

HI-FI RUSH
U.S. Application Serial No. 90398634
Office Action Response

I. AMENDED SERVICES

The Examining Attorney has requested clarification as to the description of goods and services included in the Application. Applicant accepts the Examiner's proposed amendments. Furthermore, applicant has deleted references to downloadable audio files and multimedia files. Given these amendments, Applicant notes that the revised recitations of goods and services are as follows:

Class 9: Downloadable mobile application software, namely, downloadable electronic game programs; downloadable computer game software for use with on-line interactive games; downloadable video game programs for mobile devices; downloadable electronic game programs; downloadable electronic game software; downloadable computer game programs; downloadable interactive game programs; downloadable interactive game software; downloadable computer game software offered via the internet and wireless devices; downloadable computer game software for use with computers and video game consoles; downloadable computer and video game software offered via the internet and wireless devices; pre-recorded electronic media devices featuring downloadable computer game software for use with computers and video game consoles; pre-recorded digital media in the nature of CD-ROMs and DVDs featuring computer games and video games, wallpapers, screensavers, graphics, videos, films, motion pictures, and animation in the field of video games and computer games; downloadable digital media, namely, downloadable images, downloadable artwork, downloadable text files, downloadable game software, and downloadable motion pictures, all in the field of video games and computer games

Class 41: Entertainment services, namely, providing on-line interactive computer games; online interactive games accessible via mobile phones and wireless devices; entertainment services, namely, providing information and entertainment in the nature of news, information, non-downloadable art pictures, non-downloadable video clips, and non-downloadable trailers relating to electronic computer games via the Internet; Providing non-downloadable electronic publications in the nature of books, magazines, journals and newspapers in the field of novels, comics and cartoons; movie film production; movie film distribution; television show production; rental of amusement machines and apparatus; rental of game machines and apparatus

II. DISCLAIMER REQUIREMENT

The Examining Attorney has refused registration of the Application and is requesting a disclaimer of the term "HI-FI". In a trademark application, a disclaimer is a statement that the applicant does not claim the exclusive right to use the elements/wording apart from the mark as a whole. TMEP § 1213. The purpose of a disclaimer is to permit 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. *Id.*

While Applicant concedes that a disclaimer may at times be required, the combined wording "HI-FI" is part of a unitary mark and the term "HI-FI" is not merely descriptive as applied to Applicant's goods and services. As such, for these reasons, Applicant respectfully requests that the Examining Attorney withdraw the request for a disclaimer of "HI-FI" and allow the Application to proceed to publication.

A. THE TERM "HI-FI" DOES NOT DESCRIBE APPLICANT'S GOODS AND SERVICES.

As noted above, Applicant concedes that a disclaimer may be required as to unregistrable components of a trademark, which includes matter that is merely descriptive or deceptively misdescriptive of the goods or services. TMEP §1203.03(a). However, in this case, Applicant contends that the allegedly descriptive term "HI-FI" does not describe Applicant's goods and services.

A mark is merely descriptive only if it “immediately describes” the Applicant’s goods or services. *In re Econoheat Inc.*, 218 U.S.P.Q. 381, 383 (T.T.A.B. 1983) (emphasis in original). For a term to be considered “merely descriptive,” the name must “immediately tell a potential customer what to expect in sum total of these concepts.” *Holiday Inns, Inc. v. Monolith Enter.*, 21 U.S.P.Q. 949, 952 (T.T.A.B. 1981).

However, if the term used as a mark provides vague or indirect information about the goods or services, then the term is used in a “suggestive” manner. 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS §11:19 (4th ed. 2002). See also *Glamorene Prods. Corp. v. Boyle-Midway, Inc.*, 188 U.S.P.Q. 145 (S.D.N.Y. 1975) (finding that the mark SPRAY ‘N VAC is not merely descriptive of a no scrub rug cleaner and stating “a mark is not merely descriptive unless descriptiveness is its *principal significance*. A mark is not descriptive if it merely suggests the nature or class of the product on which it is used”). *Philip Morris Inc. v. R.J. Reynolds Tobacco Co.*, 207 U.S.P.Q. 451, 455 (T.T.A.B. 1980). In concluding that the term “SOFT SMOKE” was suggestive, and not merely descriptive, the Board in *Philip Morris* noted that the term “SOFT SMOKE” suggests some characteristic of applicant’s smoking tobacco, but it is a “suggestion that may not be clear or immediately perceptible or even be the same for each user of applicant’s tobacco.” *Id.* at 456.

The *Philip Morris* case is similar to the case at hand. The Examiner has alleged that the term “HI-FI” means goods or services related to “the reproduction of music or other sound with high fidelity.” The term “HI-FI” may provide some very oblique suggestion regarding the nature and characteristics of Applicant’s goods and services, but because the term does not immediately describe Applicant’s goods and services, the suggestion is not clear, immediately perceptible, or even the same for each potential consumer of Applicant’s services. In no way does the term “HI-FI” directly describe the Applicant’s video and computer game related goods and services. To obviate any doubt about this point, Applicant has voluntarily amended the application to delete references to downloadable audio files and multimedia files from the recitation of goods in Class 9. Applicant does not sell audio equipment or any goods or services related to audio equipment, nor are such goods included in the recitation of goods and services included in the Application. Applicant appreciates the evidence provided by the Examiner in support of the disclaimer argument. However, Applicant respectfully contends that the dictionary definition for the term “HI-FI”, namely “equipment for reproduction of sound with high fidelity” (see: <https://www.merriam-webster.com/dictionary/hi-fi>) does not immediately describe or convey anything of substance about that Applicant’s goods and services. Thus, Applicant submits that the term “HI-FI” is at least suggestive and, therefore, the composite HIFI RUSH mark, when considered as a whole, is arbitrary when applied to the capable of registration on the Principal Register without a disclaimer requirement.

B. THE HI-FI RUSH MARK IS A UNITARY MARK AND THEREFORE A DISCLAIMER IS NOT NECESSARY



A disclaimer is also inappropriate in this case because the HI-FI RUSH mark is a unitary mark. Specifically, when a composite mark is unitary, an individual component of the mark need not be disclaimed. See TMEP § 1213.02 and § 1213.05, *et seq.* The combination of the terms “HI-FI” and “RUSH” into the HI-FI RUSH mark creates a unitary mark with a unique and distinctive meaning. Unitary marks are not properly dissected and characterized as descriptive, even if the individual components of the mark are allegedly descriptive. See TMEP § 1209.03(d). In *Warner Elec. Brake & Clutch*, the applicant sought to register the ELECTRO-MODULE mark for “electromagnetic friction clutches and brakes adapted for alternative motor or bracket mount.” 154 U.S.P.Q. 328, 328. Similarly, the Court of Customs and Patent Appeals held that the mark BROWN-IN-BAG, for cooking bags sued to brown meats, was suggestive when considered as a unitary mark. *Application of Reynolds Metals Co.*, 178 U.S. P.Q. 296, 297 (C.C.P.A. 1973) (noting that “it is true, but not fatal, that appellant’s [BROWN-IN-BAG] mark is informational”).


Similarly, the HI-FI RUSH mark is not merely descriptive when the words are used in combination. Rather, the unitary HI-FI RUSH mark is creates a distinctive commercial impression in the minds of consumers such that a disclaimer of the HI-FI term is not required

C. HI-FI RUSH SHOULD BE ABLE TO CO-EXIST WITH OTHER REGISTERED MARKS INCORPORATING THE TERM “HI-FI” WITHOUT A DISCLAIMER.


A review of the United States Patent and Trademark Office (“USPTO”) records identifies numerous marks on the Principal Register consisting of, in part, the term “HI-FI” for a variety of goods and services. The following is a representative sampling of such marks:

TM/Disclaimer	Status/Key Dates	Reg. No.	Goods/Services
COME BY, SAY HI-FI	Registered, March 16, 2021	6294993	Int'l Class: 35 (Int'l Class: 35) Retail store and on-line retail store services featuring audio and visual equipment, sound and audio equipment, video equipment, home theaters, consumer electronics, mobile electronics, computers, computer networks, communications equipment, home and mobile entertainment equipment, and software for use in storing and displaying multi-media programs, pre-recorded CDs and DVDs and vinyl records; Retail store and wholesale store services featuring audio and visual equipment, sound recordings, CDs, LPs, DVDs, laser discs, audiovisual recordings, videos tapes, audio tapes, posters, clothing, headwear, bags, audio accessories, furniture and cabinetry, slipmats for turntables, printed materials, musical instruments, patches, postcards, audio-visual and musical instrument parts and accessories; Online retail and wholesale store services featuring sound and audio equipment and musical instrument parts and accessories, sound and audio equipment, video equipment, home theaters, consumer electronics, mobile electronics, computers, computer networks, communications equipment, home and mobile entertainment equipment, and software for use in storing and displaying multi-media programs, pre-recorded CDs and DVDs and vinyl records, sound recordings, CDs, LPs, DVDs, laser discs, audiovisual recordings, videos tapes, audio tapes, posters, clothing and accessories, headwear, bags, audio accessories, furniture and cabinetry, slipmats for turntables, printed materials, musical instruments, patches, postcards; Providing consumer information related to music-related merchandise for retail purposes; Retail store services featuring sounds and music listening equipment for customers to preview compact discs, tapes, vinyl records, sound recordings, DVDs, DVRs, and other media prior to purchase; Provision of a website featuring commercial information on shopping
COMMON WAVE HI-FI	Registered, March 16, 2021	6292883	Int'l Class: 18 (Int'l Class: 18) Reusable shopping bags; Tote bags; Record carrying tote bags; All-purpose carrying bags; All-purpose reusable carrying bags; Canvas shopping bags;

TM/Disclaimer	Status/Key Dates	Reg. No.	Goods/Services
			Reusable shopping bags; Tote bags
COMMON WAVE HI-FI	Registered, March 16, 2021	6292884	Int'l Class: 25 (Int'l Class: 25) Clothing, namely, tops, tank tops, t-shirts, shirts, sweaters, sweatshirts, hooded sweatshirts, jackets, coats, jerseys, shorts, pants, sweatsuits, scarves, shawls, belts, socks, gloves and knitwear in the nature of tops, shirts, and bottoms; Headwear, namely, hats, caps and beanies
HI FI YOGA Disclaimer: "YOGA"	Registered, April 16, 2019	5729681	Int'l Class: 41 (Int'l Class: 41) Providing fitness training and instruction services in the field of yoga; yoga instruction; educational services, namely, conducting classes, camps and workshops in the field of yoga and yoga teaching; providing fitness and exercise studio services, namely, yoga instruction and training
HI/FI RADIO ROASTERS USA and Design  Disclaimer: "ROASTERS" AND "USA"	Registered, December 8, 2015	4865831	Int'l Class: 30 (Int'l Class: 30) Artificial coffee; Artificial coffee and tea; Beverages made of coffee; Beverages with a coffee base; Caffeine-free coffee; Chicory based coffee substitute; Coffee; Coffee; Coffee and artificial coffee; Coffee and coffee substitutes; Coffee and tea; Coffee based beverages; Coffee beans; Coffee beverages with milk; Coffee-based beverages; Coffee-based iced beverages; Ground coffee beans; Iced coffee; Prepared coffee and coffee-based beverages; Roasted coffee beans
HI-FI	Registered, June 14, 2016	4979893	Int'l Class: 34 (Int'l Class: 34) Cigarillos; Cigars; Tobacco
HIFI and Design 	Registered, April 13, 2018	4177583	Int'l Class: 07, 11, 16 (Int'l Class: 07) Filters for cleaning cooling air, for engines; cartridges for filtering machines; filtering machines; filters being parts of machines and engines; machines, namely, filter presses (Int'l Class: 11) Air purifying apparatus and machines; filters for air conditioning; air filtering installations; air dryers; water filtering apparatus; filters for drinking water; aquarium filtration apparatus; air and water filters being parts of household or industrial installations

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			(Int'l Class: 16) Paper filtering materials; filter paper
HIFI	Registered, January 16, 2018	5380959	Int'l Class: 09, 42 (Int'l Class: 09) pipe and pipeline failure and leak sensors, fiber optic sensors for detecting leaks or failures in surface or sub-surface pipelines, tubulars, pipe strings or pipes (Int'l Class: 42) engineering services, namely, field and remote investigation of surface and sub-surface pipe and pipeline failures and leaks to industry organizations
HIFI	Registered, October 27, 2015	4842995	Int'l Class: 09, 42 (Int'l Class: 09) Software, namely, downloadable computer application software, for early language and early literacy assessment for mobile phones, portable media players, tablets and handheld computers, featuring testing, teaching, monitoring, and assessment tools in the field of literacy and early literacy skills; Providing downloadable computer application software that assesses early language and early literacy skills for mobile phones, portable media players, tablets and handheld computers over a global computer information network, featuring technology that provides instructional and educational testing, teaching, monitoring and assessment services in the field of literacy and early literacy skills; Providing downloadable computer application software for mobile phones, portable media players, tablets and handheld computers for creation of an educational platform that allows for the transmission of messages among computer users concerning customized educational content and materials in the field of literacy and early literacy skills; Downloadable computer application software for assessing early language and early literacy skills for mobile phones, portable media players, tablets and handheld computer (Int'l Class: 42) On-line computer services providing testing, teaching, monitoring and assessment tools in the nature of non-downloadable software for assessing students' early language and early literacy skills
HIFI (Stylized) 	Registered, November 9, 2021	6555666	Int'l Class: 09, 35, 36, 42 (Int'l Class: 09) Downloadable software for accounting, bookkeeping, and payroll (Int'l Class: 35)

TM/Disclaimer	Status/Key Dates	Reg. No.	Goods/Services
			Payroll processing services (Int'l Class: 36) Collecting license fees on behalf of independent writers and publishers and making payments to the copyright owners of the music (Int'l Class: 42) Software as a service (SAAS) services featuring software for accounting, bookkeeping, and payroll
HIFI	Registered, November 9, 2021	6555665	Int'l Class: 09, 35, 36, 42 (Int'l Class: 09) Downloadable software for accounting, bookkeeping, and payroll (Int'l Class: 35) Payroll processing services (Int'l Class: 36) Collecting license fees on behalf of independent writers and publishers and making payments to the copyright owners of the music (Int'l Class: 42) Software as a service (SAAS) services featuring software for accounting, bookkeeping, and payroll
HIFI	Renewed, December 2, 2010	1663689	Int'l Class: 41 (Int'l Class: 41) entertainment services in the nature of a music group
HI-FI	Registered, December 25, 2018	5638221	Int'l Class: 03 (Int'l Class: 03) Body spray used as a personal deodorant and as fragrance; Eau de toilette and eau de cologne; Fragrances; Perfumes, aftershaves and colognes
HI-FI	Registered, February 19, 2019	5677479	Int'l Class: 05, 31 (Int'l Class: 05) Veterinary preparations for equines for the management of laminitis, equine gastric ulcer syndrome and equine rhabdomyolysis syndrome; animal feed additives for use as a nutritional supplement for medical purposes and dietary supplements; vitamins for animals; vitamins and mineral dietary food supplements for animals; dietary fibre to aid digestion for animals; linseed dietary supplements for animals; yeast dietary supplements and yeast extracts for veterinary purposes (Int'l Class: 31) Foodstuffs and feeds for animals; animal foodstuff and animal feed preparations; feed supplements for animals; fresh alfalfa for animals; alfalfa seeds for animals; dried alfalfa for animals; alfalfa based

TM/Disclaimer	Status/Key Dates	Reg. No.	Goods/Services
			products, namely, equine feeds; chopped straw for animal bedding; animal foodstuffs in the form of pellets; linseed for animal consumption; fibre and yeast extracts and yeast tablets for animal consumption
HI-FI	Registered, March 30, 2021	6306119	Int'l Class: 09 (Int'l Class: 09) snow goggles; motocross and motorcycle goggles
HI-FI	Renewed, May 11, 2012	1686580	Int'l Class: 29 (Int'l Class: 29) shortening
HI-FI	Renewed, November 9, 2017	3331534	Int'l Class: 10 (Int'l Class: 10) Surgical sutures
HIFI FARMS	Registered, October 10, 2017	5308341	Int'l Class: 25 (Int'l Class: 25) Hoodies; Shirts; Sweatshirts; Hooded sweatshirts
HI-FI HANGOVER HIGH ENERGY ROCK 20 10 75 3 0 0 20 40 60 80 100% HI-FI and Design  Disclaimer: "ROCK"	Registered, September 18, 2018	5566506	Int'l Class: 41 (Int'l Class: 41) Entertainment, namely, live performances by a musical band
HI-FI HOPS	Registered, June 15, 2021	6389890	Int'l Class: 35 (Int'l Class: 35) Promoting public awareness of the cannabis and hemp movements
HI-FI ROOFTOP BAR Disclaimer: "ROOFTOP BAR"	Registered, July 9, 2019	5799853	Int'l Class: 43 (Int'l Class: 43) Bar and cocktail lounge services

TM/Disclaimer	Status/Key Dates	Reg. No.	Goods/Services
HI-FI SHINE Disclaimer: "SHINE"	Registered, November 6, 2018	5602475	Int'l Class: 03 (Int'l Class: 03) Lip gloss
HIFI-EVO	Registered, August 6, 2019	5824013	Int'l Class: 09 (Int'l Class: 09) Batteries; Battery chargers; Blank hard computer discs; Blank USB flash drives; Cabinets for loudspeakers; Car video recorders; Cell phone cases; Cell phone covers; Chargers for electric batteries; Consumer electronic products, namely, audio amplifiers, audio speakers, audio receivers, electrical audio and speaker cables and connectors, audio decoders, video decoders, speakers, power conversion devices, power converters, and power inverters; Earphones and headphones; Hard disk drives (HDD); Loud speakers; Memory cards; Portable listening devices, namely, MP3 players; Portable media players; Power supplies; Protective covers and cases for cell phones, laptops and portable media players; Secure Digital (SD) Memory Cards; Stands for handheld digital electronic devices, namely, cell phones; Blank flash memory cards
HIFI-M8	Registered, September 9, 2020	4452114	Int'l Class: 09 (Int'l Class: 09) Consumer electronic products, namely, a portable, hand-held audio component for use with computers and smart phones to provide improved audio playback quality
HIPHI	Registered, January 12, 2021	6242382	Int'l Class: 42 (Int'l Class: 42) Cartography services; Industrial design; Research and development of technology in the field of roadworthiness; Dress designing; Weather forecasting; Surveying; Computer programming; Quality management services, namely, quality evaluation and analysis, quality assurance, and quality control, in the field of motor vehicles; Vehicle roadworthiness testing; Off-site data backup
HIPHI	Registered, December 31, 2019	5947347	Int'l Class: 39 (Int'l Class: 39) Parcel delivery; piloting; arranging of transportation for travel tours; Car rental; Car transport; Pleasure boat transport; Air transport; Rental of storage containers

TM/Disclaimer	Status/Key Dates	Reg. No.	Goods/Services
HIPHI	Registered, December 24, 2019	5941282	Int'l Class: 37 (Int'l Class: 37) Clothing repair; Heating equipment installation and repair; Motor vehicle maintenance and repair; Electric appliance installation and repair; Providing an Internet website that features information about automotive maintenance and repair service; Retreading of tires; vehicle washing; Burglar alarm installation and repair; Rustproofing; Airplane maintenance and repair
HIPHI	Registered, December 24, 2019	5941281	Int'l Class: 36 (Int'l Class: 36) Real estate management services; Insurance brokerage; Trusteeship representatives; Pawn brokerage; Charitable fund raising; surety services; Automobile lease financing; financial customs brokerage services; Art appraisal; Financial management
HIPHI	Registered, December 31, 2019	5947346	Int'l Class: 18 (Int'l Class: 18) Umbrellas; motorized suitcases; walking sticks; Travelling bags; fur; Leather leads; Leather thread; bags for sports
HIPHI	Registered, December 31, 2019	5947345	Int'l Class: 09 (Int'l Class: 09) Interactive touch screen terminals; Signalling devices, namely, traffic-light apparatus; Parking meters; Hologram apparatus; Semi-conductors; reflective safety vests; Sunglasses; Electric navigational instruments; Cabinets for loudspeakers; Alarm installations and alarms; Computer component testing and calibrating equipment; Fire extinguishers; electronic key fobs being remote control apparatus; Tool measuring instruments; Video screens; accumulators, electric, for vehicles; Keyless entry system and keyless ignition switch system for automotive vehicles comprised of a microprocessor, electronic signal receiver, and keyfob with electronic signal transponder; lightning rods
HIPHI	Registered, November 3, 2020	6187576	Int'l Class: 12 (Int'l Class: 12) Trolleys; Locomotives; Cars; Automobile tires; Airplanes; Bicycles; pumps for bicycle tires; Boats; Patches for repairing inner tubes; Brake discs for vehicles; Remotely controlled land vehicle, for

TM/Disclaimer	Status/Key Dates	Reg. No.	Goods/Services
			transport; Carts; Automobile seat cushions
HY-FI	Registered, July 30, 2018	4180171	Int'l Class: 09 (Int'l Class: 09) Computer software and hardware for wired and wireless information delivery
LIFE IN HI-FI	Registered, September 22, 2015	4819268	Int'l Class: 38 (Int'l Class: 38) Providing online forums for communication on topics of general interest; providing online chat rooms and electronic bulletin boards for transmission of messages among users in the field of general interest; audio, text and video broadcasting services over the Internet or other communications network featuring the uploaded, posted and tagged videos of others; peer-to-peer photo and video sharing services, namely, electronic transmission of digital photo files and video files among Internet users
LIFE IN HI-FI	Registered, September 22, 2015	4819269	Int'l Class: 42, 45 (Int'l Class: 42) Providing a web site that gives users the ability to upload images, videos and audio-visual content; computer services, namely, creating on-line virtual communities for registered users to organize groups and events, participate in discussions, and engage in social, business, lifestyle and community networking; providing an online network service that enables users to transfer personal identity data to and share personal identity data with and among multiple websites; providing a web site featuring technology that enables online users to create personal profiles featuring social networking information and to transfer and share such information among multiple websites; providing a website featuring technology enabling users to upload, view, and download digital photo files and video files (Int'l Class: 45) Internet based social networking services; providing a social networking website for entertainment purposes
LIFE IN HI-FI	Registered, September 22, 2015	4819267	Int'l Class: 16 (Int'l Class: 16) Decorative decals and stickers
LIFE IN HI-FI	Registered, April 12, 2016	4937474	Int'l Class: 35 (Int'l Class: 35) On-line retail store services featuring decals and

TM/Disclaimer	Status/Key Dates	Reg. No.	Goods/Services
			stickers, men's apparel, women's apparel and sports apparel
LIFE IN HI-FI	Registered, September 22, 2015	4818258	Int'l Class: 25 (Int'l Class: 25) Men's apparel, namely, shirts, pants, shorts, sweatshirts, sweatpants, running suits, swimwear, golf shirts, golf pants, ski wear; women's apparel, namely, shirts, skirts, pants, shorts, sweatshirts, sweatpants, running suits, swimwear, golf shirts, golf pants, golf skirts, ski wear; sports apparel, namely, sweat shirts, sweat pants, sweat suits, running suits, running shorts, golf shorts, swim wear, T-shirts, athletic shorts, hats and caps, wristbands, headbands, jackets
LIFE IN HI-FI	Registered, November 22, 2016	5085293	Int'l Class: 09 (Int'l Class: 09) Downloadable software in the nature of a mobile application for creating on-line virtual communities for users to organize groups and events, participate in discussions, and engage in social, business, lifestyle and community networking
SHELL HIFI	Renewed, April 29, 2016	3062762	Int'l Class: 09, 11 (Int'l Class: 09) Refinery equipment, namely, trays for use in distillation, extraction, absorption or stripping columns (Int'l Class: 11) Refinery apparatus and instruments, namely, separators for contacting gases and liquids.

Copies of the United States Trademark Registration Certificates for the above-referenced marks are attached hereto as **Exhibit A** and hereby made a part of the record.

As shown above, the USPTO has allowed registration of a large number of marks comprised of or incorporating the term "HI-FI" on the Principal Register without a disclaimer of the term "HI-FI" or a claim of acquired distinctiveness. Many of these marks relate to goods and services that are much more closely related to "the reproduction of music or other sound with high fidelity" than the goods and services recited in the Application, including services such as live performances by a musical band, consumer products for increasing audio quality, and retail store and on-line retail store services featuring audio and visual equipment, among others.

Applicant respectfully submits that the registrability of such marks clearly indicates that consumers do not necessarily view the term "HI-FI" as descriptive in all contexts. Thus, if each of these marks are capable of registration on the Principal Register without the disclaimer requirement, then Applicant's HI-FI RUSH mark should likewise be registrable without the disclaimer requirement for "HI-FI."

D. DOUBTS SHOULD BE RESOLVED IN FAVOR OF APPLICANT.

A term is considered merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of the specified goods or services. TMEP § 1209.01(b). In other words, to be "merely descriptive," the mark must do nothing but describe the particular goods/services to the consumer. Unlike a refusal under Section 2(d) of the Trademark Act, under Section 2(e), all doubts as to descriptiveness of the mark must be resolved in favor of the Applicant and the mark should be published for opposition. In *Shutts*, the Board stated this principle clearly:

We recognize that the suggestive/descriptive dichotomy can require the drawing of fine lines and often involves a good measure of subjective judgment. Indeed, this case may well present such a challenge in making the necessary classification. At the very least, however, we have doubts about the "merely descriptive" character of the mark before us and, unlike the situation in determining likelihood of confusion under Section 2(d) of the Trademark Act, it is clear that such doubts are to be resolved in favor of applicants.

In re Shutts, 217 U.S.P.Q. 363, 365 (T.T.A.B. 1983). See also *In re Bed-Check Corp.*, 226 U.S.P.Q. 946 (T.T.A.B. 1985). The reason for this rule is patently clear: passing the mark to publication does not guarantee the Applicant any rights, but merely enables any person who believes he would be damaged by the registration of the mark to present evidence of descriptiveness. See *In re Morton-Norwich Prods., Inc.*, 209 U.S.P.Q. 791 (T.T.A.B. 1981); *In re Wisconsin Tissue Mills*, 173 U.S.P.Q. 319 (T.T.A.B. 1972); *In re Distribution Codes, Inc.*, 199 U.S.P.Q. 508 (T.T.A.B. 1978); *In re Ray J. McDermott and Co., Inc.*, 170 U.S.P.Q. 524 (T.T.A.B. 1971).

In reversing the Examining Attorney's refusal to register the service mark CODE & SYMBOL for product identification journals, the Board stated:

Our decision is assisted by the fact that we have no information that anyone will be damaged by the registration of the mark but that anyone who would be injured will have an opportunity to file a notice of opposition and to develop a factual record upon which any question of descriptiveness could be adjudicated with more confidence than it can be on the basis of *a priori* assumptions.

In re Distribution Codes, Inc., 199 U.S.P.Q. 508, 511 (T.T.A.B. 1978). Therefore, in the present case, the term "HI-FI" is not "merely descriptive" of the amended goods and services, and at the very least, deserves the benefit of this presumption.

Any doubts as to the descriptiveness of a term should be resolved in favor of Applicant. "[T]here is a thin line between a suggestive and a merely descriptive designation, and where reasonable men may differ, it is the Board's practice to resolve the doubt in the Applicant's favor and publish the mark for opposition." *In re Morton-Norwich Prods., Inc.*, 209 U.S.P.Q. 791 (T.T.A.B. 1981). See also *In re Penwalt Corp.*, 173 U.S.P.Q. 317, 319 (T.T.A.B. 1972). Under these standards, Applicant's mark is entitled to approval without the disclaimer requirement.

III. PRIOR PENDING APPLICATION

The Examining Attorney has made reference to Ser. No. 90058901, which was filed with the USPTO on July 17, 2020, noting that it "precedes applicant's filing date". While it is true that Applicant did not file the subject Application until December 21, 2020, Applicant respectfully notes that same Application includes a claim of priority based upon an earlier trademark filing made in Honduras on July 9, 2020. Thus, without directly addressing the underlying issue of potential confusion between the marks, Applicant believes that its earlier effective filing date should be sufficient to eliminate this issue from consideration as to the subject mark's eligibility for registration.

Notwithstanding the foregoing, Applicant reserves its right to make arguments against a refusal under § 2(d), or any other basis that the Examiner may choose to raise in this case.

IV. CONCLUSION

For the above-stated reasons, Applicant believes that it has thoroughly and completely addressed the Examining Attorney's concerns and respectfully requests that the Examining Attorney withdraw the disclaimer requirement with respect to the term "HI-FI" and allow the Application to proceed to publication.