

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark:	5 STYLE GROOM)	
Serial No.:	88/827,788)	Examining Attorney
Filing Date:	March 10, 2020)	Steven W. Jackson
Attorney Docket No.	50784-317762)	Law Office 107

RESPONSE TO NON-FINAL OFFICE ACTION

This responds to the Office Action dated June 8, 2020.

I. Disclaimer Request

Although Applicant wholly disagrees that its 5 STYLE GROOM Mark is merely descriptive as a whole, Applicant is willing to acknowledge the potential descriptive nature of the term “groom” within its Mark, and thus, Applicant respectfully requests the following disclaimer be entered in the record, without prejudice, for its 5 STYLE GROOM Mark:

No claim is made to the exclusive right to use “GROOM” apart from the mark as shown.

II. Section 2(e)(1) Refusal – Applicant’s Mark Is Not Merely Descriptive

The Examining Attorney has preliminarily refused registration for Applicant’s 5 STYLE GROOM mark (“Applicant’s Mark”), under Section 2(e)(1), as merely descriptive of the goods in International Class 8. As discussed more fully below, Applicant respectfully disagrees and offers arguments in support of the registrability of its mark on the Principal Register because: (1) the mark 5 STYLE GROOM is, at most, suggestive and does not merely describe the identified goods or its primary features or characteristics; (2) there is no evidence that “5 STYLE GROOM” is commonly used to describe Applicant’s relevant goods or that the mark has any significance other than trademark significance; (3) the Trademark Office has not met its burden of proof; and, (4) there is doubt with respect to the issue of descriptiveness of 5 STYLE GROOM as it is incorporated in Applicant’s mark, and that doubt must be resolved in Applicant’s favor.

As such, Applicant respectfully requests that the objection be withdrawn and the application be approved for publication.

1. The Term 5 STYLE GROOM Is, At Most, Suggestive of Some Characteristics of the Relevant Goods and Does Not Merely Describe Applicant's Goods In International Class 8

A mark is merely descriptive only if it *immediately* describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods or services. TMEP §1209.01(b); *see In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 U.S.P.Q.2d 1420, 1421 (Fed. Cir. 2005). Moreover, the Trademark Manual of Examining Procedure states that “to be refused registration on the Principal Register under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), a mark must be **merely** descriptive . . . of the goods or services to which it relates.” (emphasis added).

A trademark need not be devoid of all meaning to be registrable; rather, to be considered merely descriptive, a mark must possess **nothing more** than descriptive significance when applied to the goods and services in question, and must convey **nothing more** than a readily understood meaning to the average purchaser of such goods and services. *See, e.g., In re Bright-Crest Ltd.* 204 U.S.P.Q. 591 (TTAB 1979). In addition, importantly, upon examination for mere descriptiveness, the mark **must be considered as a whole**, and not dissected into its component parts to find mere descriptiveness. *See In re Application of Colonial Stores, Inc.*, 394 F.2d 549, 552 (C.C.P.A. 1968) (holding SUGAR & SPICE registrable and not merely descriptive of bakery products); *In re Federated Dept. Stores*, 3 U.S.P.Q.2d 1541 (T.T.A.B. 1987) (holding THE CHILDREN'S OUTLET registrable and not merely descriptive of retail children's clothing store services). This is particularly important in the present case, where Applicant's Mark, 5 STYLE GROOM, forms a unitary whole through a pattern and use of terms to create a distinctive impression. TMEP § 1213.05(e). Applicant's Mark is a fun and unique unitary term that rolls off the tongue, and its cadence and sound pattern creates a significance in the minds of consumers beyond any descriptive significance of any single element of the Mark. Applicant's 5 STYLE GROOM Mark is, at worst, suggestive, as it features a term with non-descriptive meaning as applied to the recited goods, does not explicitly describe the goods, does not comport with any relevant dictionary definition, and a consumer seeing the Mark would not know the recited goods offered under the Mark or understand the primary features and characteristics of the goods based on the product brand name alone.

Applicant has coined the term 5 STYLE GROOM for its line of trimmer and clipper products and has applied to register its unique mark 5 STYLE GROOM in relation to the Class 8 clipper and trimmer goods stated herein. Applicant's coined term 5 STYLE GROOM does not immediately invoke an impression and understanding of "electric hair trimmers and clippers" or the primary features and characteristics of the same, and is therefore suggestive, if not arbitrary. One hypothetically merely descriptive interpretation of the "5 STYLE GROOM" Mark might be that the products are intended for creating five different styles or cutting lengths, or possibly that a purpose, intended use, or a result of using the products is to style and groom hair in five different styles. However, there is no indication that the products offered under the 5 STYLE GROOM Mark are intended for these purposes or that a use, purpose, or result of the products is as described by the Examiner. Indeed the products are not intended for and do not serve these purposes. Rather, consumers must go through a series of "mental gymnastic" thoughts and engage their imagination to discover or reveal an understanding of the nature and features of the recited products under Applicant's Mark, specifically, that the product features Applicant's 5-in-1 blade and that the product is intended for use in animal hair grooming on up to five different animal coats/hair types. Neither of these features are immediately understood upon initial review of the Mark. As noted on Applicant's advertising materials describing and discussing the 5 STYLE GROOM products and its features (see <https://www.petsmart.com/dog/grooming-supplies/hair-clippers-and-trimmers/wahl-5-style-groom-pet-grooming-clipper-59969.html?cgid=100257>): "Coat Type: Trim Only, Smooth/Short, Medium, Heavy, Curly" and ""This 5-in-1 blade features 5 different blade sizes." While not formally being submitted as a specimen of use, the following images from Applicant's advertisement of its 5 STYLE GROOM product on a third-party website (www.petsmart.com) are presented to provide the Examining Attorney a better understanding of the product being offered for sale under the 5 STYLE GROOM Mark:

POWER THROUGH



and

DESCRIPTION

The Wahl 5 Style Groom by Wahl features Wahl's signature 5-in-1 blade; a preferred option of professional groomers around the world. This 5-in-1 blade features 5 different blade sizes - #9, #10, #15, #30, and #40 in one convenient blade. The 5 Style Groom is a great option for shaving down small or medium sized dogs with fine coats but can also be used on large dogs with thick coats with trimming sensitive areas such as paws, faces, ears, and sanitary areas. Your 5 Style Groom kit comes with one removable, rechargeable battery with a run time of 80 minutes.

This material also shows another set of “5” such as the areas for cutting/trimming, namely, in addition to the animal’s body, sensitive areas including paws, face, ears, and sanitary areas.

This shows that the “5 style” in Applicant’s Mark, and specifically the use of the number “5,” is not used by Applicant to reference 5 different styles or lengths in which the trimmer or clipper can cut or 5 different hair styles the product can create, but rather, the Applicant’s signature 5-in-1 blade, 5 different types of animal hair and coat types, and 5 areas on the animal that the product can be used on for animal hair styling and grooming. “5 style” does not immediately describe or refer to a quality or function of the product, nor to a result a consumer would achieve by using the product. Significantly, the true primary nature and features of the goods are not readily and immediately discernable upon initial view of Applicant’s Mark on the product. As such, 5 STYLE GROOM is not merely descriptive of the products.

The Examining Attorney improperly dissects and defines each term in Applicant’s unitary mark separately to conclude that: “As such, the mark is merely descriptive of the

applicant's goods, namely, clippers and trimmers used to style and groom hair in five different cutting lengths." While this could be one possible interpretation of Applicant's Mark, it is not the intended interpretation by Applicant, nor is it the readily understood meaning by consumers. Rather, Applicant's goods contain Applicant's signature 5-in-1 blade and can be used on different styles and types of animal hair and coats, for different grooming areas on the animal, and are intended to appeal to consumers seeking to use a single electric hair clipper or trimmer with a single blade that can be used to clip or trim up to 5 different types or styles of animal hair/coats. The Examiner's misunderstanding and alternative interpretation itself is evidence that the Mark is not *merely descriptive* of the relevant goods at issue, but rather, requires some imagination and thought to understand the goods involved under the Mark and the primary features and characteristics of those goods.

Applicant's 5 STYLE GROOM mark is only suggestive of one potential or desired characteristic of its goods, and does not give purchasers a full and accurate description of the goods, or any distinct knowledge about the characteristics of Applicant's goods. Suggestive marks require the consumer to use imagination, thought, or perception to reach a conclusion as to the nature of the goods or services. As stated in the Trademark Manual of Examining Procedure (TMPEP) (section 1209.01(a)):

Suggestive marks are those that, when applied to the goods or services at issue, require imagination, thought or perception to reach a conclusion as to the nature of those goods or services. Thus, a suggestive term differs from a descriptive term, which immediately tells something about the goods or services. *See In re Shutts*, 217 U.S.P.Q. 363 (T.T.A.B. 1983) (SNO-RAKE held not merely descriptive of a snow removal hand tool). *See also In re Quik-Print Copy Shop, Inc.*, 203 U.S.P.Q. 624 (T.T.A.B. 1979), *aff'd*, 616 F.2d 523, 205 U.S.P.Q. 505 (C.C.P.A. 1980) (QUIK-PRINT held merely descriptive of printing services); *In re Aid Laboratories, Inc.*, 223 U.S.P.Q. 357 (T.T.A.B. 1984) (BUG MIST held merely descriptive of insecticide). Suggestive marks, like fanciful and arbitrary marks, are registrable on the Principal Register without proof of secondary meaning. Therefore, a designation does not have to be devoid of all meaning in relation to the goods and services to be registrable.

Applicant's mark requires the exercise of imagination, mental processing or gathering of further information in order for purchasers and prospective users of Applicant's goods to readily perceive the merely descriptive significance of the Mark. Consumers are not *immediately* able to discern the applied-for goods from reviewing the mark 5 STYLE GROOM because it is not readily apparent what the mark 5 STYLE GROOM has in connection with the applied-for goods. As described above, the Mark *could be* perceived to indicate a grooming tool intended to style hair in 5 different ways, a hair clipper used to cut hair in 5 different lengths, a hair clipper or trimmer intended to create 5 different hair styles, among other things. A Mark that is capable of so many different reasonable interpretations, by definition, is not merely descriptive.

Moreover, to be merely descriptive under 2(e)(1), the mark must describe the goods in some degree of particularity. *In re TMS Corp.*, 200 U.S.P.Q. 57 (TTAB 1975). In the case of *In re TMS Corp.*, for example, the Board found the mark THE MONEY SERVICE to be suggestive, rather than descriptive, of money-wiring services. The Board stated that because the mark consisted of general terms, "it suggests a number of things, but yet falls short of describing applicant's services in any one degree of particularity." *Id.* at 59. Likewise, Applicant's 5 STYLE GROOM mark falls short of describing Applicant's "electric hair clippers; electric hair trimmers" goods in any meaningful way.

Similar to THE MONEY SERVICE, which conveyed, at most, some general aspect of the services provided under that mark, 5 STYLE GROOM could suggest a number of products, characteristics, or services, and only at the creative end of that investigation would there be an interpretation of Applicant's specific goods. Specifically, although a relevant consumer might perceive 5 STYLE GROOM as vaguely indicating an association with styling and grooming hair through the use of electric hair trimmer and clipper goods, consumers would need additional information to determine anything in particular about the goods offered under Applicant's mark. Such an imprecise and general connection between the mark and the product does not rise to the level of merely descriptive, but rather should be viewed, at most, as suggestive.

2. The Evidence Cited by the Office Does Not Support the Conclusion that Applicant's Mark is Merely Descriptive

Applicant's Mark is not merely descriptive of its goods, and the burden of proof in establishing descriptiveness is on the U.S. Patent and Trademark Office.

There is insufficient evidence to demonstrate that the term "5 STYLE GROOM" is merely descriptive of Applicant's goods. Applicant's 5 STYLE GROOM mark is, *at most*, suggestive of a potential or desired characteristic of its goods, and does not give purchasers a full and accurate description of the goods, or any distinct knowledge about the characteristics of Applicant's goods.

In support of the descriptiveness refusal, the Examining Attorney relied solely on a caption from a product listing on a third-party retailer site selling Applicant's specific product and on definitions for the individual words "style" and "groom". However, none of the Examining Attorney's evidence refers to any use of Applicant's coined term 5 STYLE GROOM for *Applicant's* relevant goods, namely, electric hair clippers and trimmers. Definitions of the individual terms "style" and "groom" alone are insufficient to demonstrate the overall mark 5 STYLE GROOM is merely descriptive of *Applicant's goods*. And as described further herein, in making a determination as to whether a mark is merely descriptive, it is improper to dissect the mark and consider its individual parts to conclude that the overall mark as a whole is merely descriptive.

Therefore, the Examining Attorney did not provide any relevant evidence that the public understands 5 STYLE GROOM to merely describe and refer to Applicant's goods, electric hair clippers and trimmers. If others needed to use the term to describe the same or related goods, then evidence would exist that others do indeed use 5 STYLE GROOM to describe these goods. **The fact such evidence does not exist is evidence that others do *not* need to use Applicant's Mark to describe the same or similar goods.** The reasons for denying registration to marks that are merely descriptive, including the need for others to use the mark, are delineated in *In re Abcor Development Corp.*, 588 F.2d 811, 813, 200 U.S.P.Q. 215, 217 (C.C.P.A. 1978):

The major reasons for not protecting such marks are: (1) to prevent the owner of a mark from inhibiting competition in the sale of particular goods; and (2) to maintain freedom of the public to use the language involved, thus avoiding the

possibility of harassing infringement suits by the registrant against others who use the mark when advertising or describing their own products.

Applying this standard to the case at hand, it is clear that registration of Applicant's 5 STYLE GROOM mark will not inhibit competition or limit the freedom of the public to use the language involved. If a mark is merely descriptive, this necessarily means that others need to use the term to describe the goods.

Moreover, *even if* Applicant's mark arguably contains descriptive elements, that does not alter the conclusion that the mark is not merely descriptive as a whole. Descriptive meaning must be communicated to the public through the applied-for mark as a whole, not through an analysis of its various component parts. *See In re Federated Dept. Stores*, 3 U.S.P.Q.2d 1541 (T.T.A.B. 1987) (holding THE CHILDREN'S OUTLET registrable and not merely descriptive of retail children's clothing store services); *Hunter Publishing Co. v. Caufield Publishing Ltd.*, 1 U.S.P.Q.2d 1996 (T.T.A.B. 1986) (holding SYSTEM USER registrable and not merely descriptive of a period trade journal).

The Supreme Court provides instruction on this very principle:

The commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety. . . .

Estate of P.D. Beckwith, Inc. v. Commissioner of Patents, 252 U.S. 538, 545-46 (1920).

The Examining Attorney's primary evidence that consists solely of evidence of the dissected words – i.e., separate dictionary definitions for “style” and “groom” – belies the Supreme Court's clear mandate that marks are not to be separated and considered in detail. One must not dissect the mark into its component parts, but must consider the mark in its entirety. *See In re Application of Colonial Stores, Inc.*, 394 F.2d 549, 552 (C.C.P.A. 1968) (holding SUGAR & SPICE registrable and not merely descriptive of bakery products); *Mercury Record Corp. v. Custom Fidelity Records*, 129 U.S.P.Q. 368, 369 (T.T.A.B. 1961) (holding CUSTOM FIDELITY registrable and not merely descriptive of audio recordings). When viewed in its entirety, as required, the 5 STYLE GROOM mark has no dictionary or popular meaning. 5

STYLE GROOM is a term coined by Applicant. Accordingly, the mark conveys a novel and imaginative commercial impression. Indeed, a Google search for “5 STYLE GROOM” revealed that nearly all search results, that is 15 of 19 hits, refer specifically to Applicant’s products. *See Exhibit A* attached hereto and incorporated herein.

In sum, the Office has provided no evidence that “5 STYLE GROOM” is commonly understood by the relevant public to refer to anything other than Applicant’s goods. Therefore, this dearth of evidence strongly supports the conclusion that Applicant’s mark is not merely descriptive of the goods offered, and the evidence submitted by the Examining Attorney is insufficient to demonstrate that the mark 5 STYLE GROOM is merely descriptive of Applicant’s goods.

3. The Trademark Office Has Not Met Its Burden of Proof

The Trademark Office has the burden of demonstrating that a term is merely descriptive of the identified goods. Applicant believes that the Office has not met its burden in this case. It would be speculative to assume without further evidence that consumers will observe Applicant’s Mark in connection with its Applicant’s Goods and will immediately understand the mark to merely describe some characteristic or feature of those goods.

4. The Benefit of the Doubt Must Be Resolved in Applicant’s Favor

In situations involving the potential descriptiveness of a trademark, the benefit of the doubt goes to the Applicant. As noted, there is a lack of sufficient evidence to prove that Applicant’s mark is merely descriptive. The Trademark Trial and Appeal Board recognizes that “there is often a thin line of demarcation between a suggestive term and a merely descriptive term, and that the determination is often difficult and somewhat subjective [A]ny doubt with respect to the issue of descriptiveness should be resolved in applicant’s behalf.” *In re Grand Metropolitan Foodservice, Inc.*, 30 U.S.P.Q. 2d 1974, 1976 (TTAB 1994) (reversing a §2(e) refusal to register “MufFuns” in stylized script for baked mini muffins). As made clear in this Response, at the very least, *there is doubt* with respect to the issue of descriptiveness of 5 STYLE GROOM in relation to Applicant’s goods. That doubt must be resolved in Applicant’s favor.

Applicant submits that its 5 STYLE GROOM mark is not merely descriptive and respectfully requests that the objection of mere descriptiveness be removed, the disclaimer offered of the term “groom” be entered into the record, and the application be allowed to proceed to publication.

Conclusion

All matters in the Office Action having been addressed above, Applicant respectfully requests the Examining Attorney withdraw the objection and pass Applicant’s 5 STYLE GROOM Mark to publication.

Dated: July 31, 2020

Respectfully submitted,

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