

OFFICE ACTION RESPONSE

On August 20, 2019, the USPTO Examining Attorney issued an Office Action (“Office Action”) with respect to the above-referenced mark (“Applicant’s Mark” or “Mark”). Applicant, Zuffa, LLC (“Applicant”) hereby submits the following argument and attached evidence in response to the Examiner’s position that the term “INSTITUTE” must be disclaimed.

I. ARGUMENT

In the Office Action, the Examining Attorney refused registration of Applicant’s Mark on the grounds that Applicant must disclaim the term “INSTITUTE” apart from the mark as shown because the term merely describes a feature, quality or characteristic of Applicant’s goods. Applicant submits that the term “INSTITUTE” is not descriptive of Applicant’s goods and that Applicant is entitled to exclusive rights in this term. Accordingly, for the reasons set forth below, Applicant respectfully requests that the Examiner withdraw the requirement to disclaim the term “INSTITUTE” and approve Applicant’s Mark for publication.

A. The Term “INSTITUTE” is at Least Suggestive of Applicant’s Goods.

Applicant respectfully submits that the term “INSTITUTE” is not descriptive of Applicant’s exercise mats; rather, the term is at least suggestive of the goods and is a registrable component of Applicant’s Mark.

To show descriptiveness, a term must describe a “major feature, function, characteristic or quality of that product.” *General Foods Corp. v. MGD Partners*, 224 U.S.P.Q. 479, 485 (TTAB 1984). Moreover, in making such a descriptiveness determination, the Examining Attorney is required to consider the context in which the mark is used or intended to be used in connection with the goods or services identified, and the possible significance that the mark would have to the average purchaser of the goods or services in the marketplace. *See In re Sundown Technology*, 1 U.S.P.Q.2d 1927, 1928 (Commr. Pat. 1986); *In re Omaha National Corp.*, 2 U.S.P.Q.2d 1859 (Fed. Cir. 1987); *In re Abcor Development Corp.*, 200 U.S.P.Q. 215 (C.C.P.A. 1978); *In re Venture Lending Associates*, 226 U.S.P.Q. 285 (TTAB 1985).

The issue central to registrability is whether the mark, considered in its entirety, possesses a merely descriptive significance as applied to the goods or services in question, or whether it may also suggest other qualities to the viewer, and therefore, is registrable as a suggestive mark. Examples of marks requiring imagination, and thus being suggestive, include CARMAX for automobile services, *Circuit City Stores, Inc. v. CarMax, Inc.*, 165 F.3d 1047, 1054 (6th Circuit 1999) (requiring a consumer’s imagination to determine the precise nature of automobile services offered); and L’EGGS for hosiery, *Sara Lee Corp. v. Kayser-Rothe Corp.*, 81 F.3d 455, 465 (4th Circuit 1996) (conjuring up attractive legs rather than hosiery).

Furthermore, “[s]uggestive marks, like fanciful and arbitrary marks, are registrable on the Principal Register without proof of secondary meaning. Therefore, a designation does not have to be devoid of all meaning in relation to the goods and services to be registrable.” TMEP § 1209.01(a). If a mark uses otherwise descriptive terms in a suggestive manner when applied to the goods and services offered under the mark, it is registrable. For example, the mark "Sugar and Spice" was held not to be merely descriptive of bakery products because it called to mind and was suggestive of the Nursery Rhyme, "Sugar and Spice and Everything Nice;” and as such “does not tell the potential purchaser only what the goods are, their function, their characteristics or their use.” *In re Colonial Stores, Inc.*, 394 F.2d 594, 157 U.S.P.Q. 382, 385 (CCPA 1968). Similarly, the Trademark Trial and Appeal Board found that the mark “Showroom Online” was not unregistrable as merely descriptive of the computerized interior furnishings product information service because the mark was suggestive as well. *In re TBG, Inc.*, 229 U.S.P.Q. 759, 760 (TTAB 1986).

Finally, with regard to a refusal of registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), when the question of registrability is a “close case, any doubt on the matter should be resolved in applicant’s favor, and the mark should be published for purposes of opposition.” *In re Waverly Inc.*, 27 U.S.P.Q.2d 1620, 1623 (TTAB 1993). Those in the industry can decide for themselves whether or not they believe that registration of the mark at issue for the goods or services identified will inhibit their right to compete with the applicant, and file a notice of opposition accordingly. *Id.*

Here, the Examiner has taken the position that the term “INSTITUTE” “merely indicates Applicant’s entity type.” The evidence used by Examiner to support this position consists of printouts from an online dictionary. However, this evidence does not demonstrate that the term “INSTITUTE” is descriptive of Applicant’s exercise mats. Indeed, an “institute” can involve organizations in a wide variety of industries and, as applied to the particular goods listed in the subject application, does not describe a major feature, function, characteristic or quality of the goods. The term “INSTITUTE,” as used in Applicant’s Mark, is at least suggestive of Applicant’s goods because it requires imagination, thought and perception by the consumer to determine the nature of the products provided by Applicant. Indeed, the consumer must view the entire mark as a whole and utilize some additional thought and imagination to make the connection that the goods are related to fitness or mixed martial arts. As such, while one definition of the word “institute” is an organization for the promotion of a particular cause, it cannot be said that the term merely describes a quality, feature, ingredient or characteristic of the exercise mats offered under Applicant’s Mark.

Furthermore, Applicant is not seeking registration of Applicant’s Mark for sports-related *services*, such as fitness training and instruction, sports competitions, or the like. In that case, it would be more reasonable to conclude that the word “INSTITUTE” could describe the way in which the *services* are provided. But as applied to Applicant’s *goods*, Applicant contends that the term INSTITUTE is not merely descriptive and is a registrable component of Applicant’s Mark.

B. The USPTO has Granted Registration or Issued a Notice of Allowance to Other Marks Utilizing the Term INSTITUTE without Requiring a Disclaimer.

Notably, the USPTO has either granted registration or issued a notice of allowance to other third party marks that incorporate the term INSTITUTE without requiring a disclaimer. Thus, it is reasonable to conclude that the USPTO has taken the position that the term INSTITUTE is at least suggestive when used in connection with similar or related goods. For example, the marks MASSACHUSETTS INSTITUTE OF TECHNOLOGY (U.S. Reg. Nos. 2055070 and 2057036), MARS INSTITUTE (U.S. Ser. No. 76570627), INSTITUTE FOR LEARNING AND BRAIN SCIENCES (U.S. Reg. No. 3584490), TROON GOLF INSTITUTE (U.S. Ser. No. 75553856), THE KINSEY INSTITUTE (U.S. Ser. No. 77473369), DERI DIGITAL ENTERPRISE RESEARCH INSTITUTE (U.S. Reg. No. 3317096), THE UNICORN TRAINING INSTITUTE (U.S. Ser. No. 87642645), IRON INSTITUTE (U.S. Ser. No. 87377868), INSTITUTE OF RUGBY (U.S. Ser. No. 87035862), KINSEY INSTITUTE (U.S. Reg. No. 5210095), FARM INSTITUTE (U.S. Reg. No. 4021805), AI THE ART INSTITUTES (and design) (U.S. Reg. No. 4978361), LINCOLN CENTER INSTITUTE (U.S. Reg. No. 3437812), CSI COMPUTER SECURITY INSTITUTE (U.S. Reg. No. 3041559), and BUECHNER INSTITUTE (U.S. Reg. No. 4129069) are all for goods that are similar or related to those provided by Applicant and the USPTO did not require a disclaimer. Attached hereto and incorporated herein by reference as **Exhibit 1** are true and correct copies of the registration certificates, notices of publication, notices of allowance or USPTO TSDR printouts for the aforementioned marks. Applicant understands that “[t]hird-party registrations are not conclusive on the question of descriptiveness,” and “[e]ach case must stand on its own merits.” *See* TMEP § 1209.03(a) (internal citations omitted). However, in the instant case, Applicant requests that the Examiner consider the third-party registrations where the term INSTITUTE has been found to have trademark significance when used for goods that are similar or related to those of Applicant. As such, Applicant contends that this evidence is persuasive in showing that this term is not merely descriptive of Applicant’s goods.

II. CONCLUSION

Based on the foregoing, Applicant believes the objections and issues raised by the Examiner have been resolved. More specifically, Applicant respectfully submits that the term “INSTITUTE” is not merely descriptive of a quality, characteristic, function or feature of Applicant’s goods and a disclaimer of this term should not be required. Therefore, Applicant respectfully requests that the Examiner withdraw the disclaimer requirement and approve Applicant’s Mark for publication.