

TRADEMARK LAW OFFICE 110
Trademark Examining Attorney:
Shaunia Carlyle
Serial Number: 88847793
Mark: ROOTPHOS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: J.R. Simplot Company

Trademark Examining Attorney: Shaunia Carlyle

Commissioner of Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

RESPONSE TO OFFICE ACTION

On November 7, 2020, the Examining Attorney issued a second Office Action for the mark ROOTPHOS (“Applicant’s Mark”), continuing the refusal to register Applicant’s Mark and requesting information regarding whether Applicant’s goods contain phosphate. Applicant provides the information requested but respectfully disagrees with the Examining Attorney’s refusal to register. Applicant submits the following Remarks addressing the Examining Attorney’s concerns.

REMARKS

I. Request for Information.

The Examining Attorney has asked whether Applicant’s goods contain phosphate and also whether the term “phosphate” has any meaning or significance in the trade or industry in which Applicant’s goods and/or services are manufactured or provided, any meaning or significance as applied to Applicant’s goods and/or services, or if such wording is a term of art within Applicant’s industry. Applicant responds that its goods do contain phosphate and that the term does have meaning in the industry in which Applicant’s goods are manufactured or provided. Specifically, pursuant to the Association of American Plant Food Control Officials, it means “the amount of pentavalent phosphorus {P(V)} present in the material calculated as phosphorus pentoxide (P2O5).” AAPFCO official publication terms and definitions (Official 1997).

II. The Phrase “ROOTPHOS” Is Not Merely Descriptive.

The Examining Attorney argues that “ROOTPHOS” is merely descriptive and retains its descriptive meaning in relation the goods. In support of this argument, the Examining Attorney cites various third-party marks to demonstrate that the terms “root” and “phos” have been disclaimed in relation to goods that are the same or similar to Applicant’s goods. However, with the exception of only one of the cited registrations, the terms in the cited marks are individual and

not telescoped or combined, as they are in Applicant's Mark. Further, the only term that is combined in the cited registrations – ROOTFEEDER – was disclaimed as two separate words, i.e., “root feeder,” not “rootfeeder.” Accordingly, Applicant reiterates its previous arguments that the Mark is not merely descriptive. Applicant also notes that, “The Board resolves doubts as to the mere descriptiveness of a mark in favor of the applicant.” *In Re Fat Boys Water Sports LLC*, 118 U.S.P.Q.2d 1511 (T.T.A.B. 2016).

If Disclaimer Is Necessary, The Words Should Be Disclaimed Separately.

If a compound word itself is not used descriptively, “the disclaimed portion should appear as two or more distinct words, separated by spaces.” TMEP 1213.05(a). As discussed in Applicant's previous response, Applicant has combined the terms “root,” “pH,” and “phos” to create a unique compound word mark, and therefore, the phrase is not used descriptively in relation to the goods. As a result, if disclaimer is required, the words should be disclaimed separately, and Applicant should obtain rights in the compound phrase: “ROOTPHOS.”

CONCLUSION

The foregoing Remarks establish that Applicant's Mark should be registered without a disclaimer on the Principal Register because “ROOTPHOS” is either unitary and not merely descriptive of Applicant's goods, or it is a nondescriptive composite phrase. However, if a disclaimer is required, Applicant respectfully requests that the Examining Attorney allow each word to be disclaimed separately, as opposed to disclaiming the phrase in its entirety.