

In the Office Action issued on August 31, 2019, for Applicant's mark NURSE BLAKE (the "**Mark**"), the Examining Attorney has requested a disclaimer of the word "NURSE" claiming that it is merely descriptive of Applicant's goods. Applicant respectfully disagrees that NURSE immediately describes anything about Applicant's goods, which consist of "shirts; sweatshirts" in Class 25 ("**Goods**"). Moreover, as set forth below, the evidence attached to the office action is almost entirely irrelevant to Applicant's case. Instead, since nearly every other application treats NURSE as inherently distinctive for general purpose apparel, Applicant requests that its Application receive consistent treatment. Therefore, Applicant requests that the Examiner withdraw the disclaimer request.

Analysis

A mark is merely descriptive if it immediately describes an ingredient, quality, characteristic, function, feature, purpose, or use of the specified goods or services. TMEP § 1209.01(b); *See In re TriVita, Inc.*, 783 F.3d 872, 114 USPQ2d 1574 (Fed. Cir. 2015). The determination of whether a mark is merely descriptive must be made in relation to the goods or services for which registration is sought, not in the abstract. *See In re Chamber of Commerce*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012). However, a mark is considered suggestive if it "requires some imagination, thought or perception to reach a conclusion as to the nature of the goods." *Id.* If a mark requires a modicum of imagination to determine the goods or services it is suggestive; it must be an immediate and direct conveying of the meaning to be merely descriptive. *See BellSouth Corp. v. Plenum Tech. Corp.*, 14 USPQ 2d 1555, 1556 (TTAB 1990). There is a thin line between merely descriptive marks and those that are suggestive and any doubt is resolved in favor of the applicant. *See In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1512 (TTAB 2016) (citing *DuoProSS Meditech Corp. v. Inviro Medical Devices Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012)).

The term NURSE does not describe any quality, feature or characteristic of shirts or sweatshirts or of Applicant's intended customers. In fact, the term NURSE could have many meanings including (1) a person that cares for the sick or to care for and wait on; (2) to attempt to cure by care and treatment; (3) to manage with care or economy; (4) to promote the development or progress of; (5) to hold in one's memory or consideration; (6) to nourish at the breast; or (7) to use, handle, or operate carefully so as to conserve energy or avoid injury or pain. *See Exhibit A* (showing definitions of the term NURSE). None of these definitions convey anything to the purchasing public about Applicant's shirts or sweatshirts. Combining the term NURSE with BLAKE doesn't change this conclusion.

The USPTO has consistently found that NURSE is inherently distinctive as an element of marks for use with general purpose clothing. The chart attached as Exhibit B shows several principal register applications that have been approved for publication by the examiner without a disclaimer as well as several principal registrations for marks that found the term NURSE inherently distinctive. These include

marks such as MY NURSE; POLISHED NURSE; NURSES ON THE RUN; NURSES WITH CARDS; THE NURSE AND CO.; NURSE MATES ALIGN; NIGHT NURSE; and I LOVE BEING A NURSE.

While the Examining Attorney provided as evidence six examples that disclaim NURSE, these are largely distinguishable from the Application. In Serial No. 86/030221 and 87,637639, the marks were refused as ornamental, not descriptive. Thus, their presence on the Supplemental Register is irrelevant. In Serial No. 86/418544, the mark includes a design element, which is described as “a nurse from waist up.” This clearly impacts the meaning and commercial impression of the term NURSE in a way that is entirely absent from the Application. In Serial No. 87/387718, the description of goods includes within it “nurse pants.” The goods associated with that mark are explicitly for nurses, which is not the case here. In Serial No. 87721932, the descriptiveness refusal, as set forth in the relevant office action, was based on the applicant’s providing clothing specifically for nurses (and again, this application features a description that is targeted to the medical field, such as “bottoms as clothing” and “tops as clothing”). On close examination, only one of the cited marks (BOSS NURSE) includes a disclaimer of the term NURSE based on descriptiveness (rather than ornamental) and without other indications that the relevant goods are specifically (or explicitly) offered to nurses.

By contrast, the Mark is not used in association with nursing apparel, but rather standard t-shirts and sweatshirts. Some consumers of these products may be nurses, but many are not. And nothing about Applicant’s t-shirts and sweatshirts is specifically designed for use by nurses.

Applicant acknowledges that each case must be decided on its own facts and that the existence of third-party registrations is not *conclusive* of the issue of descriptiveness. *In re the Dot Commc’ns Network LLC*, 101 USPQ2d 1062, 1067 (TTAB 2011); TBMP § 1209.03(a). However, third-party registrations are probative evidence as acknowledged by the Examiner in the Office Action. In this case, the third party registrations weigh heavily against requiring a disclaimer. Every application that includes the term NURSE as an element for use with general purpose clothing in Class 25 has treated NURSE as inherently distinctive, except one. Applicant requests that its Application be treated with the same consistency.

Conclusion

Applicant's use of the term NURSE in its NURSE BLAKE Mark does not immediately convey a particular meaning, purpose or feature about the Goods. There is no evidence that NURSE is a common term in the marketplace for shirts and sweatshirts where it would need to be disclaimed. Since consumers would need to exercise some thought to come to a determination about Applicant’s Goods, the term is at least suggestive. Further, NURSE has been commonly found to be inherently distinctive of various clothing articles in the USPTO database. As a result of the foregoing, the matter should be resolved in Applicant’s favor. Accordingly, Applicant respectfully requests that the requirement to disclaim NURSE be withdrawn.

Additional Information Required

In the Office Action, additional information has been requested:

1) Applicant is the owner of Registration No. 5743870 for Entertainment services in the nature of live public speaking events in the nature of lectures and providing on-line lecture in the field of healthcare; Education services, namely, providing live and on-line seminars in the field of healthcare; On-line journals, namely, blogs featuring healthcare information; Providing on-line videos featuring healthcare information, not downloadable. Applicant must explain whether or not the goods in this application are promotional items for the services in the registration.

Response: Applicant's clothing are general purpose shirts and sweatshirts that could be purchased and worn by any consumers, including nurses and others. Some clothing promotes campaigns associated with Applicant.

2) Website for the goods.

Response: <https://store.nurseblake.com/>

3) A statement describing whether the goods will be sold in relation to the aforementioned services.

Currently, the goods are primarily sold through Applicant's website.