

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No. : 88/493,318
Applicant : Advanced Nutrients Ltd.
Filed : June 28, 2019
Mark : ADVANCED COCO
Examining Attorney : Anthony Rinker, Law Office 102
Date of Office Action : September 10, 2019

RESPONSE TO OFFICE ACTION

Advanced Nutrients Ltd. (“Applicant”, by counsel David R. Welch) hereby responds to the Office Action issued by Examining Attorney Anthony Rinker on September 10, 2019.

I. MERELY DESCRIPTIVE 2(e)(1) REFUSAL

The Examining Attorney has refused registration of the proposed mark pursuant to Trademark Act Section 2(e)(1), on the belief that Applicant’s Mark is merely descriptive of a feature of Applicant’s goods. Applicant respectfully submits that Applicant’s Mark is at least suggestive and not descriptive of the goods offered under the mark, as follows.

A mark is merely descriptive only if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods or services. *See In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). By contrast, a suggestive mark is one that, when applied to the goods or services at issue, requires imagination, thought, or perception as to the nature of the goods or services. *See In re Shutts*, 217 USPQ 363 (TTAB 1983). In determining whether a mark is suggestive or descriptive, there are a number of tests which may be applied. One such test is the “imagination” test, which notes that: “[a] term is suggestive if it requires imagination, thought and perception to reach a conclusion as to the nature of the goods”; see TMEP 1209.01(a). It is well settled that a composite mark must be considered in its entirety, and not merely by its parts, in order to determine if it is merely descriptive. Even if a mark combines descriptive terms, it is registrable if the composite result is a unitary mark with a unique, incongruous, or otherwise non-descriptive significance in relation to the goods and/or services. TMEP 1209.03(d).

Here, Applicant seeks registration of the mark ADVANCED COCO in standard characters for use in connection with “plant nutrients, namely, fertilizers and soil additives” in International Class 001. Applicant’s Mark is a unitary mark with a nondescriptive meaning in relation to the goods offered. More specifically, the Applicant’s goods are fertilizers and soil additives. A fertilizer is defined as “a chemical or natural substance added to soil or land to increase its fertility.” (*definition per Dictionary.com*). A soil additive is defined as “are additives used to improve the physical properties of the soil, such as fertility, water retention, drainage permeability, aeration and soil structure” (definition per <https://homeguides.sfgate.com/organic-soil-additives-70662.html>). Applicant’s Mark does *not* describe a feature of the goods, as seen from the definitions of fertilizer and soil additive. The terms “ADVANCED” or “COCO” do not refer to a chemical, natural, or any other substance to increase fertility or to improve physical properties of soil. “Advanced” is more simply defined as “highly developed or complex” or “being at a higher level than others,” as stated by the Office. *See Office Action page 2*. The term is evocative or suggestive, not descriptive.

ADVANCED COCO does not immediately convey information regarding the Applicant’s goods. The mark does not immediately convey information concerning a quality characteristic, function, ingredient, attribute, or feature of Applicant’s fertilizer. Instead, upon seeing the mark the consumer must engage in an additional thought, imagination, or perception to connect the mark with the Applicant’s goods and explore the possible significance ADVANCED COCO is likely to have on the ingredients, contents, and/or purpose of the fertilizer to which it is connected. To put it simply, the product’s buyer must ask herself “How would using this product result in ‘advanced’ coco?” Because of that additional train of thought or perception, ADVANCED COCO acts as a unique source identifier for the Applicant’s goods.

The question then is not whether someone presented only with the mark could guess the identity of the products listed in the description of goods. Rather, the question is whether someone who already knows what the products are will understand the mark to convey information about them. See *In re the Dot Communications Network, LLC*, 101 USPQ2d 1062 (TTAB 2011); *In re Tower Tech, Inc.*, 64 USPQ2d 1315, 1316-1317 (TTAB 2002); *In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537, 1539 (TTAB 1998). If one must exercise mature thought or follow a multistage reasoning process in order to determine what product or service

characteristics a mark indicates, the mark is suggestive rather than merely descriptive. *In re Tennis in the Round, Inc.*, 199 USPQ 496, 497 (TTAB 1978).

Applicant's Mark does not immediately call the goods to mind, but rather requires imagination, thought and perception to reach the conclusion that the Applicant is providing quality goods as identified in the application. Applicant employs the terms "ADVANCED" and "COCO" to describe itself as a brand that provides unique, quality goods. Furthermore, it is clear that no reasonable consumer could identify the type of goods Applicant provides by simply looking at the Applicant's mark, without any additional thought or reasoning.

Examiner states "an internet search that establishes that COCO refers to products derived from the coco palm tree that are used as soil additives or growing media similar to the use of applicant's goods." See Office Action, page 4. Applicant respectfully disagrees; although Applicant's Mark include the term "COCO," Applicant's goods do not use any products that are derived from coco palm trees, husks, or coir, or have any attribute of using coconuts as an ingredient in Applicant's goods.

A second test that is often used in determining whether a mark is descriptive or suggestive is the "competitor's need" test. The analysis under this test is whether "the suggestion made by the mark [is] so remote and subtle that it is really not likely to be needed by competitive sellers to describe their goods." See 2 McCarthy § 11:68; see also *Union Carbide Corp. v. Ever-Ready, Inc.*, 531 F.2d 366 (7th Cir. 1976), *cert. denied*, 429 U.S. 830 (1976). "As the amount of imagination needed increases, the need of [others to use] the mark to describe the product decreases." 2 McCarthy § 11:68.

As applied here, competitors do not need to use the term "ADVANCED COCO" to describe their fertilizers, or soil additives and amendments. Even if a competitor provides fertilizers or soil additives, there are many ways to describe such goods without using the term "ADVANCED COCO" – for example, using terms like ULTRA NUTRIENTS, or SUPER AMENDMENTS.

In conclusion, Applicant's Mark is not merely descriptive, because Applicant's mark is unique, does not describe the identified goods (plant nutrients, namely, fertilizers and soil

additives), and instead gives a distinct overall commercial impression. Even if doubt exists as to whether a proposed mark is merely descriptive as applied to the goods or services for which registration is sought, it is the practice of the Office to resolve those doubts in favor of the applicant. *In re Grand Metropolitan Foodservice, Inc.*, 30 USPQ2d 1974 (TTAB 1994). Therefore, Applicant respectfully requests that the Examining Attorney allow Applicant's mark to proceed to publication.

Applicant would also like to note that Applicant holds scores of U.S. trademark registrations, including U.S. Reg. No. 4,141,054, a design mark (sometimes known as "3 leaves") registered May 15, 2012. Another registration, ANCIENT EARTH, U.S. Reg. No. 4,261,856, registered December 18, 2012, featured a specimen filed October 24, 2012 showing the use of the 3 leaves design with the words ADVANCED NUTRIENTS, as it appears consistently on Applicant's products; for example, as at <https://www.advancednutrients.com/>. An abandoned registration, ADVANCED GROW GEAR, U.S. Reg. No. 4,110,399, registered March 6, 2012 shows the use of the term ADVANCED as of even date to identify an Applicant product.

To put it simply, Applicant has used the term ADVANCED NUTRIENTS as a "house mark" for some time [cf. TMEP 1402.03(b)], and routinely uses the term ADVANCED as part of a product name. Rather than being descriptive, the term "ADVANCED" speaks as a designation of source – i.e., a product's affiliation with Advanced Nutrients, one of the most highly respected hydroponics fertilizer companies in the world. The term "ADVANCED" is intended to refer to the goodwill associated with the Advanced Nutrients brand and any distinctiveness it has acquired over decades of continuous use in Canada, the U.S., and around the world.

In conclusion, Applicant respectfully submits that the term "ADVANCED COCO" is a designation of source, and quality – i.e., Applicant's reputation for producing superior agricultural inputs.

Accordingly, Applicant respectfully request the Office reconsider its initial findings and allow this application to proceed to publication.

Please let us know if you need any further information or assistance.