

The Examining Attorney requires a disclaimer of the wording "SENSORY FX" asserting that it is merely descriptive of the goods listed in the application. Applicant respectfully disagrees and submits that a proper analysis of the mark of the application confirms that "SENSORY FX" is not merely descriptive as it does not immediately convey the purpose of the goods to which it is applied with any degree of particularity. Rather it takes imagination and mental leaps to ascertain with any degree of specificity the nature of the goods offered under the mark. Accordingly, the disclaimer requirement should be withdrawn. The reasons are discussed in further detail below. In the alternative, Applicant consent to entry of the disclaimer.

It is well-settled that a mark is merely descriptive only if it immediately describes an ingredient, quality, characteristic, function, feature, purpose or use of the goods to which it is applied. *In re On Technology Corp.*, 41 USPQ.2d 1475, 1477 (TTAB 1996) (citing *In re Abcor Dev. Corp.*, 588 F.2d 811 (CCPA 1978)). Moreover, the immediate idea must be conveyed forthwith with a "degree of particularity." *In re TMS Corp. of the Americas*, 200 USPQ 57, 59 (TTAB 1978) (emphasis added). A mark is merely descriptive when it tells the potential customer only what the goods are, their ingredients, qualities or characteristics. *In re Quik-Print Copy Shops, Inc.*, 205 USPQ 505 (CCPA 1980) ("merely' is considered to mean 'only'") (citing *In re Colonial Stores, Inc.*, 157 USPQ 382 (CCPA 1968)).

As to suggestive terms, which are distinctive, "[a] term is suggestive if it requires imagination, thought and perception to reach a conclusion as to the nature of the goods." *Stix Products, Inc. v. United States Merchants & Mfns, Inc.*, 160 USPQ 777, 785 (SDNY 1968). "[I]f one must exercise mature thought or follow a multi-stage reasoning process in order to determine what product or service characteristics the term indicates, the term is suggestive rather than merely descriptive." *In re Tennis in the Round, Inc.*, 199 USPQ 496, 498 (TTAB 1978). If the mental leap between the mark and the product's attributes is not almost instantaneous, this indicates suggestiveness, and not mere descriptiveness. See *Investacorp, Inc. v. Arabian Inv. Banking Corp.*, 19 USPQ 1056 (11th Cir. 1991). See also *Plus Prods, v. Medical Modalities Assoc., Inc.*, 211 USPQ 1199, 1204-05 (TTAB 1981) (merely descriptive mark is one that immediately conveys information as to the ingredients, qualities or characteristics of the goods with a "degree of particularity.").

In *Plus Products*, the marks Zn-PLUS, Ca-PLUS, and Mn-PLUS were initially found to describe the presence of a chemical ingredient ("Zn" is the abbreviation for zinc, "Ca" is the abbreviation for calcium, and "Mn" is the abbreviation for manganese) and something more. *Plus Prods.*, 211 USPQ 1199. However, the -PLUS suffix did not indicate with particularity what that something more was, and thus the marks were found suggestive. *Id.* Similarly, THE MONEY SERVICE was found suggestive of services to arrange for the transfer of funds ("money") to and from savings accounts from remote locations. *In Re TMS Corp. of the Americas*, 200 USPQ 57 (TTAB 1978). The TTAB noted that the mark "suggests a number of things, but falls short of describing applicant's services in any one degree of particularity." *Id.* at 59.

Nothing about SENSORY FX merely describes a good according to Applicant's recited goods. The examiner states that SENSORY FX merely describes a good that has an effect on the user's senses. The examiner's description is much broader than an ASMR toy, as is recited. By contrast, Applicant's goods are relate to toys that cause particular type of reaction to audible stimulus. Every toy necessarily has a sensory function, whether it be tactile, audible, visual, or a combination of these. Applicant respectfully submits that consumers must engage in a multi-stage reasoning process in order to reach any conclusion

as to the features of Applicant's products. The name does not describe any particular sense. The consumer simply cannot directly reach a conclusion regarding the features of the toy simply from looking at the mark; rather, perception of the message is indirect.

In determining whether a mark is descriptive or suggestive, the courts have utilized a number of different tests. Under the competitor's need test, the courts ask whether a competitor is likely to need the term to describe its goods. *Minnesota Mining & Mfg. Co. v. Johnson & Johnson*, 172 USPQ 491 (CCPQ 1972). If it is not likely that the competitor will need the term to describe its goods, then the mark is suggestive. 4 McCarthy §11:68, p.11-130 to 131. Applicant submits that competitors do not need the term SENSORY FX to describe their ASMR toys. For example, the mark ASMR for toys (Appl. Serial No. 88581197) was not refused as being merely descriptive. There is also the application for the mark AUTHENTIC ASMR PRODUCT, which was allowed (Appl. Serial No. 88348451). See also Appl. Serial No. 88230013 (application for CRUSHY FOAM for ASTM foam allowed without merely descriptive refusal); and Reg. No. 5887007 (MIND MASSAGE for ASMR entertainment services). Applicant is unaware of any use by competitors of SENSORY FX or Sensory Effects to describe ASMR products, let alone toys; thus, consumers will likely view the term as a mark indicating source or origin. Accordingly, the refusal to register should therefore be withdrawn.

Finally, if the Examining Attorney should still waver on the issue of distinctiveness of Applicant's mark, it is respectfully submitted that all doubt regarding the merely descriptive nature of a mark should be resolved in favor of the applicant, and the mark should be published for opposition. When considering whether a mark is suggestive or merely descriptive, courts agree that to the extent there is any doubt, the doubt must be resolved in the Applicant's favor by finding the proposed mark to be suggestive. See *In re Conductive Systems, Inc.*, 220 USPQ 84 (TTAB 1983); *In re Gourmet Bakers, Inc.*, 173 USPQ 565 (TTAB 1972) (holding THE LONG ONE not merely descriptive of bread); *In re Aid Labs, Inc.*, 221 USPQ 1215 (TTAB 1983) (holding PEST PRUF for animal shampoo with insecticide suggestive, and not merely descriptive); *In re Morton-Norwich Prod., Inc.*, 209 USPQ 791 (TTAB 1981) (holding COLOR CARE suggestive of a characteristic of laundry bleach rather than merely descriptive). Resolving such doubts in favor of finding a mark suggestive is soundly based on the recognition that any person who believes that he will be damaged by the registration will have the opportunity to oppose the registration of the mark. *In re Gourmet Bakers*, 173 USPQ 565.