

**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: September 2, 2020)	

RESPONSE TO OFFICE ACTION

Applicant Black Girl Sunscreen LLC (“Applicant”) respectfully submits the following response to the Office Action dated September 2, 2020 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 1. As explained below, Applicant’s Mark is not merely descriptive of Applicant’s goods and services, as evidenced by the fact that: intended users of Applicant’s goods encompass the general population, the mark is incongruous, and the United States Patent and Trademark Office (“USPTO”) has issued multiple registrations for similar marks without finding the term “BLACK GIRL” descriptive.

I. Applicant’s Mark Is Not Merely Descriptive of Applicant’s Goods

A. Applicable Principles of Law

The standard for determining whether a mark is merely descriptive is whether it simply describes “an ingredient, quality, characteristic, function, feature, purpose or use of an applicant’s goods or services.” See TMEP § 1209.01(b); *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251 (Fed. Cir. 2012). The determination must be made in relation to the goods or services for which registration is sought, in the context in which the mark is used, and the possible significance that the mark would have, because of that context, to the average purchaser in the marketplace. See *In re Omaha Nat’l Corp.*, 2 U.S.P.Q.2d 1859, 1861 (Fed. Cir. 1987). However, “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).

In contrast, “[i]ncongruity is a strong indication that a mark is suggestive rather than merely descriptive.” TMEP 1209.019a; *In re Tennis in the Round Inc.*, 199 USPQ 496, 498 (TTAB 1978) (TENNIS IN THE ROUND held not merely descriptive for providing tennis facilities, the Board

finding that the association of applicant's marks with the phrase "theater-in-the-round" created an incongruity because applicant's tennis facilities are not at all analogous to those used in a "theater-in-the-round"). The Board has described incongruity in a mark as "one of the accepted guideposts in the evolved set of legal principles for discriminating the suggestive from the descriptive mark," and has noted that the concept of mere descriptiveness "should not penalize coinage of hitherto unused and somewhat incongruous word combinations whose import would not be grasped without some measure of imagination and 'mental pause.'" *In re Shutts*, 217 USPQ 363, 364-5 (TTAB 1983) (SNO-RAKE held not merely descriptive of a snow-removal hand tool); *see also In re Vienna Sausage Mfg. Co.*, 156 USPQ 155, 156 (TTAB 1967) (FRANKWURST held not merely descriptive for wieners, the Board finding that although "frank" may be synonymous with "wiener," and "wurst" is synonymous with "sausage," the combination of the terms is incongruous and results in a mark that is no more than suggestive of the nature of the goods); *In re John H. Breck, Inc.*, 150 USPQ 397, 398 (TTAB 1966) (TINT TONE held suggestive for hair coloring, the Board finding that the words overlap in significance and their combination is somewhat incongruous or redundant and does not immediately convey the nature of the product); *cf. In re Getz Found.*, 227 USPQ 571, 572 (TTAB 1985) (MOUSE HOUSE held fanciful for museum services featuring mice figurines made up to appear as human beings, the Board finding that the only conceivable meaning of "mouse house," i.e., a building at a zoo in which live and/or stuffed mice are displayed, is incongruous).

B. Applicant's Mark Is Not Merely Descriptive Because It Is Incongruous and Applicant's Intended Users Encompass the General Public

Applicant's Mark is incongruous because of the popular belief that people with dark skin do not need to use sunscreen, and thus the combination of words is unexpected and memorable, as in the cases above. However, as the specimen submitted by Applicant on June 1, 2020 indicates,

what sets this product apart is that it is “ultra sheer” and does not leave any white residue. This feature is widely appealing to people with a wide range of skin tones, including light-skinned or freckled people who do not enjoy the effect of white residue left by most sunscreens, as well as people of Asian, Indian, Middle Eastern, Latino, or other descent who are looking for a sheer sunscreen product. Needless to say, the sunscreen product is equally effective and intended for use by persons of all genders and ages. Accordingly, the term “BLACK GIRL” in Applicant’s Mark does not merely describe the intended users of its product but creates an incongruous and memorable mark in combination with “SUNSCREEN.”

C. Marks Similar to Applicant’s Mark Have Been Registered on the Principal Register

Principles of consistency and fairness also support a finding that Applicant’s Mark is not merely descriptive of the products and services identified in the Application. The USPTO has permitted registration and/or approved applications for similar unitary marks featuring the term “BLACK GIRL,” including the following.

- CORPORATE BLACK GURL?, Reg. No. 5594772
- BLACK GIRLS WITH PURPOSE, Reg. No. 5685184
- BLACK GIRLS EAT, Reg. No. 5933278
- BLACK GIRLS CAN BOWL 2, Reg. No. 5962852
- BLACK GIRLS TRAVEL TOO, Reg. No. 6095212
- BLACK GIRL SHAKING THINGS UP, Reg. No. 6118011
- NATURAL BLACK GIRL, Reg. No. 6178099
- BLACK GIRLS BEAD, Reg. No. 6178408
- BLACK GIRLS WITH THE TEA, Reg. No. 6237158
- BLACK GIRLS IN THE VINEYARD, Reg. No. 6245321
- BLACK GIRL BUCKET LIST, Reg. No. 6259898
- THE RIGHT KIND OF BLACK GIRL UNAPOLOGETICALLY FREE, Reg. No. 6268154

See Exhibit A (USPTO records for the above marks).

While Applicant recognizes that the Examining Attorney is not bound by the status of similar third-party trademark registrations and applications, the existence of such filings on the

USPTO's Principal Trademark Register should not be discounted. The Board has found that such third-party registrations are entitled to some weight. *See, e.g., In re Men's International Professional Tennis Council*, 1 U.S.P.Q.2d 1917, 1919 (TTAB 1986) ("the fact that MASTERS has been registered on the Principal Register for golf tournaments, albeit not conclusive evidence of the registrability of MASTERS by appellant for different services, tends to rebut the Examining Attorney's characterization of MASTERS"); *In re JMH Prods., Inc.*, Serial No. 76608812 (TTAB August 25, 2006) (non-precedential) (reversing refusal "because the plethora of third-party registrations submitted by applicant serve at the very least to raise some doubt").

Applicant respectfully submits that these third-party filings are highly persuasive evidence that similarly structured marks have been registered on the Principal Register by the USPTO.

D. Doubt Should be Resolved in Favor of Applicant

Lastly, it has long been acknowledged that there is often a gray area between terms which are merely descriptive and those which are suggestive, and the borderline between the two is hardly a clear one. *See In re Atavio Inc.*, 25 USPQ2d 1361 (TTAB 1992). However, if there is doubt about the "merely descriptive" character of a mark, that doubt should be resolved in favor of the Applicant. *See, e.g., In re Stroh Brewery Co.*, 34 USPQ2d 1796, 1797 (TTAB 1994); *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). The arguments above demonstrate that, at a minimum, there is genuine doubt as to the descriptiveness of Applicant's Mark. 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 services in consumers' minds, and should be permitted to proceed to publication.

II. 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.