 749 (TTAB 1985), wherein the mark NOBURST for liquid antifreeze and rust inhibitor for hot-water-heating systems was found to be suggestive because it merely suggested a desired result of using the product rather than immediately informing the purchasing public of a characteristic, feature, function, or attribute. Just like these marks, the OATIES mark requires “imagination, thought, or perception to reach a conclusion as to the nature of the goods,” making OATIES a suggestive mark, rather than descriptive. TMEP §1209.01(a).

The OATIES mark, as a coined term that does not appear in any dictionary, creates a new and unique commercial impression in relation to cereal bars and French toast-based breakfast goods. For this reason, OATIES is not merely descriptive. TMEP §1209.03(d). Here, the fact that the products in the OATIES application are not specifically oatmeal, or comprised of oats, but may be made up of a combination of ingredients, makes the OATIES mark a suggestive term that will cause consumers to stop and exercise their imagination as to the mark’s meaning. Further, as stated above, given the fact that “OATIES” is not at all clearly defined in the baking industry, and given its use with such a variety of food products, as demonstrated by the Examiner’s evidence, including those for humans and animals, and the fact that it is not a defined term in general, it is clear that consumers must exercise “mature thought or follow a multi-stage reasoning process” to determine attributes of the products covered by the OATIES mark. In re Tennis in the Round Inc., 199 U.S.P.Q. 496 (TTAB 1978) (TENNIS IN THE ROUND held not descriptive of tennis facilities). Therefore, the OATIES mark is suggestive, not descriptive.

Because the connection between the OATIES mark and Dr. Praeger's goods is not immediate and apparent, the refusal of the OATIES application should be removed.

CONCLUSION

Where there may be doubt as to whether a mark is merely descriptive or in fact suggestive, precedent dictates that such doubt should be resolved in favor of the Applicant. In re Merrill Lynch, Pierce, Fenner & Smith, Inc., 828 F.2d 1567, 1571 (Fed. Cir. 1987); J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS, §11:51. In the present matter, OATIES is suggestive of the goods in Dr. Praeger's application, and, thus, Applicant respectfully requests that the Examiner remove the refusal and allow the Application to proceed to publication.