

US Application No 88213270

Mark: BESSTOIL

Amended Goods in class 003

Non-medicated soaps, none of the foregoing containing essential oils

Section 2(e) Refusal.

The Examiner has raised a descriptiveness objection to the present trademark BESSTOIL as describing a feature, characteristic, purpose, function, subject matter, or use of applicant's goods.

Whether a mark is merely descriptive is determined in relation to the goods for which registration is sought and the context in which the mark is used, not in the abstract or on the basis of guesswork. *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *In re Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002). In other words, we evaluate whether someone who knows what the goods are will understand the mark to convey information about them. *DuoProSS Meditech Corp. v. Inviro Med. Devices Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012). A mark need not immediately convey an idea of each and every specific feature of the goods in order to be considered merely descriptive; it is enough if it describes one significant attribute, function or property of the goods. See *In re Gyulay*, 3 USPQ2d at 1010; *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973). The determination that a mark is merely descriptive is a finding of fact and must be based upon substantial evidence. *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007).

The correct test is whether the phrase forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods. *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511 (TTAB 2016).

Soap is generally unrelated to oil in the mind of a consumer, since soap is the “opposite” to oil, as it is generally perceived as removing oil from the skin.

Examiner cites a number of examples of soaps advertised in relation to essential oils, which provide a fragrance to the oil, and would thereby provide a connection for a consumer. Applicant agrees and amends the goods ID to exclude the use of essential oils in the soaps, thereby removing the possibility of descriptiveness of the mark BESSTOIL in relation to the goods in class 003, namely non-medicated soaps.

After the amendment of the goods, the word BESSTOIL does not provide an immediate idea of a characteristic of the goods, which consists of non-medicated soap.

Mark is Suggestive

A suggestive mark is one that is not descriptive of a feature, characteristic, purpose, function, subject matter, or use of applicant’s goods. The “degree of imagination” test is still relevant as it is part of the concept of suggestiveness. “A suggestive mark requires imagination, thought and perception to reach a conclusion as to the nature of the goods, while a merely descriptive mark forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods.” *StonCor Grp., Inc. v. Specialty Coatings, Inc.*, 759 F.3d 1327, 111 USPQ2d 1649, 1652 (Fed. Cir. 2014) (citing *DuoProSS*, 103 USPQ2d at 1755 (internal quotation marks omitted)).

BESSTOIL has no immediate meaning for a consumer. Rather, the consumer must think about the meaning, and be imaginative, to come up with something meaningful to the consumer. It may provide a consumer with some inkling that something about the product is the “best” and related to “oil”. However, since the

consumer understands the difference between soap and oil, the idea would not be immediate.

The Board resolves doubts as to the mere descriptiveness of a mark in favor of the applicant. *In re Stroh Brewery Co.*, 34 USPQ2d 1796, 1797 (TTAB 1994), and the Applicant kindly requests that the mark be forwarded to publication.