

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Examining Attorney:
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Applicant: Talon Metals Corp

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Mark: GREEN NICKEL

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In an Office Action issued February 17, 2021, the Examiner refused registration of the applied-for mark under 15 U.S.C. § 1052(e)(1) on the basis that the applied-for mark, when used on or in connection with the services of Applicant, is merely descriptive. Applicant respectfully submits that GREEN NICKEL (or the “Mark”) is not descriptive of Applicant’s applied-for services and requests the Examiner to reconsider his refusal based on the arguments provided herein. Simply stated, while GREEN NICKEL would be descriptive if Applicant filed an application for goods that were actually green nickel; here, Applicant seeks registration for mining and drilling services for which GREEN NICKEL is not descriptive.

The Examiner has refused registration alleging that the mark GREEN NICKEL is not inherently distinctive and is merely descriptive of Applicant’s applied-for services which consist of “metal drilling and perforation” and “geophysical exploration for the oil, gas and min industries, mining exploration and mineral exploration services” (the “Services”). A mark is descriptive if it “consists merely of words descriptive of the qualities, ingredients or characteristics of the goods or services related to the mark.” DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd., 695 F.3d 1247, 1251 (Fed. Cir. 2012) (quoting In re Oppedahl & Larson LLP, 373 F.3d 1171, 1173 (Fed.Cir.2004)) (citations omitted). A suggestive mark, however, is one that “suggests, rather than describes.” Vision Center v. Opticks, Inc., 596 F.2d 111, 115 (5th Cir. 1979), cert. denied, 444 U.S. 1016 (1980). Whether a given mark is suggestive or merely descriptive depends on whether the mark “immediately conveys...knowledge of the ingredients, qualities, or characteristics of the goods...with which it is used,” or whether “imagination, thought, or perception is required to reach a conclusion on the nature of the goods.” In re Quik-Print Copy Shops, Inc., 616 F.2d 523, 525 (CCPA 1980). Any doubt as to whether a mark is suggestive or merely descriptive must be resolved in applicant’s favor so that the mark may proceed to publication for opposition by the public. See In re Merrill Lynch, Pierce, Fenner, and Smith, Inc., 828 F.2d 1567, 1571 (Fed. Cir. 1987); see also In re Rank Organization Ltd., 222 USPQ 324, 326 (TTAB 1984).

Here, the overwhelming evidence demonstrates that the Mark is suggestive rather than merely descriptive because (a) the Mark is incongruous when used in connection with the Services; (b) imagination, thought, or perception is required to draw a connection between the constituent

elements of the Mark and the Services; (c) the term GREEN NICKEL is coined by Applicant; (d) even if the mark were found to have a “descriptive connotation” it is still registerable on the Principal Register; and (e) third-party registrations demonstrate that the constituent elements of the mark are not descriptive of the Services. For the reasons set forth below, applicant respectfully requests the withdrawal of the descriptiveness refusal.

I. The Mark is Not Descriptive of the Services

It is a well-recognized rule of construction in trademark prosecution that a mark sought to be registered must be considered in its entirety. In re Hutchinson Tech., Inc., 852 F.2d 552, 554 (Fed. Cir. 1988); Estate of P.D. Beckwith, Inc. v. Comm’r of Patents, 252 U.S. 538, 545-46 (1920) (“The commercial impression of a trade-mark is derived from it as a whole, not from its elements separated and considered in detail”); see also Coca-Cola Co. v. Seven-Up Co., 497 F.2d 1351, 1353 (C.C.P.A. 1974) (“We have said, so often as not to require citation of authority, that marks must be viewed as the public sees them, i.e., in their entirety. In the present case, the record is devoid of evidence that the buying public would employ the scalpel technique envisioned by appellant.”).

Applicant offers that, when viewed as a whole, the Mark is not descriptive, but rather suggestive of the Services.

a. *The Mark is not descriptive because it is incongruous to the Services.*

One rationale for analyzing a mark as a whole rather than by its constituent elements is that “combinations of merely descriptive terms are registrable if their combination results in a new and different commercial impression and/or the term created imparts a unique, incongruous or otherwise non-descriptive separate meaning as used in connection with the goods or services.” In Re Restoration Spirits, Inc., No. 85575675, 2014 WL 4896403 (Sept. 19, 2014) (citing In re Colonial Stores, Inc., 394 F.2d 549 (CCPA 1968)). It is especially important to review a mark for an incongruous effect because incongruity is a strong indication that a mark is suggestive rather than merely descriptive, TMEP § 1209.01, which, here, is the heart of the Examiner’s refusal. Applicant offers that the Mark is suggestive, rather than descriptive, when viewed as a whole, because when the prefix “green” is combined with the word “nickel” it creates an incongruous composite that creates a distinctive commercial impression that is not descriptive of the Services.

Applicant agrees with the Examiner’s diction definition that the prefix “green” relates to beneficial to the environment or less harmful to the environment than others. See Examiner Attachments 11 and 12. But, equally important is the definition of “nickel,” which, in the context of the Examiner’s Office Action, is a reference to a noun meaning “[a] type of ore.” See Exhibit 7. If consumers are to understand these terms according to their dictionary definitions, they would expect that the Services would consist of an environmentally beneficial type of ore. This is not the case for the Mark.

The Services are not just an environmentally friendly type of ore developed and produced by the Applicant. The Services are an environmentally friendly and socially responsible

exploration and mining process. See Exhibit 12. The Services function principally as the “process of mining services, and the control of every step from mine to battery.” Id. The Services are themselves a high grade, small footprint mining process which uses carbon capture and storage. Nickel is the end product of Applicant’s services, not what is covered by the Mark. The purpose of mining services is to create an environmentally friendly and socially responsible process. Thus, there is no “environmentally beneficial type of ore” as part of the Services and, therefore, the Mark does not immediately convey knowledge to the consumer of the ingredients, qualities, or characteristics of the Services.

The term “nickel” in the mark only *suggests* to the consumer that the process could be used in connection with a type of ore. Nevertheless, this use does not undermine the incongruity of the mark as applied to the Services. Applicant is not requesting a trademark for “green drilling” or “green mining”, but for “green nickel”. “Drilling” and “nickel” are not synonymous. In fact, “it is not necessary that the meaning of a term be changed in order for an incongruity to exist.” In Re Corp. Fuel Partners, LLC, No. SERIAL 78705685, 2010 WL 3501479 (Aug. 27, 2010). “[D]ictionary words may be used in association with words or terms so as to create a notation which, as a whole, serves to suggest the well-known significance of the term rather than describe with any degree of particularity some quality or characteristic of the goods in connection with which it is used.” In re Hampshire-Designers, Inc., 199 USPQ 383, 384 (TTAB 1978). When the word “nickel” is coupled with the prefix “green,” the commercial impression is such that the nickel would be environmentally friendly, and here, even when the Services are used in connection with an environmentally friendly ore, it is not descriptive of any quality or characteristic of the Services, and therefore the Mark is not descriptive within the context of the identification.

Other brands in the mining services industry do in fact offer clean nickel and, therefore, could be considered a “environmentally friendly nickel”; however, neither the Services nor the process described in the identification are such products. One brand offering their key technologies to establish their brand as a Zero-Carbon footprint operation by using existing hydrometallurgical processes to produce nickel products. Another such product is referred to as “being focused on value-adding the whole value chain with the recovery of battery-grade nickel and working on processing nickel and minimizing tailings with solutions to energy challenges.” These products are immediately distinguishable from applicant’s Services in that the end result is primarily focused on the nickel, rather than the mining service process. The combined GREEN NICKEL is therefore incongruous when used in connection with the Services because the Services do not match the meaning of the Mark as the reasonable consumer would understand it from the Mark’s constituent elements.

b. The consumer must use imagination to understand the real nature of the Services when viewing the Mark.

The Mark is suggestive because imagination, thought, or perception is required to draw the connection between the constituent elements of the mark and the real nature of the Services. “The most popular method to determine the suggestive-descriptive boundary is the “imagination” test.” 2 McCarthy on Trademarks and Unfair Competition § 11:67 (5th ed.). According to the often-quoted formulation of the imagination test, as expressed by Judge Weinfeld in Stix Prod., Inc. v.

United Merchants & Mfrs., Inc., 295 F. Supp. 479 (S.D.N.Y. 1968), “[a] term is suggestive if it requires imagination, thought and perception to reach a conclusion as to the nature of the goods.” If the consumer must exercise “mature thought or follow a multi-stage reasoning process” to determine attributes of the goods, then the term is suggestive and not descriptive. In Re Tennis in the Round Inc., 199 U.S.P.Q. (BNA) 496 (T.T.A.B. Mar. 28, 1978).

Here, GREEN NICKEL is not merely the sum of descriptive parts; it is something more, something that requires the consumer to engage in a multi-step thought process to understand what the combination of the terms mean in the context of the Services. The Services are designed to be used as “green energy for an electric mine fleet while working to protect the environment.” See Exhibit 13. Stated plainly, to mine elements in an environmentally friendly way. Thus, the term “nickel” in the Mark conveys process which results in the end product of the mining service. The consumer comes to understand that the mining process uses modern techniques to minimize environmental impacts resulting in environmentally friendly nickel. *Id.*

As noted, “[a]pplicant’s website shows ‘we believe that nickel should be produced in an environmentally friendly and socially responsible way. It means that from mine to battery, every step is carefully controlled.’ Thus, the proposed mark describes the environmentally-friendly nickel developed and produced by applicant.” A consumer, much like the Examiner, may associate the term “nickel” with a type of ore—understanding it initially as a noun—but after a multi-step reasoning process, the consumer will come to understand the term “nickel” as a verb in that the Services do not include, create, or apply to a “environmentally friendly type of ore,” but rather, the Mark has another meaning in that the Services is the mining services process which then results in the environmentally friendly ore. See definition of “nickel” as Exhibit 7. It is for this reason that the mark is not descriptive, as it does not immediately convey knowledge of the ingredients, qualities, or characteristics of the Services. Thus, the Mark is merely suggestive.

c. The Mark is not descriptive because it is coined my Applicant.

Even if the Examiner disagrees with the above arguments, the Mark is still not descriptive because it is a unique term coined by Applicant not otherwise used in the mining services industry. It is well settled that two or more words that would be merely descriptive by themselves can be joined together into a single term in such a way that the resulting term is a valid technical trademark. See Minnesota Min. & Mfg. Co. v. Johnson & Johnson, 454 F.2d 1179, 1181 (C.C.P.A. 1972) (SKINVISIBLE); Coca-Cola Co., 497 F.2d at 1353 (THE UNCOLA); In re Ada Milling Co., 205 F.2d 315 (1953) (STARTGROLAY); In re Colonial Stores, 394 F.2d 549 (1968) (SUGAR & SPICE); In re Chesapeake Corp. of Virginia, 420 F.2d 754 (1970) (SUPERWATERFINISH); Henry Muhs Co. v. Farm Craft Foods, Inc., 37 F.Supp. 1013, (E.D.N.Y., 1941) (FARMCRAFT). It follows that evidence of such uniqueness is an indication that the mark is not merely descriptive of the applied-for goods. See Coca-Cola Co., 497 F.2d at 1355; see also Firestone Tire & Rubber Co. v. Goodyear Tire & Rubber Co., No. 76-504, 1976 WL 21295 at *2 (C.C.P.A. Apr. 1, 1976); In re Automatic Radio Mfg. Co., 404 F.2d 1391, 160 USPQ 233 (1969).

Applicant asserts that GREEN NICKEL has never been used in the mining services industry and is thus a suggestive mark. The fact that GREEN NICKEL consists of two known

terms in the English language is of no consequence. A coined mark is registerable even if it is merely a combination of existing words. Coryn Grp. II, LLC v. O.C. Seacrets, Inc., 868 F. Supp. 2d 468, 485 (D. Md. 2012) (finding SEACRETS, a combination of the English words “sea” and “secrets,” to be coined and suggestive). Such a mark “may not be wholly fanciful (because it is phonetically identical to a common word) or arbitrary (because it is not actually a ‘real’ word), [but] it is unquestionably suggestive, and therefore a strong, distinctive mark.” Id. (quoting Sara Lee Corp. v. Kayser–Roth Corp., 81 F.3d 455, 465 (4th Cir.1996)) (internal quotations omitted).

In determining whether a term is coined, courts have found dictionary definitions and the lack of prior use within the industry instructive as to whether a term has been coined by applicant. See Firestone Tire & Rubber Co., No. 76-504, 1976 WL 21295; see also Coca-Cola Co., 497 F.2d at 1353. Here, applicant offers the following evidence in support that it has coined the term “GREEN NICKEL:”

- GREEN NICKEL is not a word found in a dictionary, see Exhibits 8-9;
- Search engine results for the term “GREEN NICKEL” reveal only applicant’s Services and reviews thereof when applied to the mining services industry.

The lack of prior use of the mark in the mining services industry provides strong evidence that applicant has coined GREEN NICKEL. Applicant proposes that the record establishes that GREEN NICKEL did not exist in the mining services industry until it was coined by applicant. When such is the case, even highly suggestive marks are registerable. See Minnesota Min. & Mfg. Co., 454 F.2d at 1180. To borrow from the court in Minnesota Min., rather than being merely descriptive, applicant’s coined mark “is a short, snappy way of *suggesting* advantageous characteristics of the goods.” Id. Therefore, Applicant asserts that the Mark is suggestive based on its original and unique characteristics and the lack of prior use of the Mark.

d. Descriptive connotations are not prohibitive of registration.

While applicant believes that it has demonstrated that the Mark is suggestive rather than descriptive of the Services, it also asserts that such a finding is not required in order to find that the mark is registerable. Courts have held that marks bearing a “descriptive connotation” are nevertheless registerable on the Principal Register. See Coca-Cola Co., 497 F.2d at 1354 (THE UNCOLA); see also Minnesota Min. & Mfg. Co., 454 F.2d at 1181 (finding SKINVISIBLE registerable despite it possessing “an obvious merely descriptive connotation as applied to medical and surgical tapes.”).

In Coca-Cola Co., the court was presented with an appeal from the Trademark Trial and Appeal Board (the “TTAB”) dismissing a trademark opposition for the mark THE UNCOLA for soft drinks, 497 F.2d 1351 (C.C.P.A. 1974). In reviewing the board’s dismissal, the Court noted that the mark conveys an impression that the product is not a cola, however, such a “descriptive connotation” is not fatal to registration. Id. at 1354. Rather, the court affirmatively stated that the “simple presence of that type of descriptive ‘connotation,’ like the presence of suggestiveness, will

not preclude registration where the mark is not merely descriptive of the goods.” *Id.* In finding that THE UNCOLA was not merely descriptive of soft drinks, the Court placed great weight on the fact that the term was coined by the applicant and had not been used previously. *Id.* at 1355.

The Coca-Cola decision highlights the established premise that a mark that is highly suggestive of the applied-for goods is registerable. In Maremont Corp. v. Air Lift Co., 463 F.2d 1114 (C.C.P.A. 1972), the Court was presented with an appeal from a TTAB decision sustaining an opposition of the mark LOAD-CARRIER for load-supporting and damping units for automobiles, automobile trailers, and small trucks. *Id.* at 1115. In assessing the mark’s level of descriptiveness, the Court stated that there was no question that the word LOAD-CARRIER was “highly *suggestive* of the function of the class of goods produced by both parties, but it [was] equally suggestive of many other things—e.g., wheelbarrows, dump trucks, freight cars, steamships, and elevators.” *Id.* at 1117. In reversing the denial of registration by the TTAB, the Court stated that “we cannot agree that it is so obviously descriptive that it was incapable of use as a trademark from the start.” *Id.*

Following the principles set forth in the precedent cases, the mark is entitled to registration. Much like THE UNCOLA that is composed of a prefix and a common word, GREEN NICKEL is made up of the prefix “green” coupled with a common English word that combine to make a word never-before used in the industry. Also, just as the marks THE UNCOLA and LOAD-CARRIER suggest goods and services that are unrelated to their applied-for services, GREEN NICKEL suggests goods and services unrelated to the Services; for example, the production of the actual green nickel. If the Examiner finds that the applied-for mark bears the same descriptive connotation as the marks from the precedent cases, this should not prevent the registration of the Mark.

II. Conclusion

When viewed as a whole, applicant’s mark is a unique and incongruous term coined by Applicant in the mining services industry. To understand the mark in the context of the Services, the reasonable consumer must engage in a multi-step analysis and use imagination and thought to discern the nature of the Services. Even if dissected, third-party registrations demonstrate that the individual components of the mark are not descriptive of the Services. Moreover, if the Examiner concludes that the Mark is highly suggestive or bears a descriptive connotation, the Mark is nevertheless registerable on the Principal Register. For the foregoing reasons, the applied-for mark is at worst suggestive, not descriptive, and any doubt in the Examiner’s mind should be resolved in favor of applicant. See In re Gourmet Bakers Inc., 173 USPQ 565 (TTAB 1972); In re Morton-Norwich Products, Inc., 209 USPQ 791 (TTAB 1981); In re Distribution Codes, Inc., 199 USPQ 508, 511 (TTAB 1978).

Applicant respectfully requests the withdrawal of the descriptiveness refusal. Thank you for your consideration.

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A handwritten signature in blue ink, appearing to read "Michael Lee", is written over a horizontal line.

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