

UNITED STATES PATENT AND TRADEMARK OFFICE

**Mark:** EMBRACE AMERICAN HARVEST THE NATURE

**Application Serial No.:** 88486510

**Applicant:** American Harvest Inc.

**Office Action Date:** September 20, 2019

**Examiner:** Kamal Preet

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**Response to Office Action**

The examiner raised the issues of (1) disclaimer and (2) description of the mark in refusing registration of the applied for mark. Applicant responds to both issues as follows.

**1. Descriptive**

The Examiner asserts that the “Applicant must disclaim the wording “AMERICAN” because it is not inherently distinctive.” In light of the case law on point, Applicant respectfully disagree with the Examiner’s assertion. The general rule that has evolved is that the term “American” in a composite mark where the additional term(s) are not descriptive, the term “American” is not descriptive. Whereas, when the additional term is descriptive the term “American” is descriptive.

*"American" Composite Marks.* One of the most-used marks appears to be AMERICAN. On the whole, courts have held that the addition or variation of any element of AMERICAN, no matter how slight, will remove it from the geographically descriptive category for American-based sellers. For example, AMERICAN GIRL shoes, ALL AMERICAN on radios, AMERICAN PLAN CORPORATION for insurance services, and AMERICANA for hotel services. § 14:11. Composite geographic marks, 2 McCarthy on Trademarks and Unfair Competition § 14:11 (5th ed.).

Whereas, The Trademark Board has observed that: “The addition of a generic term to a geographic term does not avoid the refusal of primarily geographic descriptiveness.” Thus, the Board held that CAROLINA APPAREL was primarily geographically descriptive. Expanding on that rule further, the Board has said: “[T]he Board has held that the addition of highly descriptive or generic matter to the name of a geographic location generally does not alter the primary significance of the mark.” Applying this rule, the Board held that ROYAL HAVANA RESORT & CASINO for wearing apparel and personal care products not from Havana, Cuba was unregistrable. § 14:11. Composite geographic marks, 2 McCarthy on Trademarks and Unfair Competition § 14:11 (5th ed.).

Based, on the above collection of case law, the term “American” in “Embrace American Harvest The Nature” for hemp fabric is not descriptive because the terms “Embrace” “Harvest” and “the Nature”, are suggestive, arbitrary or fanciful (not descriptive) for fabrics. As such, the term “American” is not descriptive and should not be disclaimed.

The classic case is the United States Supreme Court's opinion holding that THE AMERICAN GIRL on shoes was not geographically descriptive. The Court distinguished away its prior cases holding LACKAWANNA coal, COLUMBIA flour, and ELGIN watches as all geographically descriptive by pointing out that “if the mark here in controversy were AMERICAN shoes, these cases would be quite in point.” § 14:11. Composite geographic marks, 2 McCarthy on Trademarks and Unfair Competition § 14:11 (5th ed.)

In light of the above arguments, Applicant request that the Examiner withdraw the descriptiveness refusal.

## **2. Description of the Mark**

Applicant accepts the Examiner's recommendation as to the description of the mark. As such, the application as to the description of the mark may be amended as suggested.

The mark consists of an outline of a gold circle with the wording "EMBRACE" in green in an arch shape with a curved gold line below it with the wording "AMERICAN HARVEST" appearing in green on two lines above a bunch of green leaves encircled by a gold curved line with the wording "THE NATURE" in green curving upwards below it.

Based on the arguments above, Applicant respectfully requests that the Examiner allow the trademark application without a disclaimer of the term "AMERICAN" and with the amendment as suggested to the description of the mark.