

The Examining Attorney has refused registration of the subject application on the grounds that the mark, TASTY, merely describes the subject matter of Applicant's goods. Applicant respectfully submits the following arguments in response.

I. The Mark is Suggestive and Not Merely Descriptive of the Services Provided.

To be refused registration on the Principal Register under Section 2(e)(1) of the Trademark Act, 15 U.S.C. Section 1052(e)(1), a mark must be merely descriptive or deceptively misdescriptive of the goods or services to which it relates. The primary test for determining whether a mark is merely descriptive within the meaning of Section 2(e)(1) is whether it *immediately* conveys to consumers a feature, characteristic, or the nature of Applicant's goods or services, or whether consumers must use some "imagination, thought or perception" to draw that conclusion. *J.S. Paluch Co. v. Irwin*, 215 U.S.P.Q. 533, 536 (TTAB 1982). Moreover, "if one must exercise mature thought or follow a multi-stage reasoning process in order to determine what product or service characteristics the term indicates, the term is suggestive rather than merely descriptive." *In re Tennis in the Round Inc.*, 199 U.S.P.Q. 496, 498 (TTAB 1978).

On the other hand, suggestive marks are those that, when applied to the goods or services at issue, require imagination, thought or perception to reach a conclusion as to the nature of those goods or services. *Stix Products, Inc. v. United Merchants & Mfrs., Inc.*, 295 F. Supp. 479, 488, 160 U.S.P.Q. 777 (S.D. N.Y. 1968); *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 11, 189 U.S.P.Q. 769 (2d Cir. 1976); *West & Co., Inc. v. Arica Institute, Inc.*, 557 F.2d 338, 342, 195 U.S.P.Q. 466 (2d Cir. 1977); *Surgicenters of America, Inc. v. Medical Dental Surgeries, Co.*, 601 F.2d 1011, 1019, 202 U.S.P.Q. 401 (9th Cir. 1979); *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 792, 217 U.S.P.Q. 988 (5th Cir. 1983); *A.J. Canfield Co. v. Honickman*, 808 F.2d 291, 297, 1 U.S.P.Q.2d 1364, 1369 (3d Cir. 1986) (*Stix* "correctly stated the distinction between suggestive and descriptive terms."); *Hasbro, Inc. v. Lanard Toys, Ltd.*, 858 F.2d 70, 73, 8 U.S.P.Q.2d 1345, 1348 (2d Cir. 1988); *Equine Technologies, Inc. v.*

Equitechnology, Inc., 68 F.3d 542, 544, 36 U.S.P.Q.2d 1659, 1 (1st Cir. 1995); *Star Industries, Inc. v. Bacardi & Co. Ltd.*, 412 F.3d 373, 385, 75 U.S.P.Q.2d 1098 (2d Cir. 2005). A suggestive term differs from a descriptive term, which immediately tells something about the goods or services. TMEP 1209.01(a). Therefore, for a mark to be refused registration under Section 2(e)(1), it must *immediately*, without the use of imagination, thought or perception describe the goods or services. If one must engage in reasoning to reach a conclusion as the nature of the goods, the mark is suggestive, not merely descriptive. Applicant respectfully submits that the mark at issue is at most suggestive of the goods listed in its application.

While the question to be answered is whether the subject mark functions as a trademark on its own merits, it is nonetheless instructive to note that the Office has accepted similar TASTY marks for beverages in Class 32 on the Principal Register, without a disclaimer. (See attached Exhibit A for the registration particulars.):

TASTY WAVES (Reg. No. 5662656)
TASTY6 (Reg. No. 4782945)
TASTY SIPS (Reg. No. 1926158)

As with Applicant's goods, for each of the above marks, potential customers are required to have more information than merely the mark in order to determine the nature, or any particular quality or characteristic of the goods. In other words, they must exercise imagination, thought, or perception. Simply because the mark TASTY hints at the possibility that the goods have a "pleasing flavor," does not make it merely descriptive.

Conclusion

For all of the foregoing reasons, Applicant respectfully requests that the Examining Attorney withdraw the refusal to register under Section 2(e)(1) and approve the application for publication in the *Official Gazette*.