

**UNITED STATES DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE**

In Re the Trademark Application:)	
Serial No.: 88/942,410)	Trademark Law Office: 104
Applicant: Black Girl Sunscreen LLC)	Attorney: John M. Wilke
Trademark: BLACK GIRL SUNSCREEN)	
Filing Date: June 1, 2020)	
Class: 3)	
Office Action Mailing Date: March 11, 2021)	

RESPONSE TO FINAL OFFICE ACTION

Applicant Black Girl Sunscreen LLC (“Applicant”) respectfully submits the following response to the Final Office Action dated March 11, 2021 issued for the above-captioned application (the “Application”) for the mark BLACK GIRL SUNSCREEN (“Applicant’s Mark”). In that Office Action, the Examining Attorney expressed concerns that Applicant’s Mark is merely descriptive for the goods identified in the Application, namely “Sunscreen preparations” in Class 3, because Applicant’s Mark “merely describes the intended users of applicant’s goods.” Office Action at 2. However, the intended users of Applicant’s goods encompass the general population, including men and children, as well as people of any skin color, who do not want a white residue that is left after most sunscreen products.

Alternatively, Applicant’s Mark has acquired distinctiveness due to extensive sales and advertising of Applicant’s goods, and the extensive media coverage and consumer recognition of Applicant’s Mark. Pursuant to TMEP § 1212.02(c), Applicant hereby claims Section 2(f) distinctiveness in the alternative.

I. Applicant's Mark Is Suggestive, Not Descriptive, And Thus Is Registrable Without Proof Of Acquired Distinctiveness

It is well established that “a designation does not have to be devoid of all meaning in relation to the goods or services to be registrable.” *See* TMEP § 1209.01(a). The Board has made it clear that in order for a mark to be considered merely descriptive, the mark must describe the goods or services with “particularity.” *See In re Bright-Crest Ltd.*, 204 U.S.P.Q. 591, 593 (T.T.A.B. 1979); *see also In re TMS Corp. of the Americas*, 200 U.S.P.Q. 57, 59 (T.T.A.B. 1978) (THE MONEY STORE held registrable for financial services wherein funds are transferred to and from a savings account from locations remote from the associated financial institution); *Airco, Inc. v. Air Prods. & Chems., Inc.*, 196 U.S.P.Q. 832, 835 (T.T.A.B. 1977) (AIR-CARE held registrable for applicant's preventive maintenance services directed to a scheduled maintenance program for hospital and medical anesthesia and inhalation therapy equipment); *In re Silva Mind Control Int'l, Inc.*, 173 U.S.P.Q. 564 (T.T.A.B. 1972) (MIND CONTROL held registrable for lectures and lecture-type educational programs of a scientific and philosophical character designed for achieving mental acuity and other powers).

The Examining Attorney bears the burden of demonstrating that a mark is merely descriptive. *See In Re Bel Paese Sales Company*, 1 U.S.P.Q.2d 1233, 1236 (T.T.A.B. 1986). As further set forth below, however, the Examiner does not meet this burden. Applicant's Mark is not merely descriptive, but rather is suggestive, because it only indirectly suggests some quality of the goods and competitors need not use and do not use the phrase “black girl” to describe similar products or services.

A. Applicant's Mark Is Suggestive Because It Only Indirectly Suggests Some Quality of the Goods

A mark is suggestive “[i]f information about the product or service given by the term used as a mark is indirect or vague.” 1 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair*

Competition, § 11.67 (1997). Marks that only vaguely suggest a product characteristic, or marks that suggest more than one particular characteristic, are not descriptive. *See McCarthy, supra* at § 11:19 (“[i]f information about the product or service given by the term used as a mark is indirect or vague, then this indicates that the term is being used in a ‘suggestive,’ and not descriptive, manner”).

In *Maremont Corporation V. Air Lift Company*, 174 USPQ 395 (C.C.P.A. 1972), the Court found that the mark LOAD-CARRIER was not descriptive when used in connection with load-supporting and damping units for automobiles, automobile trailers, and small trucks, because, while the term was *suggestive* of the function of the goods, it was “equally suggestive of many other things—e.g., wheel barrows, dump trucks, freight cars, steamships, and elevators.”

Such is the case with Applicant’s Mark, which does not “describe any one thing in particular” and does not “immediately convey” the nature, function, purpose of Applicant’s goods. While BLACK GIRL SUNSCREEN may be suggestive, as it provides a hint as to the nature or characteristic of the goods, exactly what about the goods makes it a “BLACK GIRL” sunscreen requires further thought by the consumer. For example, BLACK GIRL SUNSCREEN could equally as well suggest a product that results in a deep even tan or a product that supports non-profits that provide services to underprivileged children, or it could suggest something about who created the product instead of how the product may be used. Because Applicant’s Mark provides only an indirect indication that the product does not leave a white residue, the term BLACK GIRL SUNSCREEN is not merely descriptive of the goods offered. In fact, Applicant’s offerings include additional product lines, including a kids formula and a matte formula that controls shine, this “BLACK GIRL” does not describe any one feature or aspect of the product. Thus, Applicant’s Mark is suggestive and not merely descriptive of Applicant’s goods.

B. Applicant's Mark Is Suggestive Because Consumers Must Use Their Imagination To Determine What Applicant's Services Are

A term is “merely descriptive” only if “it *forthwith* conveys an *immediate* idea of the ingredients, qualities or characteristics of [the applicable goods].” *StonCor Grp., Inc. v. Specialty Coatings, Inc.*, 111 USPQ2d 1649 (Fed. Cir. 2014) (finding ARMORSTONE not descriptive when used in connection with epoxy coating for use on concrete industrial floors); *see also, No Nonsense Fashions, Inc. v. Consolidated Foods Corp.*, 226 U.S.P.Q. 502, 507 (T.T.A.B. 1985) (SHEER ELEGANCE mark not descriptive of hosiery); 1 McCarthy, *supra* at § 11:67.

The primary criterion for distinguishing descriptive and suggestive marks is “the imaginativeness involved in the suggestion,” that is, how immediate and direct is the thought process from the mark to the particular product. *AMF v. Sleekcraft Boats*, 599 F.2d 341, 349 (9th Cir. 1979) (quoting Restatement of Torts § 721, comment a (1938)). If one must exercise “mature thought or follow a multi-stage reasoning process to determine attributes of the product or service,” or “[i]f the mental leap between the word and the product’s attributes is not almost instantaneous,” the term is suggestive, not descriptive. 1 McCarthy at § 11:21, p. 491-92.

In *Nautilus Group Inc. v. ICON Health and Fitness Inc.*, 71 USPQ2d 1173 (Fed. Cir. 2004), for example, the Federal Circuit affirmed a finding that the trademark BOWFLEX was suggestive of an exercise machine using curving rods because, even though it was not particularly creative or distinctive, the “mental leap” between the mark and the curving rods it described was not “almost instantaneous,” and instead required imagination or multistage reasoning. Similarly, in *Glamorene Products Corporation v. Boyle-Midway, Inc., et al.*, 188 USPQ 145 (S.D.N.Y. 1975), the Court found that the trademark SPRAY ‘N VAC was suggestive because, while it suggested a rug cleaner, it did not describe the product or how the product was used, and consumers had to follow multi-stage reasoning process in order to ascertain what product characteristics the term suggested.

Likewise, Applicant's Mark is not descriptive because it is not immediately clear what makes a product a "BLACK GIRL" product. Rather, as with BOWFLEX and SPRAY 'N VAC, the "mental leap" between BLACK GIRL SUNSCREEN and the innovative no white residue formula requires imagination and multistage reasoning to determine the nature of Applicant's goods. Thus, Applicant's Mark is not merely descriptive.

C. Applicant's Mark Is Suggestive Because Competitors Need Not Use and Do Not Use the Phrase to Describe Similar Products or Services

A mark is deemed suggestive rather than merely descriptive if competitors do not need the words in the mark to describe their products or services. *Union Carbide Corp. v. Ever-Ready, Inc.*, 531 F.2d 366, 379 (7th Cir. 1976), *cert. denied*, 429 U.S. 830 (1976). The decision in *Aluminum Fabricating Co. v. Season-All Window Corp.*, 259 F.2d 314, 317 (2d Cir. 1958) is instructive. In that case, the Court agreed with the PTO's determination that the mark SEASON-ALL was *suggestive* for storm windows. The Court stated that its finding that SEASON-ALL was suggestive did not "render it difficult for others in the business of selling other storm doors and storm windows [to] adequately describe their products." *Season-All*, 259 F.2d at 317; *see also, In re Reynolds Metals Co.*, 480 F.2d 902, 904 (C.C.P.A. 1973) (holding BROWN-IN-BAG was suggestive, because its registration for transparent plastic bags would not prevent competitors from producing similar products).

Here, the Examining Attorney has presented no evidence that the term "black girl" is used to describe goods similar to those offered by Applicant. In determining whether a word "has a descriptive or suggestive significance as applied to merchandise it is proper to take notice of the extent to which it has been used in trademarks by others on such merchandise." *Shoe Corp. of America v. Juvenile Shoe Corp.*, 266 F.2d 793, 796 (C.C.P.A. 1959). A mark is descriptive if its use "has been so frequent that consumers are unlikely to perceive the term when used in the manner

of a trademark as indicating source or origin.” *No Nonsense Fashions, Inc. v. Consolidated Foods Corp.*, 226 USPQ 502, 507 (TTAB 1995). There is no evidence that other companies *need* to use the term “black girl” to describe goods similar to those of Applicant. Therefore, under the “competitor needs test” Applicant’s Mark is merely suggestive, not descriptive.

D. Doubt Should Be Resolved in Favor of the Applicant

The arguments above demonstrate that that there is, at minimum, some doubt as to the descriptiveness of Applicant’s Mark. “[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 (T.T.A.B. 1994); *see also See In Re Bed-Check Corporation*, 226 U.S.P.Q. 946, 948 (T.T.A.B. 1985); *In re Gourmet Bakers, Inc.*, 173 U.S.P.Q. 565, 565 (T.T.A.B. 1972) (holding that any doubt in determining registrability of THE LONG ONE for bread was to be resolved in favor of the Applicant). Applicant therefore respectfully requests that the refusal to register be withdrawn. Applicant’s Mark is capable of identifying and distinguishing Applicant as the source of Applicant’s goods in consumers’ minds, and should be permitted to proceed to publication.

II. Alternatively, If Applicant’s Mark Is Descriptive, It Has Acquired Distinctiveness, And Thus Is Registrable Under Section 2(f)

Where an examining attorney rejects an application on the ground that a mark is merely descriptive, section 2(f) entitles an applicant to establish that the mark at issue has acquired distinctiveness or “secondary meaning.” *Yamaha Int’l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1527, 1580 (Fed. Cir. 1988); Trademark Manual of Examining Procedure (“TMEP”) § 1212. An applicant may present any competent evidence to establish that a mark has achieved secondary meaning. 37 C.F.R. § 2.41(a). “It is not necessary that the applicant conclusively establish distinctiveness; evidence which in the opinion of the examining attorney presents a prima facie

case of acquired distinctiveness is sufficient.” TMEP § 1212.01 (citing *In re Packaging Specialists, Inc.*, 221 USPQ 917 (TTAB 1984); *In re Riviana Foods Inc.*, 160 USPQ 757 (TTAB 1969)). Any question as to the sufficiency of secondary meaning evidence should be resolved in favor of the Applicant. *In re Merrill-Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 U.S.P.Q.2d 1141 (Fed. Cir. 1987).

Applicant may submit affidavits, declarations under 37 C.F.R. §2.20, or other appropriate evidence tending to show that the mark distinguishes the goods or services. Applicant has submitted herewith the declaration of Shontay Lundy evidence of use and consumer recognition of Applicant’s Mark.

With regard to Exhibit D to the Declaration of Shontay Lundy, Nielsen data demonstrates that Good Morning America was the No. 1 morning show and it averaged 3.94 million live-plus-same-day viewers in that quarter. See <https://www.adweek.com/tvnewser/q2-2020-morning-show-ratings-good-morning-america-and-today-earn-a-split-decision/446159/>.

Accordingly, Applicant respectfully requests that the Section 2(e)(1) refusal be withdrawn, or in the alternative that the application at issue proceed to registration on the Principal Register pursuant to Section 2(f) on the grounds of acquired distinctiveness. 15 U.S.C. § 1052(f).

III. CONCLUSION.

Applicant has responded to all of the issues raised by the Examining Attorney in the Office Action issued September 2, 2020. In view of the foregoing, Applicant believes this Application is now in condition for publication.