

### Response to First Office Action

In the office action dated February 20, 2021, regarding Application Serial No. 90266369 (the "Application") for the mark BEST BUY ESSENTIALS and Design ("Applicant's Mark"), the Examining Attorney has refused registration of Applicant's Mark, requiring disclaimer of "ESSENTIALS" and certain amendments to Applicant's identification of goods in International Class 9. Applicant addresses these grounds for refusal herein.

### DISCUSSION

#### **I. Amendments to Identification of Goods in International Class 9**

Elsewhere in this response, Applicant has requested that the following amendments be made to its Class 9 identification to address the requirements set forth in the Office Action:

Computer peripherals and parts thereof; computer and laptop computer peripherals and accessories, namely, computer mice, trackballs, mouse pads, arm and wrist rests, keypads, keyboards, keyboard covers, headphones, headsets, protective covers, protective cases, protective sleeves, carrying cases, bags, backpacks **especially adapted for holding laptops and notebook computers**, power adapters, cables, cable connectors, styluses, battery chargers, screen protectors **comprised of tempered glass adapted for use with portable electronic devices**, protective films adapted for computer screens, screen filters, stands, memory devices, storage devices, blank hard drives, blank flash drives, blank disk drives, stands **adapted for computers and laptops**, mounts, and cooling pads; styluses for use with tablet computers and portable electronic devices; carrying cases, holders, protective cases and stands **adapted** for use with handheld digital electronic devices; surge protectors; USB hubs; USB cables; ethernet adapters; ethernet cables; **protective** optical blue light blocking glasses; blank digital storage media; blank electronic storage media; batteries; battery chargers; mobile telephone and portable electronic device accessories, namely, chargers, **electric** charging cables, battery charging devices, wireless charging pads **for smartphones**, auxiliary cables **for cell phones and portable electronic devices**, USB cables, protective covers, cases, charging cases, straps, armbands, keyboards, headsets, headphones, screen protectors, holders, stands and mounts **all specially adapted for use with portable electronic devices and cell phones**; home theater, audio and video equipment accessories, namely, antennas, surge protectors, television mounts and mounting brackets, cables, connectors, adapters; audio and video interconnect cables, high definition multimedia interface cables, adapters and splitters; USB cables; power strips and circuit overload protection devices, **namely, voltage surge protectors**; speaker cables; electrical cables, **electrical** adapters, and **electrical** audio and video switches; **electrical** audio-visual equipment cables and connectors; electrical and power cables; video cables;

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audio cables; extension cables; electric connectors; cable connectors; plug connectors; **electric power** converters; optical cables; networking cables, **namely, telecommunication cables**, in International Class 9.

Applicant notes that these changes differ from Examining Attorney's suggested amendments as follows (marked changes reflect differences between suggested amendments and those being requested by Applicant):

mobile telephone and portable electronic device accessories, namely, chargers, electric charging cables, battery charging devices, wireless charging pads for smartphones, auxiliary cables for cell phones **and portable electronic devices**, USB cables, protective covers, cases, charging cases, straps, armbands, keyboards, headsets, headphones, screen protectors, holders, stands and mounts all specially adapted for use with ~~handheld digital electronic devices, namely, portable~~ **electronic devices and** cell phones.

As the "portable electronic device" wording appears elsewhere in Applicant's identification, and is included in the USPTO ID Manual ("Power supply connectors and adaptors for use with portable electronic devices"), Applicant believes this alternative wording should be acceptable, and is within the scope of Applicant's original identification.

## II. "Essentials" Is Suggestive, But Not Merely Descriptive, Of Applicant's Goods

Examining Attorney has required that Applicant disclaim "ESSENTIALS," on the grounds that this wording merely describes a feature of Applicant's goods, because "ESSENTIALS" means things which are "absolutely necessary; extremely important." While the "ESSENTIALS" wording may suggest that Applicant's goods are necessary or important, it is not merely descriptive of Applicant's goods which are a variety of computer peripherals, accessories for electronic devices, water filters, flashlights and paper. As such, disclaimer of this wording should not be necessary.



That the "ESSENTIALS" wording is not merely descriptive of Applicant's goods is demonstrated by the USPTO's registration of numerous marks incorporating this wording for goods identical or closely related to Applicant's goods, on the Principal Register, with no disclaimer of "ESSENTIALS" and no claim of acquired distinctiveness under Section 2(f). To list some examples:

Mark/Disclaimers	Relevant Goods/Services	Owner
<a href="#">WIRELESS ESSENTIALS</a> RN: 2667941 SN: 76164220 Disclaimer: "WIRELESS"	Int'l Class: 09 (Int'l Class: 09) microphones	Audio-Technica U.S., Inc. (Delaware Corp.)
<a href="#">CHARGING ESSENTIALS</a> RN: 5776276	Int'l Class: 09 (Int'l Class: 09)	Consumer Sales Network, Inc.

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Mark/Disclaimers	Relevant Goods/Services	Owner
SN: 87600842 Disclaimer: "CHARGING"	Electrical plugs; electrical power devices, namely, wall taps; power strips	(Minnesota Corp.)
<a href="#">DE DIGITAL ESSENTIALS and Design</a>  RN: 4871526 SN: 86337023 Disclaimer: "DIGITAL"	Int'l Class: 09 (Int'l Class: 09) earphones; headphones; audio speakers; carrying cases, holders, protective cases and stands for use with mobile and handheld electronic devices; power supply connectors, adaptors, speakers and battery charging devices for use with mobile and handheld electronic devices; computer peripheral devices	Zeeva International LTD (Hong Kong Special Administrative Region of the People's Republic of China, the Limited Company (Ltd.))
<a href="#">DEALFAINT ESSENTIALS and Design</a>  RN: 5468835 SN: 87638002	Int'l Class: 09 (Int'l Class: 09) carrying cases, holders, protective cases and stands featuring power supply connectors, adaptors, speakers and battery charging devices, specially adapted for use with handheld digital electronic devices, namely, cell phones, mp3 players, personal digital assistants, computers	Eco Squadron (Pennsylvania Limited Liability Company)
<a href="#">DECO ESSENTIALS</a> RN: 5916760 SN: 88320880	Int'l Class: 09 (Int'l Class: 09) Adapter cables for headphones; Cellular telephone apparatuses; Charging appliances for rechargeable equipment; Devices for hands-free use of mobile phones; Virtual reality headsets; Camera stability accessory, namely, a support arm, vest and sled for film and video cameras to absorb shaking moves while shooting	Beach Trading Company, Inc. (New Jersey Corp.)
<a href="#">DELTA ESSENTIALS</a> RN: 5642341 SN: 87916627	Int'l Class: 09 (Int'l Class: 09) batteries; cabinets for loudspeakers; calculating machines; calculators and calculating machines; cell phones; chargers for batteries; chargers for electric batteries; computer hardware;	Shenzhen Shi San Zi You Du Keji You Xian Gong Si (China Limited Liability Company)

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Mark/Disclaimers	Relevant Goods/Services	Owner
	<p>computer peripheral devices; computers; covers for smartphones; electric switches; electrical arc detection and suppressing device used in low voltage switchgear; headphones; joysticks for use with computers, other than for video games; loudspeakers; mobile phones; portable computers; portable telephones; power switches; radio sets; radios; rechargeable batteries; remote controls for household, televisions, projectors; renewable battery system to provide backup power; smartphones; subwoofers; virtual reality glasses; virtual reality headsets; voltage stabilizing power supply; battery chargers; computer joystick peripherals; electric connections and connectors; electrical plugs and sockets</p>	
<p><a href="#">DIGITAL ESSENTIALS</a> RN: 4918893 SN: 86337020</p>	<p>Int'l Class: 09 (Int'l Class: 09) earphones; headphones; audio speakers; carrying cases, holders, protective cases and stands for use with mobile and handheld electronic devices; power supply connectors, adaptors, speakers and battery charging devices for use with mobile and handheld electronic devices; computer peripheral devices</p>	<p>Zeeva International LTD (Hong Kong Special Administrative Region of the People's Republic of China, the Limited Company (Ltd.))</p>
<p><a href="#">EM ESSENTIALS BY MOORECO and Design</a></p>  <p>ESSENTIALS BY MOORECO</p> <p>RN: 5698636 SN: 87704931</p>	<p>Int'l Class: 09, 12, 16, 20, 35 (Int'l Class: 09) Computer stands specially designed for holding a computer, printer and accessories; mounting racks for computer hardware (Int'l Class: 12) Carts (Int'l Class: 16) Felt boards; directory boards; chalk, slate and erasable marker boards for writing; wall mounted chalk and blackboards; easels; projection surfaces, namely, low-glare porcelain</p>	<p>Mooreco, Inc. (Texas Corp.)</p>

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Mark/Disclaimers	Relevant Goods/Services	Owner
	<p>marker boards; adjustable wall mounted chalk and blackboards; markers; erasers; rolls of vinyl surface sheeting for resurfacing dry erase writing boards and other writing surfaces; porcelain steel skins and porcelain steel panels for resurfacing dry erase writing boards and other writing surfaces; accessories for marker boards and chalk boards, namely, map rails, paper holders, bulletin bars, cork strips, and display rails</p>	
<p><a href="#">ESSENTIALS BY VENDEV</a> <a href="#">(Stylized)</a></p>  <p>RN: 5395668 SN: 87527022</p>	<p>Int'l Class: 09 (Int'l Class: 09) batteries, battery chargers and electrical cables</p>	<p>Voice Comm, LLC (Delaware Limited Liability Company)</p>
<p><a href="#">FACTORY ESSENTIALS</a> RN: 5928490 SN: 88241551</p>	<p>Int'l Class: 09 (Int'l Class: 09) Batteries</p>	<p>Shrip LLC (New York Limited Liability Company)</p>
<p><a href="#">MONSTER ESSENTIALS</a> RN: 4511440 SN: 85651584</p>	<p>Int'l Class: 09 (Int'l Class: 09) electrical and electromagnetic signal transmitting, amplifying, receiving, and converting devices, namely, cables, wires, and connectors for use with electrical, electronic, and computer devices; computer components and accessories, namely, computer cables, and computer connectors; cable storage and management devices, namely, casings and spools for securing bundles of audio, computer, electric, and power cables for containing and organizing audio, computer, electric and power cables; cell phone connecting cables; electrical power control components and accessories, namely, power conditioners, voltage stabilizers,</p>	<p>Monster, Inc. (California Corp.)</p>

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Mark/Disclaimers	Relevant Goods/Services	Owner
	current stabilizers, electrical surge protectors, circuit chargers and circuit breakers	
<p><a href="#"><u>ON THE MOVE ESSENTIALS</u></a>                      RN: 5437974                      SN: 87598560</p>	<p>Int'l Class: 09                      (Int'l Class: 09)                      carrying cases specially adapted for electronic equipment, namely, cell phones and laptops</p>	<p>Centon Electronics, Inc. (California Corp.)</p>
<p><a href="#"><u>OTM ESSENTIALS</u></a>                      RN: 5425868                      SN: 87136764</p>	<p>Int'l Class: 09                      (Int'l Class: 09)                      carrying cases, holders, protective cases and stands featuring power supply connectors, adaptors, speakers and battery charging devices, specially adapted for use with handheld digital electronic devices, namely, cell phones and laptops</p>	<p>Centon Electronics, Inc. (California Corp.)</p>
<p><a href="#"><u>PBJ ESSENTIALS</u></a>                      RN: 4856625                      SN: 86394918</p>	<p>Int'l Class: 09                      (Int'l Class: 09)                      carrying cases specially adapted for electronic equipment, namely, camcorders and cameras</p>	<p>Pbj Enterprises (Maryland Limited Liability Company)</p>
<p><a href="#"><u>SAMSUNG GALAXY ESSENTIALS</u></a>                      RN: 4806485                      SN: 86244338</p>	<p>Int'l Class: 09                      (Int'l Class: 09)                      mobile telephones; digital cameras; portable media players; portable computers; wireless headsets for mobile phones, smart phones and tablet computers; rechargeable batteries; battery chargers; leather cases for mobile phones, smart phones and tablet computers; flip covers for mobile phones, smart phones and tablet computers; tablet computers; television receivers; audio electronic components, namely, surround sound systems; digital set-top boxes; dvd players; light emitting diode displays; computer monitors; 3d eye glasses; computers; printers for computers; semiconductors; mobile application software for mobile phones, smart phones, and tablet computers, namely, software for use in searching, promoting, advertising, recommending, and downloading of mobile</p>	<p>Samsung Electronics Co., LTD. (Republic of Korea Corp.)</p>

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Mark/Disclaimers	Relevant Goods/Services	Owner
	<p>applications; mobile application software for mobile phones, smart phones, and tablet computers, namely, software for use in providing information and news in the field of mobile applications, mobile phones, smart phones, and tablet computers</p>	
<p><a href="#">TRAVEL ESSENTIALS</a>                      RN: 2613904                      SN: 76033249                      Disclaimer: "TRAVEL"</p>	<p>Int'l Class: 03, 06, 09, 14, 16, 18, 20, 21, 25, 26                      (Int'l Class: 09)                      ear plugs not for medical purposes; exchange calculators; and travelers' aids, namely, electric plug adapters</p>	<p>Travelpro Products, Inc.                      (Delaware Corp.)</p>
<p><a href="#">CHARGING ESSENTIALS</a>                      RN: 4639881                      SN: 86168038                      Disclaimer: "CHARGING"</p>	<p>Int'l Class: 09                      (Int'l Class: 09)                      wall usb chargers; wall electrical sockets</p>	<p>Consumer Sales Network, Inc.                      (Minnesota Corp.)</p>
<p><a href="#">EMF ESSENTIALS</a>                      RN: 6017097                      SN: 88492255                      Disclaimer: "EMF"</p>	<p>Int'l Class: 09, 42                      (Int'l Class: 09)                      Radiation mitigation products, namely, EMF meters, radiation shields for electronic products, protective clothing to block EMF, cell phone cases blocking EMF, and other products offering protection from smart meters, Wireless fidelity routers, and other sources of EMF, namely, smart meter covers and wireless fidelity router covers</p>	<p>Emf Essentials, Inc. (Arizona Corp.)</p>
<p><a href="#">M MONSTER ESSENTIALS (Stylized)</a>                        RN: 4506276                      SN: 85669116</p>	<p>Int'l Class: 09                      (Int'l Class: 09)                      electrical and electromagnetic signal transmitting, amplifying, receiving, and converting devices, namely, cables, wires, and connectors for use with electrical, electronic, and computer devices; computer components and accessories, namely, computer cables, and computer connectors; cable storage and management devices, namely, casings and spools for securing bundles of audio, computer, electric, and power cables for containing and</p>	<p>Monster, Inc. (California Corp.)</p>

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	organizing audio, computer, electric and power cables; cell phone connecting cables; electrical power control components and accessories, namely, power conditioners, voltage stabilizers, current stabilizers, electrical surge protectors, circuit chargers and circuit breakers	
<p><a href="#">BRITE ESSENTIALS</a>                      RN: 5306651                      SN: 87397982                      Disclaimer: "BRIGHT"</p>	<p>Int'l Class: 11                      (Int'l Class: 11)                      flashlights and lanterns for lighting</p>	<p>Energizer Brands, LLC                      (Delaware Limited Liability Company)</p>
<p><a href="#">ELEVATED HOME ESSENTIALS</a>                      RN: 5826113                      SN: 88244288                      Disclaimer: "HOME"</p>	<p>Int'l Class: 08, 10, 11                      (Int'l Class: 11)                      Dehumidifiers; Dehumidifiers for household use; Heating pads, electric, not for medical purposes; Humidifiers; Humidifiers for household purposes; Air purifiers; Electric heating pads, other than for medical purposes; Electric and battery operated aromatherapy units; Fabric steamers; Garment steamers; Light diffusers</p>	<p>Bear Down Brands, LLC                      (Delaware Limited Liability Company)</p>
<p><a href="#">ESSENTIAL and Design</a>                        RN: 5882988                      SN: 88327286</p>	<p>Int'l Class: 16                      (Int'l Class: 16)                      Paper labels</p>	<p>Shenzhen Yisensheng Paper Co.,LTD                      (China Limited Liability Company)</p>
<p><a href="#">H2O ESSENTIALS WATER FILTRATION SYSTEMS and Design</a>                        RN: 4865926                      SN: 86589616                      Disclaimer: "H2O" AND</p>	<p>Int'l Class: 11                      (Int'l Class: 11)                      water filters; water softening units</p>	<p>Gallagher, John                      (United States Citizen)</p>



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Mark/Disclaimers	Relevant Goods/Services	Owner
"WATER FILTRATION SYSTEMS"		
<a href="#">SHREDDER ESSENTIALS</a> RN: 2996641 SN: 76584020 Disclaimer: "SHREDDER"	Int'l Class: 16 (Int'l Class: 16) paper shredders for office use	Casa Innovations, Inc. (New York Corp.)

As can be seen from the above, many of these examples are marks that incorporate descriptive wording along with "ESSENTIALS," and while this descriptive wording is disclaimed, "ESSENTIALS" is not – for example, CHARGING ESSENTIALS for wall usb chargers ("CHARGING" disclaimed), SHREDDER ESSENTIALS for shredders ("SHREDDER" disclaimed), BRITE ESSENTIALS for flashlights ("BRIGHT" disclaimed), and WIRELESS ESSENTIALS for microphones ("WIRELESS" disclaimed).

The fact that the USPTO has allowed these marks to be registered without requiring proof of secondary meaning or disclaimer of "ESSENTIALS" shows that the USPTO does not consider the "ESSENTIALS" wording to be merely descriptive of the goods and services for which they are registered, many of which are identical to, or closely related with, the goods covered by the instant application. *See Borinquen Biscuit Corp. v. M.V. Trading Corp.*, 443 F.3d 112, 119-20 (1st Cir. 2006).

In addition, Applicant notes that there are numerous registrations for the exact mark "ESSENTIALS" without additional wording, on the Principal Register, with no claim of acquired distinctiveness under Section 2(f), covering a wide variety of goods and services. For example:

Mark/Disclaimers	Goods/Services	Owner
<a href="#">ESSENTIALS</a> RN: 3718439 SN: 77730580	Int'l Class: 19 (Int'l Class: 19) non-metal windows	Sunrise Windows, LLC (Delaware Limited Liability Company)
<a href="#">ESSENTIALS</a> RN: 4292609 SN: 77762334	Int'l Class: 05 (Int'l Class: 05) medicated lip care preparations, medicated topical creams, lotions, gels, balms, and/or ointments for human use for lip and skin dryness, cold sores, and for lip and skin care	Blistex Inc. (Illinois Corp.)

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Mark/Disclaimers	Goods/Services	Owner
<a href="#">ESSENTIALS</a> RN: 5074334 SN: 86667829	Int'l Class: 02 (Int'l Class: 02) coating compositions in the nature of paint for architectural applications	Ppg Architectural Finishes, Inc. (Delaware Corp.)
<a href="#">ESSENTIALS</a> RN: 4936184 SN: 86736941	Int'l Class: 09 (Int'l Class: 09) computer software for use in gis mapping namely, spatial and attribute database integration, spatial information management, data and statistical analysis, map viewing and map viewing interfaces, application hosting management, and creating spatially-oriented web interfaces	Vertigis North America LTD (Canada Corp.)
<a href="#">ESSENTIALS</a> RN: 5571653 SN: 87505939	Int'l Class: 12 (Int'l Class: 12) Child safety seats for use in cars and vehicles; parts and accessories for all of the aforementioned goods	Britax Childcare Holdings Limited (United Kingdom Private Limited Company)
<a href="#">ESSENTIALS</a> RN: 5887008 SN: 88252112	Int'l Class: 16 (Int'l Class: 16) Pencils	Staedtler Mars GmbH & Co. Kg (Germany GmbH & Co. Kg)
<a href="#">ESSENTIALS</a> RN: 6137324 SN: 88426189	Int'l Class: 34 (Int'l Class: 34) disposable electronic cigarettes and disposable oral vaporizers for smokers	Grewal, Khalid Rashid (United States Citizen)
<a href="#">ESSENTIALS</a> RN: 6113160 SN: 88760651	Int'l Class: 16 (Int'l Class: 16) Magazines in the field of health care	Essence Healthcare, Inc. (Missouri Corp.)
<a href="#">ESSENTIALS</a> RN: 2836344 SN: 78143333	Int'l Class: 16 (Int'l Class: 16) printed curriculum, namely, teaching materials, books, manuals, and paper handouts all in the field of religion for children	General Council of the Assemblies of God (Missouri Corp.)

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Mark/Disclaimers	Goods/Services	Owner
<a href="#">ESSENTIALS</a> RN: 2400577 SN: 75465095	Int'l Class: 19 (Int'l Class: 19) vinyl siding and trim	Owens Corning Intellectual Capital, LLC (Delaware Limited Liability Company)
<a href="#">ESSENTIALS</a> RN: 2674032 SN: 76231000	Int'l Class: 08 (Int'l Class: 08) hand tools, namely, pliers, screwdrivers, saws, wire cutters, can openers, scissors, knives, namely, utility knives and multi-function hand tools comprised of pliers, screwdrivers, saws, can openers and knives	Great Neck Saw Manufacturers, Inc. (New York Corp.)
<a href="#">ESSENTIALS</a> RN: 3512898 SN: 76469679	Int'l Class: 08 (Int'l Class: 08) Hand tools, namely, knives, screwdrivers, hammers, pliers	Great Neck Saw Manufacturers, Inc. (New York Corp.)

Copies of the above listed registration certificates are attached hereto as Exhibit A.

As set forth in the TMEP, “[t]he purpose of a disclaimer is to permit the registration of a mark that is registrable as a whole **but contains matter that would not be registrable standing alone**, without creating a false impression of the extent of the registrant’s right with respect to certain elements in the mark.” (Emphasis added). TMEP Section 1213.

Clearly, “ESSENTIALS” is suggestive and registerable standing alone, as indicated by its registration on a standalone basis, for a variety of goods as set forth above. Similarly, in this case, ESSENTIALS is not merely descriptive in relation to the goods covered by the Application and disclaimer should not be required.

### CONCLUSION

The “ESSENTIALS” wording is suggestive of the goods covered by the Application, but not merely descriptive. Accordingly, Applicant requests that the disclaimer requirement be withdrawn, and the Application be allowed to proceed to publication. If there are any remaining issues that can be addressed by telephone, the Examining Attorney is invited to contact the undersigned.