

## **APPLICANT'S SUBSTANTIVE RESPONSE TO OFFICE ACTION**

The subject application is for the FAST DRY standard character mark, bearing Serial No. 88460777 for “paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colorants; mordants; raw natural resins; metals in foil and powder form for painters and decorators” in International Class 2. The Examining Attorney has issued a non-final Office Action refusing registration pursuant to Trademark Act Section 2(e)(1), 15 U.S.C § 1052(e)(1), on the grounds that the FAST DRY mark is merely descriptive. For the following reasons, the Applicant respectfully disagrees and requests that the refusal be withdrawn and that the subject application be approved for publication.

### **I. FAST DRY is Not Merely Descriptive**

At the outset, to establish that a mark, term or phrase is merely descriptive, the correct test is whether it conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose, or use of the goods. The immediate idea must be conveyed forthwith with a “degree of particularity.” *In re TMS Corp. of the Americas*, 200 U.S.P.Q. 57, 59 (emphasis added). The mark, term, or phrase must give some “reasonably accurate or tolerably distinct knowledge of the essence of the goods”. If the information conveyed by the mark, term, or phrase is indirect or vague, it is being used in a suggestive rather than a descriptive manner. *See*, J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 11:19 (Ed. 2000). *See also*, *The Money Store v. Harris Corp. Finance, Inc.* 216 USPQ 11, 18 (Fed. Cir. 1982) (“‘THE MONEY STORE’ conveys the idea of a commercial establishment whose service involves supplying money. The term does not, however, necessarily convey ‘the essence of the business, money lending...Some imagination and perception are therefore required to identify the precise nature of the services...’”).

The Applicant submits that the mark when considered in its entirety in connection with the applied-for goods, is vague and not sufficiently direct or informative to be construed as *merely* descriptive. The Applicant further submits that the evidence presented by the Examining Attorney does not establish that the mark is merely descriptive in connection with the applied-for goods. For instance, the Examining Attorney’s evidence comprises dictionary definitions of the terms FAST and DRY. The Examining Attorney contends that the term FAST means “taking a comparatively short time” and the term DRY means “no longer sticky or damp”. However, the Examining Attorney failed to mention that FAST may also refer to ‘firmly fixed’ or ‘tightly shut’, and the term DRY may also refer to ‘functioning without lubrication’ or ‘lacking freshness’. Applicant does not dispute the information set forth in the Examining Attorney’s evidence. However, applicant respectfully submits that without some further imagination, thought or perception, a consumer would be unable to reach a conclusion as to the real nature and purpose of applicant’s goods, as the terms FAST DRY do not immediately convey a feature or characteristic of the applied-for goods.

Furthermore, a search of the United States Patent and Trademark Office (USPTO) records revealed various active registrations which comprise the term FAST in connection with goods in Class 2 and for which the USPTO did not require a disclaimer of same. Several examples of such active Registrations on the Principal Register (*i.e.* considered by the USPTO to

be sufficiently distinctive/capable of distinguishing the applicant's goods) are included in the below chart:

Mark/Reg. No./Register/Exhibit	Goods	Key Dates	Disclaimer
FAST FIX U.S. Reg. No. 4902736  Register: Principal EXHIBIT A	Class: 02 touch-up paint and primer	Filing Date: December 4, 2014  Registration Date: February 16, 2016	No Disclaimer Required
FAST SERV U.S. Reg. No. 4707713  Register: Principal EXHIBIT B	Class: 02 rust inhibiting preparations in the nature of a coating for use on vehicles; paints, primers and varnishes	Filing Date: July 28, 2014  Registration Date: March 24, 2015	No Disclaimer Required
FAST-CLAD U.S. Reg. No. 2730718  Register: Principal EXHIBIT C	Class: 02 protective and decorative coatings used in the nature of paint	Filing Date: September 21, 2001  Registration Date: June 24, 2003	No Disclaimer Required

The Applicant kindly reminds the Examining Attorney that when considering whether a term is suggestive or *merely* descriptive, the Trademark Trial and Appeal Board has recognized that to the extent there is any doubt, the doubt must be resolved in the favor of the Applicant by finding the term to be suggestive. *See, e.g., In re Morton – Norwhich Prod., Inc.*, 209 U.S.P.Q. 791 (TTAB. 1981) (holding COLOR CARE suggestive of a characteristic of laundry bleach rather than merely descriptive); *In re Mobile Ray Inc.*, 224 USPQ 247, 248 (TTAB 1984) (“[W]hen there is doubt in the matter, the doubt should be resolved in Applicant’s behalf and the mark should be published for opposition.”). In light of the above, the Applicant submits that as the term FAST was determined by the USPTO to not be merely descriptive on numerous occasions, it would be inappropriate and inconsistent to maintain the refusal in the subject application.

## II. FAST DRY has acquired distinctiveness amongst U.S. consumers

In the event that the Examining Attorney maintains the contention that the mark is merely descriptive of the applied-for goods in Class 2, Applicant submits concurrently herewith a declaration of acquired distinctiveness in part, based on its substantially exclusive and continuous use of FAST DRY as a trademark in commerce since at least as early as January 1, 2008, a period exceeding five years preceding the date of the application.

Accordingly, Applicant submits that a 2(f) claim should be accepted in the subject application for FAST DRY be allowed to proceed towards publication.