

Application SN 88326666

Mark: SCIENCE POWERED BY NATURE PURECANE (and Design)

RESPONSE TO OFFICE ACTION

This is in response to the office action dated October 25, 2019 in which the Examining Attorney requested that the terms “PURE” and “CANE” be disclaimed and the identification of goods be amended. Applicant requests that the amendment set forth below be entered and the disclaimer requirement be withdrawn for the following reasons.

AMENDMENT

In response to the Examining Attorney’s request, Applicant requests that the identification of goods be amended as follows: “Zero-calorie sweetener derived through fermentation of cane syrup and consisting entirely of ingredients derived from cane sugar plants and Erythritol as a sole bulking agent”.

DISCLAIMER OF “PURE” and “CANE” IS NOT REQUIRED

The Examining Attorney has requested disclaimer of the terms “PURE” and “CANE” because it allegedly “merely describes applicant’s goods and/or services, and thus an unregistrable component of the mark.” Applicant respectfully disagrees that the terms “PURE” and “CANE” must be disclaimed for the following reasons.

The term PURECANE as it appears in Applicant’s mark is a single “unitary” term and cannot be separated into its component parts for purposes of the disclaimer request. The Examiner cites *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251, 103 USQ2d 1753, 1755 (Fed. Cir. 2012) in support of its position that the wording “PURE” and

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“CANE” is merely descriptive and should be disclaimed. However, the DuoProSS decision actually supports a finding here that the wording PURECANE should not be disclaimed. As background, the Board dismissed DuoProSS Meditech Corporation’s counterclaims for cancellation of two trademark registrations owned by Inviro Medical Devices, Ltd., after the Board determined that the marks at issue (SNAP! (and design) and SNAP SIMPLY SAFER) were not merely descriptive of medical syringes. The Court reversed the Board’s finding and concluded that SNAP! (and Design) and SNAP SIMPLY SAFER for medical syringes were, in fact, merely descriptive. The Court determined that the Board erred because it did not consider the mark as a whole, but rather improperly separated the term SNAP from the exclamation point

Snap!

which was a clear reference to syringes requiring the user to “snap off the plunger”. Similarly, SNAP SIMPLY SAFER was a clear reference to the safe way to snap off the plunger. *DuoProSS* at 1253-1255. The terms SIMPLY and SAFER merely imparted information about a significant characteristic of the product. *DuoProSS* at 1256, 1257.

Similarly, the terms “PURE” and “CANE” cannot be separated into their component parts. Together they create a term that is suggestive, not descriptive in the context of the mark as a whole, SCIENCE POWERED BY NATURE PURECANE. The term PURECANE is not a word found in the dictionary. A search of PURECANE on dictionary.com yielded no results. A screenshot of the URL <https://www.dictionary.com/misspelling?term=purecane&s=t> and the URL <https://www.dictionary.com/misspelling?term=pure%20cane&s=t> captured on October 28,

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2019 attached hereto as Exhibit A show no results for the term “purecane” as a unitary term or “pure cane” as two words. The Examining attorney points to dictionary definitions of the separate terms “pure” and “cane” from the online dictionary Merriam-Webster defining “pure” as “unmixed with any other matter” and “cane” as the “sugar cane plant”. The Examiner mistakenly concludes that “in combination the words ‘pure’ and ‘cane’ identify sweeteners that consists entirely of sugar cane derived matter”. The Examiner fails to consider the fact that the term “pure” has other meanings. For example, “pure” is also defined in the online dictionary.com as “free from tainting or polluting matter; clean . . . ” A copy of a screenshot from the URL <https://www.dictionary.com/browse/pure?s=t> accessed on October 28, 2019 is attached hereto as Exhibit B. The term “pure” in Applicant’s mark suggests that Applicant’s product is the result of a sustainable production method that requires significantly less land and emits significantly less carbon.

The term PURECANE is suggestive of the goods and not merely descriptive, particularly in the context of the other wording SCIENCE POWERED BY NATURE. A mark is considered suggestive if it “requires imagination, thought and perception to reach a conclusion as to the nature of the goods.” *Abercrombie & Fitch Co.. v. Hunting World*, 357 F.2d 4, 11 (2d Cir. 1976). Applicant acknowledges that the term “purecane” has been used by third parties in the sugar industry as an adjective to describe various forms of cane sugar such as crystalized cane sugar, conventional white sugar, brown sugar, confectioner’s sugar, liquid and invert sugar, and non-crystalized cane sugar. These types of sugar obtained from cane sugar can be associated in

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the minds of consumers with a high calorie food that contributes to weight gain and obesity.

Applicant's product is different. It is a zero-calorie sweetener made naturally from Reb-M

which is a molecule produced from cane sugar by a modified yeast strain through a complex

fermentation process. While the yeast is genetically engineered, there is no yeast in Applicant's

final product.

Disclaimer is required only if the term is "primarily merely descriptive". The term "PURECANE" is not primarily merely descriptive, but is rather suggestive of Applicant's zero-calorie sweetener, particularly in view of the fact that the remaining wording in the mark, "SCIENCE POWERED BY NATURE" provides additional information about the nature of the product and creates a unitary mark. The term PURECANE requires imagination, thought, and perception to understand the nature of a zero-calorie sweetener that is 1) untainted and unpolluted, 2) made naturally from Reb-M which is a molecule produced from cane sugar by a modified yeast strain through a complex fermentation process, and 3) does not have an aftertaste or adverse side-effects associated with artificial sweeteners. Consumers will need to go through this multi-step thought process to understand how sugar derived from sugar cane can be zero-calorie and taste great. The unitary term PURECANE is clearly incongruous as it relates to Applicant's zero-calorie sweetener and therefore should not be disclaimed. See *In re Colonial Stores, Inc.*, 394 F.2d 549, 551, 157 USPQ 382, 294 (C.C.P.A. 1968); *In re Positec Grp. Ltd.*, 108 USPQ 2d 1161, 1162-63 (TTAB 2013).

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The Examining Attorney points to evidence from websites for Monin, Dixie Crystals, Sugarcane Island, and Domino Sugar for examples of “third parties using ‘pure cane’ as a generic identifier for the composition of their sweeteners.” Any suggestion that PURECANE is potentially generic for Applicant’s zero-calorie sweetener should not be considered as the Examiner has failed to meet the burden of proving that the term is generic by clear evidence. TMEP § 1209.01(c)(i). See also *In re Nordic Naturals, Inc.* 755 F.3d 1340, 1344, 111 USPQ2d 1495, 1498 (Fed. Cir. 2014). The contexts in which the separated terms “pure” and “cane” are used in the above examples for table sugar and the manner in which the unitary term “PURECANE” is used in connection with Applicant’s Reb-M zero-calorie sweetener are entirely different. “Slogans, by their attention getting nature, are treated as unitary matter and must not be broken up for purposes of requiring a disclaimer.” See TMEP §1213.05(b)(i). The phrase SCIENCE POWERED BY NATURE PURECANE is a unitary phrase or slogan that creates a single, integrated and distinct commercial impression that is suggestive of Applicant’s zero-calorie sweetener.

In view of the foregoing arguments and amendment, Applicant respectfully requests that the requirement to disclaim “PURE” and “CANE” be withdrawn.