RESPONSE TO OFFICE ACTION

Applicant filed Application Serial No. 88/299,344 (the "Application") for the mark POWERBOOST for, as amended,

- "Automatically operated apparatus and installations for electrostatic spray coating, namely, electrostatic-paint sprayers; Spray coating apparatus and spray coating installations, namely, electrostatic spray coating devices, powder coating spray guns, paint sprayers" in International Class 7,
- "Manually operated apparatus and devices for electrostatic spray coating, namely, hand-operated spray guns" in International Class 8,
- "Electrical and electronic control units for use with operating electrostatic spray coating devices; control circuits and control installations in the nature of electronic control circuits for operating electrostatic spray coating devices" in International Class 9, and
- "Spray coating apparatus and spray coating installations, namely, paint spray coating booths, not of metal; parts for paint spray booths not of metal, in particular lining parts, wall partitions, and roof parts in the nature of non-metallic roof flashing and roof tiling; ducts of plastic for paint spray booths not of metal, in particular for supplying pressurized air, powder or liquidized coating materials" in International Class 19.

(the "Mark").

On April 25, 2019, the Examining Attorney issued an Office Action, refusing registration of the Application on the basis that the mark POWERBOOST merely describes a feature of Applicant's goods and requiring that Applicant amend the identification and classification of the

goods and services. For the reasons below, Applicant respectfully disagrees with the Examining Attorney's assessment that the mark POWERBOOST is merely descriptive and requests that the Application be approved for publication.

DISCUSSION

I. The Mark POWERBOOST is Not Descriptive in Any Sense in Relation to the Goods Identified.

A mark is descriptive if it "describes the qualities, ingredients or characteristics of the goods or services related to the mark." *In re Steelbuilding.com*, 415 F.3d 1293, 1297 (Fed. Cir. 2005) (citation omitted) (internal quotation marks omitted). It is "merely descriptive" if "it would immediately convey to one seeing or hearing it the thought of [the applicant's goods and services]." *In re Bed & Breakfast Registry*, 791 F.2d 157, 159-60 (Fed. Cir. 1986) (citation omitted) (international quotation marks omitted). A mark is suggestive if it "*requires imagination, thought, and perception to arrive at the qualities or characteristics of the goods*." *In re Nett Designs, Inc.*, 236 F.3d 1339, 1341 (Fed. Cir. 2001) (emphasis added).

Applicant first submits that the Mark is not descriptive in any sense ***as applied to the goods identified in connection with the Mark***, which is the required test, for the following reasons:

a. First, the Mark is a coined word mark invented for the sole purpose of serving as a trademark. 2 McCarthy on Trademarks and Unfair Competition § 11:5 (5th ed.). A coined word mark does not have any meaning other than its trademark significance, *id.*, and is supposed to be evaluated as a whole, *see Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 1402 (C.C.P.A. 1974) ("It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion."). As such, Applicant respectfully submits

that, in issuing the Section 2(e)(1) refusal, the Examining Attorney improperly divided it into "POWER" and "BOOST."

b. Second, assuming *arguendo* that the Examiner may divide a mark in considering whether it is merely descriptive, the Mark POWERBOOST has no meaning in relation to the goods identified in the Application. Under the law, descriptiveness of the mark in an application is determined on the basis of the goods/services listed in the application, not the goods/services actually offered. *See In re Vehicle Information Network Inc.*, 32 U.S.P.Q.2d 1542 (T.T.A.B. 1994) ("the question of registrability must be determined, in proceedings before the Board, on the basis of the goods or services as set forth in the application, rather than in reference to the precise nature of the goods or services on or in connection with which the mark is actually used or intended to be used"). Viewed in connection with the goods identified (and also actually offered) in the Application, the Mark does not immediately convey knowledge of the features or characteristics of the goods. At most, it suggests or hints at—thereby "requiring imagination, thought or perception"—a "desired result" of the products actually offered. *In re The Noble Co.*, 225 USPQ 749 (TTAB 1985) (NOBURST for liquid antifreeze and rust inhibitor for hot-water-heating systems found to suggest a desired result of using the product rather than immediately informing the purchasing public of a characteristic, feature, function, or attribute); *See In re Colgate-Palmolive Co.*, 406 F.2d 1385, 160 U.S.P.Q. 733 (C.C.P.A. 1969) (holding that the mark CHEW 'N CLEAN for dentifrice is not merely descriptive).

c. Third, the Mark is so broadly worded that it is as or more suggestive of any and all goods that can be classified in Classes 7, 8, 9 and 19 (and maybe additional classes), as it is of Applicant's goods contained in the identification. After all, purchasers of the products

identified in Classes 7, 8, 9 and 10 generally if not always look for products that are considered "powerful" in these categories. *See In re Realistic Co.*, 440 F.2d 1393, 169 U.S.P.Q. 610 (C.C.P.A. 1971) (holding that the mark CURV" is not merely descriptive of the permanent wave curling solutions that the applicant sought to register for and stating that "the word 'curve' is as suggestive of almost any article of manufacture (i.e., anything having or producing any type of curved shape) as it is of permanent wave curling solutions and their intended use"). Besides, the description that a product has the feature of "boosting power" can be interpreted in various different ways. A relevant purchaser who views the Mark in connection with the products identified and offered may conclude that the Mark is meant to suggest that the associated products are so effective that they make the user feel more powerful and in control, or that the products are more effective than other products in the same market, instead of that the POWERBOOST products increase the amount of force that their sprayers are capable to exert.

The Mark POWERBOOST certainly does not tell a relevant purchaser what Applicant's goods are nor does it "convey to one seeing or hearing it the thought of" a particular category of goods, *Bed & Breakfast Registry*, 791 F.2d at 159-60. Therefore, Applicant respectfully submits that "POWERBOOST" is not merely descriptive of the goods that are identified in the Application (and actually offered and will be offered in connection with the Mark).

II. The Mark POWERBOOST is a "Double Entendre" That is Not Merely Descriptive of the Goods Identified.

A "double entendre" is "a word or expression capable of more than one interpretation." TMEP 1213.05(c). "For trademark purposes, a 'double entendre' is an expression that has a double connotation or significance as applied to the goods or services." *Id.* (emphasis omitted). A "double entendre" mark "will ***not*** be refused registration as merely descriptive if one of its

meanings is not merely descriptive in relation to the goods or services." *Id.* (emphasis added) A mark is considered a "double entendre" "only if both meanings are readily apparent *from the mark itself*." *In re The Place Inc.*, 76 U.S.P.Q.2d 1467, 1470 (T.T.A.B. 2005).

The relevant purchasing public is familiar with the fact that the word "POWER" has multiple meanings. While one meaning is "***physical*** strength or force exerted or capable of being exerted" as the Examining Attorney quoted, other meanings include "ability to act or produce an effect" or "possession of control, authority, or influence over others." Merriam-Webster's Collegiate Dictionary (10th ed. 1998) (emphasis added).

As such, incorporating the word "POWER," the Mark POWERBOOST is meant to present multiple meanings, one of which is an impression of gaining power and control when the purchasers use Applicant's POWERBOOST products. Applicant could have coined a mark such as "ELECTRICITY-BOOST" or "FORCEBOOST," but by choosing the word "POWER" over "ELECTRICITY" or "FORCE," Applicant intended the Mark to suggest in the relevant purchasers' minds meanings associated with subjective feelings and positive human emotions. *See e.g.*, *In re Colonial Stores Inc*., 394 F.2d 549, 157 USPQ 382 (C.C.P.A. 1968) (concluding that the mark SUGAR & SPICE is not merely descriptive of bakery products because, while the words "SUGAR" and "SPICE" are commonly used to describe bakery products, when they are used in combination, "[t]he immediate impression evoked by the mark may well be to stimulate an association of 'sugar and spice' with 'everything nice'"); *see also*, *In re Kraft, Inc.*, 218 U.S.P.Q. 571, 573 (T.T.A.B. 1983) (a disclaimer of the term "LIGHT" in the mark "LIGHT N' LIVELY" as applied to the applicant's reduced calorie mayonnaise is unnecessary because the mark "as a whole has a suggestive significance which is distinctly different from the merely

descriptive significance of the term 'LIGHT' per se" – "the merely descriptive significance of the term 'LIGHT' is lost in the mark as a whole").

Thus, assuming *arguendo* that the Examining Attorney ultimately concludes that the Mark is descriptive of the goods identified and offered, which Applicant has addressed and shown above is not the case, the Mark POWERBOOST presents a "double entendre" that conveys another commercial impression that is equally apparent but unrelated to the goods identified and offered by Applicant, due to the multiple meanings of the word "POWER."

III. Conclusion

Based on the reasons above, Applicant hereby submits that the Mark POWERBOOST is not merely descriptive of the goods identified. If there are any doubts, the Board has held that the doubts should be resolved in favor of the applicants on the assumption that competitors have the opportunity to challenge an application once it is published. *See e.g.*, *In re Conductive Systems, Inc.*, 220 U.S.P.Q.84 (T.T.A.B. 1983). Therefore, Applicant respectfully requests that the Section 2(e) refusal be withdrawn, and submits that the Application is in condition for publication and respectfully requests action consistent therewith. Applicant respectfully requests that the Examining Attorney contact the Attorney of Record for Applicant if a telephone conference might be of assistance.