IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK OFFICE

IN RE APPLICATION:

Mark:	PREMIER
Applicant:	Lincare Licensing Inc.
Serial No.:	88617384
Attorney File No:	LNCR.18002

AMENDMENT A

Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1415

Dear Sir:

In response to the first Office Action issued by the United States Patent and Trademark Office, please amend the above-identified application as follows:

1. AMENDMENT OF DESCRIPTION OF GOODS

With this Response, Applicant deletes IC 041 from the subject Application. The Description of Goods now reads as follows:

> IC 035: Oxygen supply services for medical purposes, namely, retail medical supply store services featuring oxygen.
>
> IC 039: Distribution services, namely, delivery of durable medical equipment and supplies for home health care; oxygen supply services for medical purposes, namely, delivery of oxygen for home health care.
>
> IC 044: Home health care services; health care services, namely, respiratory health care services, ventilation health care services, and medical clinic services associated with the

foregoing; rental and leasing of medical equipment and supplies; providing a website featuring information in the field of health care.

2. LIKELIHOOD OF CONFUSION FOR IC 041

Registration of the subject mark, in IC 041 only, has been refused based on a likelihood of confusion with the mark of U.S. Registration No. 5910831. United States Registration No. 5910831 is owned by Premier Nursing Placement, LLC. With this Response, Applicant deletes IC 041 from the Application. Because the Section 2(d) refusal only applied to IC 041, the amendment of the description of goods has traversed the refusal based on U.S. Registration No. 5910831. Also, U.S. Application Serial Nos. 88441157, 88441152, and 88066401 have been cited against the subject Application. The cited Applications are also owned by Premier Nursing Placement, LLC and cover the same educational services in IC 041. Thus, the deletion of IC 041 from the subject Application also traverses the potential Section 2(d) refusals based on U.S. Application Serial Nos. 88441157, 88441152, and 88066401.

3. DESCRIPTIVE REFUSAL

The Examining Trademark Attorney has initially refused registration of the mark on the Principal Register on the basis the mark merely describes the goods of applicant. Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(l); TMEP section 1209 *et seq*. It is well settled that a mark is considered to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it forthwith or immediately conveys information concerning any significant ingredient, quality, characteristic, feature, function, purpose, subject matter or use of the goods or services. See, e.g., *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987) and *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). The immediate

idea must be conveyed with a "degree of particularity." I*n re TMS Corporation of the Americas*, 200 USPQ 57, 59 (TTAB 1978). A mark is suggestive if, when the goods or services are encountered under the mark, a multi-stage reasoning process, or the utilization of imagination, thought or perception, is required in order to determine what attributes of the goods or services the mark indicates. See, e.g., *In re Abcor Development Corp.*, supra at 218, and *In re Mayer-Beaton Corp.*, 223 USPQ 1347, 1349 (TTAB 1984). There is a thin line of demarcation between a suggestive mark and a descriptive mark. *In re Atavio*, 25 USPQ2d 1361 (TTAB 1992). See also *In re TMS Corp. of the Americas*, 200 USPQ 57 (TTAB 1978) (the mark THE MONEY STORE for financial service institution is suggestive.); *In re the House Store, Ltd.*, 221 USPQ 92 (TTAB1983) (the mark THE HOUSE STORE for retail store services which sells house furnishings is suggestive).

The authority that establishes a thin line of demarcation between a suggestive mark and a descriptive mark is especially true with regard to the subject mark. There is conflicting authority as to the classification of self-laudatory marks. Assuming arguendo, that a majority of the cases indicate that such marks are descriptive, some cases hold that such marks are suggestive. See *Estee Lauder Inc. v. The Gap, Inc.*, 108 F.3d 1503, 1509 (2d Cir.1997) ("A term that is merely self-laudatory, such as 'plus' or 'super,' seeking to convey the impression that a product is excellent or of especially high quality, is generally deemed suggestive."). See also, *Alpha Recycling, Inc. v. Crosby*, 2016 WL 1178774, at *5 (S.D.N.Y. Mar. 23, 2016) (finding the term "Alpha" to be suggestive when used in reference to recycling services). In the face of this mixed guidance, Applicant submits the Examiner should determine that the subject mark is highly suggestive, or at worst, only slightly descriptive.

Also, Applicant's mark has acquired a distinctive and secondary meaning when used in connection with Applicant's services, and thus the subject mark is entitled to registration on the Principal Register of the United States Trademark Office. To establish that a mark has become

distinctive of the Applicant's goods and services or has otherwise acquired secondary meaning, one "must show that, in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself." *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 851 n. 11 (1982). The Trademark Act is silent as to the weight of evidence required for a showing under 15 U.S.C. § 1052(f) except for the suggestion that substantially exclusive use for a period of five years immediately preceding filing of an application may be considered prima facie evidence. *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 1125 (Fed. Cir. 1985).

The Applicant has continuously used the subject mark, in interstate commerce, for at least seven (7) years from the date of this statement. Applicant submits that the subject mark has become distinctive of Applicant's services through the Applicant's substantially exclusive and continuous use in commerce for at least seven (7) years. Please see the attached declaration labeled as Exhibit A. Moreover, Applicant submits that seven (7) years is more than adequate to establish secondary meaning in this case, because the mark, at worst, is only slightly descriptive. The "descriptive" category is not a monolithic set of terms. Some terms are only slightly descriptive and need only a minimum quantum of evidence of secondary meaning. Other terms are highly descriptive and may need a massive quantity and quality of secondary meaning evidence to become a trademark. See 2 McCarthy § 11:25. Here, the mark is, at worst, only slightly descriptive. Thus, the burden and the amount of evidence to show acquired distinctiveness is low; and seven (7) years is more than adequate to establish secondary meaning in this case

4. SPECIMEN REFUSALS FOR IC 035 AND IC 039:

The Examining Trademark Attorney initially rejected registration of the mark in IC 035 and IC 039 based on the contention that the specimens of record do not show use of the mark in commerce. On

April 9, 2020, the Examiner agreed to withdraw the refusal based on IC 035. Please see Exhibit B. With regarding to IC 039, attached please find a substitute specimen (Exhibit C), which clearly shows the subject mark and specifically references the "delivery" of oxygen. Also, attached hereto as Exhibit D, please find a Declaration in support of the substitute Specimen of IC 039. Applicant submits that the grounds for refusal of IC 035 and IC 039 have been traversed with this response.

5. CONCLUSION

Accordingly, the subject mark is entitled to registration on the Principal Register of the United States Trademark Office. Applicant and the undersigned attorney thank the Examining Trademark Attorney for the helpful suggestions that have assisted in the preparation of this response. The Applicant respectfully submits that the above amendments to the application have overcome the objections set forth in the outstanding office action and the application is ready for approval. Favorable action is respectfully submitted. The undersigned attorney of record cordially invites any telephonic communications from the Examining Trademark Attorney which may assist in the allowance and publication of the subject mark.

Respectfully submitted,

FRIJOUF, RUST & PYLE, P.A.

4.16.2020
Date

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