

**RESPONSE TO OFFICE ACTION**

Applicant RH US, LLC hereby responds to the United States Patent and Trademark Office Action dated June 7, 2021 (the “Office Action”). In the Office Action, the examining attorney (the “Examiner”) withdrew the previous Section 2(e)(1) refusal, but added a refusal to register Applicant’s mark RESTORATION HARDWARE (“Applicant’s Mark”) unless the word “RESTORATION” is disclaimed, on the basis that the term RESTORATION as used in Applicant’s Mark for “Design of interior décor; architectural services; landscape architectural services” is descriptive. While Applicant appreciates the Examiner’s withdrawal of the 2(e)(1) refusal, Applicant respectfully disagrees with the new basis for refusal, and asserts that RESTORATION as used is not merely descriptive, and therefore requests that the Examiner withdraw the refusal and approve Applicant’s application for publication.

***I. RESTORATION is Not Merely Descriptive of Applicant’s Services Because it Does Not Immediately Convey Information About the Services, and Evidence of Record Does Not Support Otherwise***

A term is merely descriptive if it immediately conveys knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used. *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 963 (Fed.Cir.2007) (citing *In re Gyulay*, 820 F.2d 1216, 1217 (Fed.Cir.1987) (emphasis added)). A term is not merely descriptive, and is instead suggestive, if when applied to the services at issue, it requires a consumer’s imagination, thought, or perception to reach a conclusion as to the nature of the services. This is known as the “degree of imagination” test. *Id.*

Following the “degree of imagination” test, a term is not merely descriptive unless there is an “almost instantaneous” connection between it and the product or service attributes. McCarthy on Trademarks and Unfair Competition § 11:67 (4th ed. 2006); *see also Alliance Bank v. New Century Bank*, 742 F. Supp. 2d 532, 548, 98 U.S.P.Q.2d 1292 (E.D. Pa. 2010) (CUSTOMER FIRST held to not convey any direct information about plaintiff’s community banking services); *Synergistic International Inc. v. Windshield Doctor Inc.*, 66 U.S.P.Q.2d 1936, 2003 WL 21468568 (C.D. Cal. 2003) (GLASS DOCTOR not descriptive for glass repair service); *Xtreme Lashes, LLC v. Xtended Beauty, Inc.*, 576 F.3d 221, 91 U.S.P.Q.2d 1385 (5th Cir. 2009) (XTREME LASHES not descriptive for artificial eyelashes as it takes imagination to associate the mark with the product).

In refusing this Application, the Examiner states that the term “RESTORATION” is defined as “the process of repairing or renovating a building, work of art, vehicle, etc., so as to restore it to its original condition,” which “merely describes applicant’s services.” As evidentiary support, the Examiner attached websites from three architectural firms that offer historic restoration services – or services that preserve historic buildings and architecture. However, this evidence does not support that the term is merely descriptive, and actually supports that any connection to the relevant services requires a significant leap—indicative of a suggestive term.

First, as stated above, a mark is only considered merely descriptive if it immediately describes an ingredient, quality, characteristic, function, feature, purpose, or use of the specified goods or services. *See* TMEP 1209.01. Here, the term RESTORATION as used by Applicant does not relate to restoring historic buildings. Instead, Applicant has used the RESTORATION HARDWARE mark for its home furnishing goods and related services for over 40 years. Given its long term use and the reputation it has developed, consumers recognize that the Mark as a whole is representative of Applicant’s brand, and that the term RESTORATION does not pertain to restoring products or restoration services. As a result, the term is not merely descriptive.

Second, whether a mark is merely descriptive is a factual finding that must be supported by “substantial evidence.” *In re Chamber of Commerce of the US*, 675 F.3d 1297, 1300 (Fed. Cir. 2012). Evidence will be deemed substantial if a reasonable person could find that the evidence is adequate to support the finding of descriptiveness. *Id.* Although Examiner contends that her position is supported by third-party use which “shows [RESTORATION] is commonly used in connection with similar services to mean the purpose of the services are to repair or renovate a building to restore its original condition.” However, three websites showing use of the term “restoration” in connection with repair and rehabilitation of historical buildings does not in fact show significant use of the term with the relevant and applied for services, and Applicant does not believe the Examiner submitted the substantial evidence necessary to support a descriptiveness finding.

## ***II. RESTORATION Should Not be Disclaimed Because Applicant’s Mark RESTORATION HARDWARE is a Unitary Mark***

Even if the Examiner disagrees with Applicant’s argument above that RESTORATION is not merely descriptive of Applicant’s services, RESTORATION should still not be disclaimed because Applicant’s Mark is a unitary mark, and individual elements within a unitary mark cannot be disclaimed. TMEP § 1213.03(b).

### ***a. Applicant’s RESTORATION HARDWARE mark is a unitary mark***

“A mark or portion of a mark is considered ‘unitary’ when it creates a commercial impression separate and apart from any unregistrable component. The test for unitariness inquires whether the elements of a mark are so integrated or merged together that they cannot be regarded as separable.” TMEP § 1213.05.

When determining whether a mark is a unitary mark, an examiner should look at “how the average purchaser would encounter the mark under normal marketing of such goods and also . . . what the reaction of the average purchaser would be to this display of the mark.” *Id.* Here, it is clear that the average purchaser encountering Applicant’s Mark would view it as a single, unitary mark. The mark, “RESTORATION HARDWARE” cannot be understood except as a single mark for the services at issue here. Due to its grammatical structure, it cannot be understood as “Hardware that has been restored,” or “Hardware to be used for restoration projects,” and instead it “creates a distinct meaning or commercial impression that is more than its constituent parts” and therefore should “be deemed unitary for purposes of a disclaimer.” *See* TMEP § 1213.05(b)(iii).

The TMEP gives a number of examples of marks similar to Applicant’s Mark that are unitary:

- BLACK MAGIC is a unitary mark for “accessories for skateboards and snowboards,” despite both “BLACK” and “MAGIC” having individual meanings because the phrase “has a distinct meaning of its own as a whole” apart from the individual definitions, despite some of the goods covered by the application potentially being black in color. TMEP § 1213.05(b)(iii)
- NOT YOUR ORDINARY DINER is a unitary mark for “restaurant services,” despite “DINER” being generic for, and having a specific individual meaning, in connection with restaurant services, because the mark forms a distinct meaning or commercial impression that is more than its constituent parts. TMEP § 1213.05(b)(iii)
- MANGOES FOR THE EARTH is a unitary mark for “fresh mangoes,” despite “MANGOES” obviously being generic for mangoes, because the phrase “brings all the wording in the mark together to convey something more than the individual components. TMEP § 1213.05(b)(ii)(B)
- TIP YOUR HAT is a unitary mark for “hats,” despite “HAT” obviously being generic for hats, because the mark “creates the commercial impression of touching or raising a hat as a greeting or polite gesture.” TMEP § 1213.05(b)(ii)(A)

Similarly, RESTORATION HARDWARE is a unitary mark in connection with the services within the application, namely, “design of interior décor; architectural services; landscape architectural services,” because the mark creates a singular commercial impression distinct from the individual components when applied to those services. The mark would create a single commercial impression even if the Application was for “hardware” goods, which it is not. As explained above, the strange grammatical structure of Applicant’s Mark means that it cannot be understood by English speakers except as a single, unitary mark with a unique commercial impression.

The fact that the Application only covers architectural and design services makes Applicant’s Mark have even more of a distinct meaning that is apart from any individual definitions of its constitute words.

***b. Individual elements within a unitary mark cannot be disclaimed***

Individual elements within a unitary mark cannot be disclaimed. TMEP § 1213.03(b). Therefore, because Applicant’s Mark is a unitary mark, RESTORATION should not be disclaimed.

As the examples above from the TMEP show, even when individual words have an obvious descriptive or generic meaning in relation to the goods or services, those individual words should not be disclaimed when they are part of a unitary mark. The TMEP states that “HAT” should not be disclaimed for “hats,” when contained within the unitary mark TIP YOUR HAT; “MANGOES” should not be disclaimed for “mangoes,” when contained within the unitary mark MANGOES FOR THE EARTH, “DINER” should not be disclaimed for “restaurant services” when contained within the unitary mark NOT YOUR ORDINARY DINER,” and “BLACK” should not be disclaimed for skateboard accessories when contained within the unitary mark BLACK MAGIC. *See*, TMEP § 1213.05(b)(ii)(A)-(B), (b)(iii). Here, “RESTORATION” is even further from the architectural and design services than the examples above were for their respective goods and services, and the Examiner has provided no evidence that consumers would understand “RESTORATION” within Applicant’s Mark to mean anything other than a part of the single commercial impression of Applicant’s Mark.

Therefore, because Applicant’s Mark of RESTORATION HARDWARE is a unitary mark that creates a single commercial impression, RESTORATION should not be disclaimed, even if the Examiner disagrees with Applicant’s argument that RESTORATION is not merely descriptive of Applicant’s services.

***III. All Doubts Must be Resolved in Favor of the Applicant***

The arguments outlined herein establish that RESTORATION should not be disclaimed because RESTORATION as used in Applicant’s Mark is at least suggestive and not merely descriptive of the services identified in the application, and Applicant’s Mark is a unitary mark for which a single term should not be disclaimed. To the extent Examiner has doubts regarding the descriptiveness of the term, any such doubts must be resolved in Applicant’s favor. *See In re The Stroh Brewery Co.*, 34 U.S.P.Q. 2d 1796, (TTAB 1994) (“when doubt exists as to whether a term is descriptive as applied to the goods or services for which registration is sought, it is the practice of the Board to resolve doubts in favor of the Applicant and pass the mark to publication.”) and *In re Salzgitter Flachstahl GmbH*, 2007 WL 1893923, 5 (T.T.A.B. June 27, 2007) (“in descriptiveness cases . . . we must resolve any doubts that we may have about whether applicant's mark is merely descriptive in applicant's favor”).

For the reasons stated above, the term RESTORATION is not descriptive for the applied for services, and is at the very least suggestive, and therefore should not be disclaimed.

***IV. Conclusion***

Applicant believes all outstanding issues with respect to the application for the subject mark have been resolved and respectfully requests approval of the same for publication.