

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)  
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

U.S. APPLICATION SERIAL NO. 77684321

MARK: BEST FOR BABY

**\*77684321\***

**CORRESPONDENT ADDRESS:**

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**APPLICANT:** Johnson & Johnson

**CORRESPONDENT'S REFERENCE/DOCKET NO :**

N/A

**CORRESPONDENT E-MAIL ADDRESS:**

**OFFICE ACTION**

**STRICT DEADLINE TO RESPOND TO THIS LETTER**

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

**ISSUE/MAILING DATE:**

**THIS IS A FINAL ACTION.**

This Office action is in response to applicant's communication filed on March 7, 2016. The examining attorney has considered the applicant's response and determined the following:

**SPECIMEN REFUSAL**

The specimen refusal that was the subject of the TTAB hearing is hereby withdrawn.

**SECTION 2(e)(1) REFUSAL – FINAL**

The applicant applied to register the applied-for mark BEST FOR BABY for "toiletries, namely, baby bath skin cleansers and washes, and baby lotion." The descriptiveness refusal under Trademark Act Section 2(e)(1) is now made FINAL for the reasons set forth below. *See* 15 U.S.C. §1052(e)(1); 37 C.F.R. §2.64(a).

Registration was refused because the applied-for mark merely describes a feature of applicant's goods. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); *see* TMEP §§1209.01(b), 1209.03 *et seq.*

A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods and/or services. TMEP §1209.01(b); *see In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005); *In re Gyulay*, 820 F.2d 1216, 1217-18, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987).

The evidence attached to the prior Office action consisted of a dictionary definition of "best" which is defined as "better than all others." In the context of the applicant's applied-for mark BEST FOR BABY, "best" immediately confers the meaning that the applicant's goods are better than all other baby bath skin cleansers, washes and baby lotion. "Best" is laudatory as it is merely descriptive of the ingredients of the goods. In the applied-for mark, the word "best" refers to the ingredients in applicant's toiletries that set them apart from other brands. Applicant's goods are lauded as the "best". Accordingly, the goods are best for the babies, the intended users of the goods.

In addition, BEST FOR BABY contains the preposition "for," which connects the laudatory term "best" with the class of people the applicant's products are intended to be used on, namely, babies. The average consumer would conclude that in connection with applicant's

toiletries, the applied-for mark merely describes the goods as the “best” toiletries for babies.

A mark that describes an intended user or group of users of a product or service is merely descriptive. *E.g., In re Planalytics, Inc.*, 70 USPQ2d 1453 (TTAB 2004) (holding GASBUYER merely descriptive of intended user of risk management services in the field of pricing and purchasing natural gas); *In re Camel Mfg. Co.*, 222 USPQ 1031 (TTAB 1984) (holding MOUNTAIN CAMPER merely descriptive of intended users of retail and mail order services in the field of outdoor equipment and apparel); *see* TMEP §1209.03(i).

Determining the descriptiveness of a mark is done in relation to an applicant’s goods and/or services, the context in which the mark is being used, and the possible significance the mark would have to the average purchaser because of the manner of its use or intended use. *See In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (citing *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 963-64, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)); TMEP §1209.01(b). Descriptiveness of a mark is not considered in the abstract. *In re Bayer Aktiengesellschaft*, 488 F.3d at 963-64, 82 USPQ2d at 1831.

The applied-for mark is descriptive because does not requires a mental leap on the part of consumers to connect “BEST FOR BABY” with the applicant’s “toiletries, namely, baby bath skin cleansers and washes, and baby lotion” and arrive at the conclusion that the goods have the best ingredients in their class for babies.

Generally, if the individual components of a mark retain their descriptive meaning in relation to the goods and/or services, the combination results in a composite mark that is itself descriptive and not registrable. *In re Phoseon Tech., Inc.*, 103 USPQ2d 1822, 1823 (TTAB 2012); TMEP §1209.03(d); *see, e.g., In re Cannon Safe, Inc.*, 116 USPQ2d 1348, 1351 (TTAB 2015) (holding SMART SERIES merely descriptive of metal gun safes, because “each component term retains its merely descriptive significance in relation to the goods, resulting in a mark that is also merely descriptive”); *In re King Koil Licensing Co.*, 79 USPQ2d 1048, 1052 (TTAB 2006) (holding THE BREATHABLE MATTRESS merely descriptive of beds, mattresses, box springs, and pillows where the evidence showed that the term “BREATHABLE” retained its ordinary dictionary meaning when combined with the term “MATTRESS” and the resulting combination was used in the relevant industry in a descriptive sense); *In re Associated Theatre Clubs Co.*, 9 USPQ2d 1660, 1663 (TTAB 1988) (holding GROUP SALES BOX OFFICE merely descriptive of theater ticket sales services, because such wording “is nothing more than a combination of the two common descriptive terms most applicable to applicant’s services which in combination achieve no different status but remain a common descriptive compound expression”).

Only where the combination of descriptive terms creates a unitary mark with a unique, incongruous, or otherwise nondescriptive meaning in relation to the goods and/or services is the combined mark registrable. *See In re Colonial Stores, Inc.*, 394 F.2d 549, 551, 157 USPQ 382, 384 (C.C.P.A. 1968); *In re Positec Grp. Ltd.*, 108 USPQ2d 1161, 1162-63 (TTAB 2013). In this case, both the individual components and the composite result are descriptive of applicant’s goods and/or services and do not create a unique, incongruous, or nondescriptive meaning in relation to the goods and/or services.

The applicant has argued that the evidence attached to the first Office action is insufficient, asserting that BEST FOR BABY is suggestive because it requires a leap of imagination on the part of a consumer (Applicant’s Response, page 1). On the contrary, no leap of imagination is required for a consumer to conclude that BEST FOR BABY means toiletries are “best” for babies. “Whether consumers could guess what the product [or service] is from consideration of the mark alone is not the test.” *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

Second, the applicant argues that the actual product is not what is being lauded in the applicant’s mark, because “best for” is followed by the term “baby,” which is not the generic name of the product (Applicant’s Response, pages 1-2). Although the term “best” does not describe the term “baby,” it does describe the goods. The phrase BEST FOR BABY is descriptive as a whole and in part.

Finally, applicant concedes that BEST FOR BABY describes the quality of its goods. (Applicant’s Response, page 5). The quality of the goods includes the quality of the ingredients which applicant’s BEST FOR BABY mark lauds. Consumers looking for the best quality toiletry products to use on their babies would be persuaded by applicant’s use of the terms BEST FOR BABY in connection with its toiletry products. BEST FOR BABY is directly connected to the quality of applicant’s products and therefore merely descriptive. “Marks that are merely laudatory and descriptive of the alleged merit of a product [or service] are . . . regarded as being descriptive” because “[s]elf-laudatory or puffing marks are regarded as a condensed form of describing the character or quality of the goods [or services].” *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1256, 103 USPQ2d 1753, 1759 (Fed. Cir. 2012) (quoting *In re The Boston Beer Co.*, 198 F.3d 1370, 1373, 53 USPQ2d 1056, 1058 (Fed. Cir. 1999)); *see In re Nett Designs, Inc.*, 236 F.3d 1339, 1342, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) (holding THE ULTIMATE BIKE RACK merely laudatory and descriptive of applicant’s bicycle racks being of superior quality); *In re The Boston Beer Co.*, 198 F.3d at 1373-74, 53 USPQ2d at 1058-59 (holding THE BEST BEER IN AMERICA merely laudatory and descriptive of applicant’s beer and ale being of superior quality); TMEP §1209.03(k). In fact, “puffing, if anything, is *more* likely to render a mark merely descriptive, not less so.” *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d at 1256, 103 USPQ2d at 1759. *See also, In re Duvernoy & Sons, Inc.*, 212 F.2d 202, 204, 101 USPQ 288, 289 (C.C.P.A. 1954) (holding CONSISTENTLY SUPERIOR merely laudatory and descriptive of applicant’s bakery products always being of superior quality); *In re The Place, Inc.*, 76 USPQ2d 1467, 1468 (TTAB 2006) (holding THE GREATEST BAR merely laudatory and descriptive of applicant’s restaurant being markedly superior in character or quality to other restaurants and bars); *In re Dos Padres, Inc.*, 49 USPQ2d 1860, 1862 (TTAB 1998) (holding QUESO QUESADILLA SUPREME merely laudatory and descriptive of applicant’s cheese being of superior quality); *In re Inter-State Oil Co.*, 219 USPQ 1229, 1230 (TTAB 1983)

(holding PREFERRED merely laudatory and descriptive of applicant's bird and squirrel repellent being liked better than other similar products). For the aforementioned reasons, the refusal to register under Section 2(e)(1) is hereby maintained and made **FINAL**.

**OPTION OF SUPPLEMENTAL REGISTER**

The applied-for mark has been refused registration on the Principal Register. Applicant may respond to the refusal by amending the application to seek registration on the Supplemental Register. See 15 U.S.C. §1091; 37 C.F.R. §§2.47, 2.75(a); TMEP §§801.02(b), 816.

**PROPER RESPONSE TO A FINAL ACTION**

If applicant does not respond within six months of the date of issuance of this final Office action, the application will be abandoned. 15 U.S.C. §1062(b); 37 C.F.R. §2.65(a). Applicant may respond to this final Office action by:

- (1) Submitting a response that fully satisfies all outstanding requirements, if feasible; and/or
- (2) Filing an appeal to the Trademark Trial and Appeal Board, with an appeal fee of \$100 per class.

37 C.F.R. §§2.6(a)(18), 2.64(a); TBMP ch. 1200; TMEP §714.04.

In certain rare circumstances, a petition to the Director may be filed pursuant to 37 C.F.R. §2.63(b)(2) to review a final Office action that is limited to procedural issues. 37 C.F.R. §2.64(a); TMEP §714.04; see 37 C.F.R. §2.146(b); TBMP §1201.05; TMEP §1704 (explaining petitionable matters). The petition fee is \$100. 37 C.F.R. §2.6(a)(15).

/Gina Hayes/  
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**All informal e-mail communications relevant to this application will be placed in the official application record.**

**WHO MUST SIGN THE RESPONSE:** It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

**PERIODICALLY CHECK THE STATUS OF THE APPLICATION:** To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov) or call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

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