

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Green Wealth, Inc.
Serial No: 88/791,834
Filed: February 10, 2020
Mark: AMERICAN ETHICAL
SUPPLEMENTS

Examiner: Jennifer M. Martin
Law Office: 116

SUBMISSION OF DISCLAIMER AND REQUEST FOR RECONSIDERATION

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Sir:

In the recent Office Action of May 5, 2020, the Examining Attorney indicated that a review of the USPTO Database had not uncovered a registered or pending mark that would bar registration of Applicant's mark. However, the Examiner did refuse registration of Applicant's mark contending that the mark was geographically descriptive. Applicant disagrees with this basis for rejection as explained in the section that follows. Finally, the Examiner requested that Applicant disclaim the word "SUPPLEMENTS" because such wording appears to be generic in the context of Applicant's goods. In response to this request, Applicant has submitted the following Disclaimer:

"No claim is made to the exclusive right to use "SUPPLEMENTS" apart from the mark as shown."

As a result of Applicant's addressing of the rejection for geographic descriptiveness and including the requested Disclaimer, Applicant believes that the mark AMERICAN ETHICAL SUPPLEMENTS is entitled to registration, and publication is respectfully requested.

REJECTION BASED ON GEOGRAPHIC DESCRIPTION 2(e)(2)

In rejecting the present Application, the Examiner Attorney refused registration of Applicant's mark contending that the mark AMERICAN ETHICAL SUPPLEMENTS was primarily geographically descriptive of the origin of Applicant's goods. Applicant agrees that the word "AMERICAN" is clearly geographically descriptive. However, Applicant's mark AMERICAN ETHICAL SUPPLEMENTS *as a whole* is not geographically descriptive. Instead, the word "ETHICAL" converts the mark as a whole to being distinctive.

As a threshold matter, the Examining Attorney bears the burden of demonstrating that Applicant's mark is merely descriptive from the vantage point of Applicant's consumers. *In re Merrill Lynch*, 4 USPQ 2d. 1141, 1144 (Fed. Cir. 1987). Moreover, where the doubt exists as to whether a term is descriptive, such doubt should be resolved in favor of the Applicant. *Id*; See also *In Re Gourmet Bakers, Inc.*, 173 USPQ 565 (TTAB 1972) where the board held that any doubt in determining the registration of the mark THE LONG ONE for bread is resolved in favor of Applicant on the theory that any person who believes that he would be damaged by the registration will have the opportunity... to oppose the registration of the mark and to present evidence... to that effect.

To refuse registration of Applicant's mark, the Examining Attorney bears the burden of showing that a term is merely descriptive if, when applied to the relevant goods, it immediately imparts information concerning those goods to an average prospective purchaser of the goods. *In re Abcor Development Corp.*, 588 F.2d 811 (CCPA 1978). The word "merely means that if the mark clearly does not tell the potential customer only what these goods are, their functions, characteristics, use or ingredients, then the mark is not merely descriptive". *In re Intelligent Medical Systems, Inc.*, 15 U.S.P.Q. 2d 1674, 1675 (TTAB 1987) citing *McCarthy, Trademarks and Unfair Competition*.

Plainly, Applicant's mark AMERICAN ETHICAL SUPPLEMENTS does not tell potential customers only that such products are coming from America. Moreover, adding the word "ETHICAL" is not merely a traditional modifier of the word "American" as coming from America, as suggested by the Examiner. The word "ETHICAL" refers to a course of conduct by persons and cannot simply modify a geographic location. It can only modify or characterize the conduct of an individual. In other words, the geographic location of America does not have or relate to "ethics". (See *Merriam-Webster* definition of the word ethical as "of or relating to ethics" and *Oxford Dictionary* defining the word ethical as "relating to moral principles or the branch of knowledge dealing with these").

It should further be noted that the word "ETHICAL" is not modifying the word "AMERICAN" in the mark. Instead, "ETHICAL" is an adjective modifying the word "SUPPLEMENTS". However, the word "ETHICAL" cannot describe the behavior of "supplements" because supplements do not have a behavior, which is ethical or otherwise. Thus,

one would not question that the mark ETHICAL SUPPLEMENTS was distinctive, and adding the word “AMERICAN” would not change that.

Instead, Applicant’s mark could best be compared to other trademarks where behavioral adjectives have been found to modify generic goods to make the mark distinctive. Just a few examples of such marks include the following.

- U.S. Trademark Reg. No. 2,788,914 to the mark SMARTWATER for “bottled drinking water”;
- U.S. Trademark Reg. No. 6,036,621 to the mark CHARMING MOVERS for “moving and storage of goods; moving company services”;
- U.S. Trademark Reg. No. 5,037,745 to the mark DUMB RUNNER for “providing a website featuring information on exercise and fitness; providing a website featuring information relating to the sport of running”;
- U.S. Trademark Reg. No. 6,047,025 to the mark WISE BASKETBALL TRAINING for “sports training services in the field of basketball”; and
- U.S. Trademark Reg. No. 5,419,009 to the mark SUAVE VAPE for “electronic cigarette liquid (e-liquid) comprised of flavorings in liquid form, other than essential oils, used to refill electronic cigarette cartridges”.

So, Applicant does not disagree that simply adding matter to a geographic term does not *necessarily* diminish its primary geographic significance, such as REAL RUSSIAN, HAVANA SELECT, HABANA CLASSICO, etc., as cited by the Examiner in the recent Office Action.

However, that is not the case here. Accordingly, Applicant's mark AMERICAN ETHICAL SUPPLEMENTS is believed allowable.

CONCLUSION

It is believed that Applicant has addressed each of the Examiner's issues. Accordingly, allowance and publication of the present application are respectfully requested.

Respectfully submitted,

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