

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: SharkNinja Operating LLC
Mark: FOODI
Application No. 88703624
Application Date: November 22, 2019
International Class: 09

To: Victor Cerda
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RESPONSE TO OFFICE ACTION

In the Office Action dated March 3, 2020, the Examining Attorney refused registration of SharkNinja Operating LLC's ("Applicant") application for FOODI, Serial No. 88703624 (the "FOODI Mark"), on the grounds that (i) FOODI is a merely descriptive mark and (ii) the wording of the description of goods is indefinite.

Applicant agrees to amend the description of goods from the applied-for "Thermometers not for medical use; meat thermometers; food thermometers; food probes" to the proposed "Thermometers not for medical use; meat thermometers; food thermometers; food probes, namely, meat thermometers" in Class 09 as suggested by the Examining Attorney.

As set forth below, the evidence regarding the meaning of the word "foodie," the relevant case law discussing suggestive marks, Applicant's current FOODI registrations on the Principal Register, and the FOODIE third-party registrations for goods within the cooking industry on the Principal Register all establish that Applicant's FOODI Mark is suggestive and not merely descriptive. For these reasons, Applicant respectfully disagrees with the Examining Attorney's findings and requests that the Examining Attorney withdraw the refusals and allow FOODI to proceed to publication in International Class 09.

I. Applicant's FOODI Mark Requires Imagination, Thought, or Perception to Reach a Conclusion as to the Nature of Applicant's Goods.

A mark is considered merely descriptive if it immediately describes an "ingredient, quality, characteristic, function, feature, composition, purpose, attribute, use of such goods." TMEP §1209.01(b); *In re Bayer Aktiengesellschaft*, 488 F.3d 960 (Fed. Cir. 2007). The FOODI Mark does not immediately describe a quality, feature, function, or characteristic of applicant's amended goods in Class 09: "Thermometers not for medical use; meat thermometers; food thermometers; food probes, namely, meat thermometers".

Rather, the FOODI Mark is suggestive because it requires imagination, thought, or perception to reach a conclusion as to the nature of the goods or services. See TMEP 1209.01(a);

In re Gyulay, 820 F.2d 1216, 1217 (Fed. Cir. 1987). The ordinary consumer seeing the FOODI Mark would not immediately draw the conclusion that the applied-for goods are thermometers. Instead, a consumer would be required to make a mental leap to derive the nature of Applicant's goods from the mark. When a mark requires such imagination or thought, the Board has ruled in favor of the Applicant and determined the mark is suggestive. See *In re George Weston Limited*, 228 U.S.P.Q. 57, 58 (TTAB 1985) (finding SPEEDI BAKE to be suggestive for frozen dough); *In Re Sovex Foods, Inc.*, 1999 TTAB LEXIS 465, *10 (TTAB August 18, 1999) (finding SOY MOO to be suggestive of non-dairy milk substitutes); *In re Stahlbush Island Farms, Inc.*, 2005 TTAB LEXIS 548, *11 (TTAB December 20, 2005) (finding FARMERS MARKET to be suggestive of canned and frozen fruit and vegetables sold through supermarkets).

In this instance, the Examining Attorney has stated that the mark is merely descriptive because it "merely describes intended users of applicant's goods" and has stated that the definition of "foodie" is "a person who enjoys and cares about food very much." This definition does not immediately describe a quality, feature, function, or characteristic of Applicant's applied-for goods. Further, Applicant submits alternative definitions of foodie that show the word describes highly-sophisticated food lovers. Applicant submits a definition of foodie from Oxford Languages: "foodie: a person with a particular interest in food; a gourmet." See **Exhibit A**. Applicant also submits the definition of a gourmet from the same source: "gourmet: a connoisseur of good food; a person which a discerning palate." See **Exhibit B**.

In support of its argument, The Examining Attorney has cited to cases that are not fully applicable to the present case: *In re Planalytics, Inc.*, 70 USPQ2D 1453 (TTAB 2004) (the Board held GASBUYER to be merely descriptive of intended user of risk management services for pricing and purchasing natural gas) and *In re Camel Mfg. Co.*, 222 USPQ 1031 (TTAB 1984) (the Board held MOUNTAIN CAMPER to be merely descriptive of intended users of retail and mail order services for outdoor equipment and apparel). Rather, these cases are clear examples of marks that immediately describe the intended users of the goods.

In *In re Planalytics*, the Examining Attorney provided examples of the words "gas buyer" used commonly in connection with purchasers of gas supplies to support its descriptiveness refusal. Additionally, the Board stated: "Applicant's identification of services makes it clear that its services are directed to those who are in the field of making purchasing decisions for natural gas. The evidence supports the conclusion that these people would be referred to as gas buyers." *In re Planalytics, Inc.* 70 USPQ2D 1453, 1456 (TTAB 2004). Thus, the word "GASBUYER" immediately indicates a buyer of gas.

Similarly, in *In re Camel Mfg. Co.*, 222 USPQ (BNA) 1031 (TTAB 1984), the Applicant filed an application for MOUNTAIN CAMPER in relation to "retail and mail order services in the field of outdoor equipment and apparel". The Board held that the applicant's goods "are directed toward the category of purchaser we could refer to as the 'mountain camper' [which is] clear from a perusal of applicant's Winter 1982 catalog... Among the products offered for sale in the catalog are trail boots, hiking boots, and hiking staffs [the latter of which, the catalog notes, are useful 'when crossing these treacherous mountain streams or climbing a steep terrain.]" *Id.* at 1032. The Board pointed out the clear connection between the term MOUNTAIN CAMPER and a purchaser of hiking boots for use on mountains. Further, the Board stated: "we embrace

the holding that a mark is merely descriptive if it describes the type of individuals to whom an *appreciable number or all* of a party's goods or services are directed.” (Emphasis added) *Id.*

These cases are clearly distinguishable from the present case. The FOODI Mark does not describe an intended user of the goods, as the word “foodie” indicates sophisticated and skilled cooks and consumers. The purchasers of Applicant's goods cannot be described as foodies the way the term is generally understood. As is indicated on Applicant's website, Applicant creates all of its products, including the applied-for goods, for everyday home-cooks – people who aim to simplify and quicken the cooking process as much as possible. **Exhibit C.**

Applicant points to two directly applicable cases to illustrate its point. When an applied-for mark is descriptive of a highly-skilled person but the goods are aimed at the “do-it-yourself” purchasers of the goods, the Board has ruled in favor of the Applicant. For example, in *In re CHESEBROUGH-POND'S INC.*, 1969 TTAB LEXIS 122, the Applicant applied for the mark MANICURIST BY CUTEX for “nail polish”. The Examining Attorney refused registration because “the word ‘Manicurist’ is ‘descriptive of the use of the goods, i.e., the product is to be used by a manicurist.’” The Board overturned the Examining Attorney because it accepted Applicant's arguments that the purchasers of its nail polish were not manicurists but were do-it-yourselfers who paint their own nails: “We think that it is entirely clear that the word ‘manicurist’ does not describe nail polish or any characteristic or quality of nail polish. We are further of the opinion that an average woman upon encountering the term “MANICURIST BY CUTEX” in the ordinary channels of trade therefor would not thereby conclude that the mark signified a nail polish specifically for use by manicurists.” *Id.* at *1-2.

In a similar situation, an Applicant applied for the mark MASTER ELECTRICIAN for use in connection with goods related to electric power trips, extension cords, antennas, lighting fixtures, flashlights, and related goods. The Examining Attorney refused registration on the basis of mere descriptiveness. However, the Applicant made clear that the goods were targeted to “do-it-yourself” homeowners rather than skilled electricians. *In re True Value Co.*, 2008 TTAB LEXIS 391, *8 (TTAB 2008). The Board determined that the important question was whether an appreciable number or all of the applicant's goods were directed toward master electricians. *Id.* at *12 (citing *In re Camel Mfg. Co., Inc.*). Under this test, the Board found that the majority of consumers were not skilled electricians, and, therefore, the mark was not descriptive of the goods or intended users of the goods.

Applicant respectfully requests that this same rationale be applied in the present case, as these cases are directly applicable. The purchasers of Applicant's goods are not sophisticated, gourmet-eating, highly-skilled foodies. Rather, they are at-home cooks who use Applicant's products to make cooking and food preparation easier.

It is well-settled that courts will rule in favor of applicants with regard to the descriptiveness of a mark when the mark does not *immediately* describe Applicant's goods or conjure up an image of the applied-for goods. *In re TT Elecs. Tech. Ltd.*, 2009 TTAB LEXIS 240 (Mar. 6, 2009) (Board reversed an Examining Attorney's descriptiveness refusal for AUTOPAD for “electronic sensors for the determination of position, speed, and angle for use in the automotive industry”); *In re Clear Channel Outdoor, Inc.*, Serial No. 78962079 (Board reversed Examining Attorney's descriptiveness refusal to register TAXI ENTERTAINMENT NETWORK for out-of-home advertising services because the mark required mental steps to

determine the services offered in connection with the mark); *BIC Corp. v. Far Eastern Source Corp.*, 2000 U.S. Dist. LEXIS 18226 (S.D.N.Y. Dec. 17, 2000) (Court ruled WITE-OUT was suggestive for correction products including fluid, pens, and tape because although it the mark was logically related to the goods, the mark did not imply the goods); *Playtex Products v. Georgia-Pacific Corp.*, 390 F.3d 158 (2d Cir. 2004) (Court ruled that WET ONES for wet bath towelettes was not descriptive, because the mark did not conjure up the image of wet bath towelettes and could plausibly describe a wide variety of products).

Applicant argues it would require consumers to make an imaginative leap to make accurate conclusions about the goods based on the FOODI Mark. Applicant further states that neither all nor an appreciable number of Applicant’s goods are not directed toward foodies. For these reasons, the FOODI Mark should be considered suggestive in connection with the applied-for goods.

II. The Applicant’s other FOODI Registrations and Numerous Third-Party Variations Thereof Establish that Applicant’s FOODI Mark is Suggestive.

Applicant respectfully requests that the Examining Attorney view the record of FOODI applications and registrations owned by Applicant currently on the Principal Register. **Exhibit D.** All of the below marks were applied-for in connection with kitchen and cooking appliances and/or tools to aid in the cooking process. Applicant argues that the existence of these marks on the Principal Register demonstrate the mark is suggestive in connection with the applied-for goods.

Mark	Serial No - Status	Class	Goods	Disclaimer
FOODI	Serial No. 87748160 - Registered	11	11 - Electric pressure cooker; Air fryer; Multi-purpose, electric countertop food preparation apparatus, namely, air fryer and pressure cooker	N/A
FOODI	Serial No. 88416625 – Registered	7	7 - Electric kitchen appliances for household use, namely, electric food blenders, electric food choppers and electric food processors, electric mixers, electric food and meat grinders, electric coffee grinders, electric juicers, electric juice extractors, electric food slicers, electric graters; heated blenders	N/A
FOODI FAMILY	Serial No. 88536959 – Allowed	7 11	7 - Electric kitchen appliances for household use, namely, electric food blenders, electric food choppers and electric food processors, electric mixers, electric food and meat grinders, electric coffee grinders, electric juicers, electric	N/A

			juice extractors, electric food slicers, electric graters; Heated blenders 11 - Electric pressure cooker; Air fryer; Multi-purpose, electric countertop food preparation apparatus, namely, air fryer and pressure cooker; Countertop ovens; Indoor grills	
FOODI	Serial No. 88416802 – Allowed	11	11 - Countertop cooking ovens; electric indoor grills	N/A

In addition to Applicant’s other FOODI marks for kitchenware, the FOODIE third-party registrations on the Principal Register registered in connection with the cooking industry illustrates that the USPTO has not uniformly deemed such marks to be descriptive. Copies of the registrations are attached hereto as **Exhibit E**.

Mark	Registration No.	Class	Goods	Disclaimer
Q.D. FOODIE	87389591	09	Measuring cups; measuring spoons.	N/A
FOODIE WITH FAMILY	5508117	41	On-line journals, namely, blogs featuring recipes, ingredients, and cooking information; Providing online newsletters in the field of recipes, ingredients, and cooking information via e-mail.	N/A
FOODIE AND FRIENDS	5774964	41	Entertainment in the nature of an ongoing television miniseries in the field of Music, travel Food; Entertainment services in the nature of development, creation, production, distribution, and post-production of original content in various countries highlighting culture, Music and food; Entertainment services in the nature of namely, production and distribution of original video content and providing a website featuring online non-downloadable videos and articles featuring editorials, how-tos, and recipes, and organizing and hosting cultural events, all featuring the exploration of the global culinary experience and the diverse cultures that comprise it, chefs and home cooks, politics and food celebrities, offering a unique perspective	N/A

			on the intersection of food and culture; Providing an Internet website portal featuring entertainment news and information specifically in the field of Travel, Food, Music.	
SPECIALFOODIE	4977319	42	Providing a web site that gives users the ability to create and share customized food preferences and dietary restriction profiles, view food preference and dietary restriction profiles of dining guests, and have menus created for them from a database of recipes for meals that reflect the food preference and dietary restriction profiles of guests.	N/A
SPECIALFOODIE	4837529	42 43	42 - Providing a website that gives users the ability to create customized web pages featuring user-defined profiles of food preferences; providing online services, namely, creating an online community for registered users to establish profiles of food preferences. 43 - providing a website featuring information in the field of recipes and cooking.	N/A
DIABETIC FOODIE	4217226	41	On-line journals, namely, blogs featuring articles, recipes, and information in the field of diabetes awareness, food, cooking, nutrition and health for people suffering from diabetes; Providing a website featuring blogs and non-downloadable publications in the nature of articles, recipes, and newsletters in the fields of diabetes awareness, food, cooking, nutrition and health for people suffering from diabetes.	DIABETIC
G-FREE FOODIE	3912361	41	on-line journals, namely, blogs featuring articles regarding gluten free food; providing on-line publications in the nature of journals, blogs, articles, recipes, and reviews in the field of gluten free foods.	GLUTEN-FREE

Even though third-party registrations do not bind the USPTO, the Federal Circuit “encourages the [US]PTO to achieve a uniform standard for assessing [the] registrability of marks.” *In re Nett Designs, Inc.*, 236 F.3d 1139, 1342 (Fed. Cir. 2001).

III. Any Doubt as to Whether Applicant’s FOODI Mark is Merely Descriptive or Suggestive Must be Resolved in Favor of the Applicant.

The Examining Attorney bears the burden to show that a mark is merely descriptive. *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 964 (Fed. Cir. 2007). Where doubts exist as to whether a term is merely descriptive, it is the practice of the Board to resolve doubts in favor of the applicant and allow the application to proceed to publication. *In re Am. Standard Inc.*, 223 USPQ 353, 355 (TTAB 1984) (if the Board is left with conjecture and doubts regarding the descriptiveness of a mark, prevailing case law requires resolution in favor of the applicant). Applicant respectfully submits it has, at a minimum, raised doubt as to whether the FOODI Mark is descriptive in relation to the applied-for goods.

CONCLUSION

The relevant case-law, Applicant’s previous registrations and applications for similar goods, and the third-party picture clearly establish that Applicant’s FOODI Mark is suggestive in connection with the applied-for goods. Therefore, Applicant respectfully requests that the Examining Attorney withdraw the refusal to register Applicant’s FOODI Mark and approve FOODI for publication.

Dated: September 03, 2020

Respectfully submitted,
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