

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77729594
LAW OFFICE ASSIGNED	LAW OFFICE 104
MARK SECTION (no change)	
ARGUMENT(S)	
<p>Applicant submits the following remarks in response to the Final Office Action mailed on August 10, 2010.</p> <p style="text-align: center;"><u>REMARKS</u></p> <p>Applicant respectfully requests that the Examining Attorney reconsider her refusal to register the mark NEWSWEEK GREEN RANKINGS as a trademark for Applicant's various goods and services.</p> <p>I. <u>Introduction</u></p> <p>The Examining Attorney has refused registration of the subject mark NEWSWEEK GREEN RANKINGS under Section 6(a) of the Trademark Act on the basis that a disclaimer is required for the wording GREEN RANKINGS because it is descriptive of the subject matter of the goods and a feature of the identified services. Applicant respectfully disagrees that the wording GREEN RANKINGS is descriptive. First, it appears that the Examining Attorney has improperly dissected the terms GREEN and RANKINGS from the GREEN RANKINGS term in its analysis. Moreover, Applicant submits that GREEN RANKINGS is suggestive and does not immediately or directly convey anything about the products to the consumer.</p> <p>II. <u>Argument</u></p> <p>1. <u>GREEN RANKINGS Must be Considered as a Whole</u></p> <p>It is certainly appropriate for the Examining Attorney to discuss the implications of each part of a</p>	

compound mark. However, it has long been accepted that the final determination of descriptiveness must be based on consideration of the mark as a whole. See *Concurrent Technologies, Inc. v. Concurrent Technologies Corp.*, 12 U.S.P.Q.2d 1054, 1057 (T.T.A.B. 1989) (finding CONCURRENT TECHNOLOGIES CORPORATION to be suggestive and stating “we must consider the descriptiveness of the mark [] by looking at the mark as a whole.”).

In requiring the disclaimer of GREEN RANKINGS, the Examiner appears to have improperly dissected and considered a single separate meaning each for the terms “green” and “ranking,” and then combined them into one arbitrary definition for “green rankings,” which does not have a dictionary listing. See Definition of “green rankings” from *Merriam-Webster Online Dictionary*, attached as *Exhibit 1*. Specifically, the Examining Attorney argues that “green rankings” means “a listing of items in a group according to a system of rating or record of performance in the field of being a supporter of a social and political movement that espouses global environmental protection, bioregionalism, social responsibility, and nonviolence.” In essence, the Examining Attorney has focused on one of many dictionary definitions for “green” and “ranking” individually, and then combined them into one definition. In doing so, the Examiner ignored eleven definitions of “green,” and six definitions of “ranking” from the definitions the Examiner supplied in the first and second office actions, not to mention the myriad possible combinations of the unitary term GREEN RANKINGS. See Definition of “green” from the June 24, 2009 Office Action Attachments 1-3, attached as *Exhibit 2*; Definition of “ranking” from the January 13, 2010 Office Action Attachments 42-43, attached as *Exhibit 3*. As discussed in more detail below, it is precisely these possible combinations that will cause consumers to consider or imagine the many “green” entities, things, or people that Applicant may be “ranking” or that are “ranking,” particularly in combination with the incongruous term “newsweek,” which also has no dictionary listing. A composite term requiring this kind of thought process is a suggestive term. See The Trademark Manual of Examining Procedure (“T.M.E.P.”) § 1209.01(a) (“Suggestive marks are those that, when applied to the goods or services at issue, require imagination, thought or perception to reach a conclusion as to the nature of those goods or services. Thus, a suggestive term differs from a descriptive term, which immediately tells something about the goods or services.”); *In re George Weston Limited*, 228 U.S.P.Q. 57, 58 (T.T.A.B. 1985) (finding SPEEDI BAKE for frozen dough

suggestive because it only vaguely suggests a desirable characteristic of frozen dough, namely, that it quickly and easily may be baked into bread). Accordingly, the Examining Attorney has improperly not considered the meaning of GREEN RANKINGS as a whole.

2. GREEN RANKINGS As a Whole Is Suggestive

The Examining Attorney argues that the subject application requires a disclaimer of GREEN RANKINGS because the wording is “descriptive of the subject matter of the goods and a feature of the identified services.” Wording is considered “merely descriptive” if it *immediately* conveys information concerning the function, characteristics, purpose or use of the products or services in connection with which it is used. See T.M.E.P. § 1209.01(a); *In re Application of Quick-Print Copy Shops, Inc.*, 616 F.2d 523, 525 (C.C.P.A. 1980) (“A mark is merely descriptive if it immediately conveys knowledge of the ingredients, qualities or characteristics of the goods or services....”); *In re The Stroh Brewery, Co.*, 34 U.S.P.Q.2d 1796, 1797 (T.T.A.B. 1994) (“As has been stated repeatedly, a term is merely descriptive if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods.”). Suggestive marks, on the other hand, are those that, when applied to the goods or services at issue, require imagination, thought, or perception to reach a conclusion as to the nature of those goods or services. T.M.E.P. § 1209.01(a); *In re George Weston Limited*, 228 U.S.P.Q. 57, 58 (T.T.A.B. 1985) (finding SPEEDI BAKE for frozen dough suggestive because it only vaguely suggests a desirable characteristic of frozen dough, namely, that it quickly and easily may be baked into bread). The Trademark Trial and Appeal Board (“Board”) has thus imposed a high standard for categorizing a mark as merely descriptive. Accordingly, the Examining Attorney has the burden of proof in establishing that a mark is merely descriptive and must make a substantial showing based on more than mere opinion. See *In re Kopy Kat, Inc.*, 182 U.S.P.Q. 372, 373 (C.C.P.A. 1971).

Applicant respectfully submits, however, that the Examining Attorney has not met its burden that the composite wording GREEN RANKINGS *as a whole* immediately conveys the characteristics and subject matter of Applicant’s goods and services. Applicant acknowledges and admits that “GREEN” does convey to consumers that the environment is somehow involved, and therefore GREEN has been disclaimed. But, Applicant notes that the word “ranking” is defined as:

1. having a high position;

2. of the highest rank <the ranking officer>; or

3. being next to the chairman in seniority. <ranking committee member>

See Definition of “ranking” from *Merriam Webster Online Dictionary*, attached as *Exhibit 4*. Under this definition, the word “RANKINGS” is completely arbitrary and vague and does not inform consumers at all about the criteria involved, the nature or characteristics about what is being measured, or who or what is being measured. Rather, all that is immediately conveyed by the wording GREEN RANKINGS is that the environment is somehow involved and that items of some sort, such as, companies, people, or consumer products, are being put in an order of status or position.

Moreover, as discussed above, it is well settled that in determining whether a term is descriptive it must be considered in its entirety and not separated into its component parts. See *Concurrent Technologies, Inc. v. Concurrent Technologies Corp.*, 12 U.S.P.Q.2d 1054, 1057 (T.T.A.B. 1989) (“We must consider the descriptiveness of the mark [] by looking at the mark as a whole”). Indeed, even when two descriptive words are combined into a unitary whole, an entirely different commercial impression is created. See *In re Matsushita Elec. Corp. of Am.*, 1998 WL 574336, at *3 (T.T.A.B. 1998) (“Whereas the individual words . . . each have descriptive significance, when the words are combined the significance of [the composite mark] is only suggestive.”). Similarly, even if “green” and “rankings” have some descriptive qualities, when considered together, GREEN RANKINGS does not immediately convey particular information about the characteristics of Applicant’s goods or services.

The reason that GREEN RANKINGS cannot be descriptive is because it is difficult to compare different industries, entities, or people regarding their environmental performance—there is no set standard that consumers can rely on to know what is being compared in a “green rankings.” Indeed, nothing in the wording GREEN RANKINGS informs consumers at all about who or what is being listed or measured, or how they are being measured. For example, GREEN RANKINGS could rate any number of entities: companies, consumer products, or people, such as politicians, celebrities, supporters, or corporate executives. Similarly, GREEN RANKINGS could refer to strong environmental performance, the environment’s worst offenders, or a random sample of entities based on type. Finally, there is no way to know how these entities are being measured, because there is no universally-accepted standard. Accordingly, significant thought on behalf of the relevant consumers is required to determine the

particular characteristics, purpose, and subject matter of the goods and services that are associated with the GREEN RANKINGS wording. This is the essence of a suggestive mark, not a descriptive mark. See T.M.E.P. § 1209.01(a) (“Suggestive marks are those that, when applied to the goods or services at issue, require imagination, thought or perception to reach a conclusion as to the nature of those goods or services. Thus, a suggestive term differs from a descriptive term, which immediately tells something about the goods or services.”).

The Examining Attorney’s own evidence demonstrates why the wording as a whole is suggestive. By the Examining Attorney’s own definition, Applicant’s GREEN RANKINGS should describe or consist of “a system of rating or record of performance in the field of being a supporter” of environmental issues. Of course, this ignores the many other possible meanings of “green” and “rankings” and “green rankings,” which does not have a dictionary listing. Moreover, the very marketplace evidence submitted by the Examining Attorney suggests that the subject matter of Applicant’s GREEN RANKINGS are the largest American companies regardless of whether they are a “supporter,” and does not rank them according to how much they “support” these issues. Of course, a supporter could be a person or a company. Accordingly, the many possible meanings for GREEN RANKINGS as a whole demonstrate that it cannot *immediately* convey particular information about the ingredients, qualities or characteristics of the Applicant’s goods or services. Rather, GREEN RANKINGS requires thought, imagination, and/or further research on behalf of the consumer to figure out what GREEN RANKINGS means. Again, such thought or imagination is the hallmark of a suggestive term.

This conclusion is further supported by an analogous case, where the Board dismissed a Section 2(e)(1) refusal to register the mark HEALTHY HOME VACUUM, finding the mark not merely descriptive of vacuum cleaners, and only required a disclaimer of “VACUUM.” The Board concluded that the mark “does not, in any clear or precise way, serve to immediately describe a particular characteristic or feature of the goods with any degree of particularity.” See *Oreck Holdings, LLC v. Bissell Homecare, Inc.*, Opposition No. 91173831 (T.T.A.B. Feb. 16, 2010). Similarly here, GREEN RANKINGS does not in any clear or precise way immediately describe a particular characteristic or feature of the goods or services with any degree of particularity. The mark does not immediately inform consumers as to what is being listed, what characteristics are being measured, or what is being featured. In *Oreck Holdings*,

consumers understood vacuums were involved, and therefore that term was disclaimed. Likewise, in the present application, consumers understand that the environment is involved and therefore GREEN is disclaimed, but the wording as a whole, "GREEN RANKINGS," is not merely descriptive.

Moreover, in its decision the Board recognized that HEALTHY HOME VACUUM, is typical of so many marks that consumers encounter in the marketplace: a highly suggestive mark that tells consumers something general about the product, without being specific or immediately telling consumers anything with a degree of particularity. The information given by the mark is indirect and vague. The mark here conjures up indirect mental associations in the consumer's mind; the thought process beginning with the mark HEALTHY HOME VACUUM and leading to a characteristic or feature of a vacuum cleaner is neither immediate nor direct

The mark HEALTHY HOME VACUUM does not serve to directly tell a consumer anything other than a vacuum cleaner is involved. The mark is an ephemeral concept and consumers are likely to have various ideas about how a vacuum cleaner results in a more environment-friendly home. That is, the mark conveys a nebulous and amorphous concept, almost like, as applicant contends, an aspirational goal.

Id. at 22-24.

Similarly here, the information given by the wording GREEN RANKINGS is indirect and vague. It conveys the idea of a list of things in relation to the environment, but does not serve to directly tell the consumer anything other than the environment is somehow involved. GREEN RANKINGS does not tell consumers what is being listed, what characteristics or features are being measured and whether they are positive or negative, or how or why. Consumers are likely to have various ideas about what is being listed and why. Thus, GREEN RANKINGS conveys a nebulous and amorphous concept that is suggestive and cannot be considered merely descriptive.

Additionally, in *Oreck Holdings*, the Board recognized that the third-party registrations submitted in support of a finding that HEALTHY HOME VACUUM was descriptive were part of the record, but such registrations were found to be of "very limited probative value," as the prior issuance of registrations for similar marks is not binding on the Board. *Id.* at 7. Here, the third-party registrations identified by the Examining Attorney are also of limited probative value because such registrations do not reflect or establish what consumers understand when viewing the subject mark "GREEN RANKINGS."

Accordingly, when GREEN RANKINGS is viewed as a whole it functions as a suggestive term for Applicant's goods and services, and Applicant respectfully requests that the refusal to register be withdrawn.

3. Any Doubt Must Be Resolved in Applicant's Favor

It is also well established that the Board has a policy of resolving doubts in the Applicant's favor in *ex parte* cases. See *In re Benthin Management*, 37 U.S.P.Q.2d 1332, 1334 (T.T.A.B. 1995) (merely a surname rejection); *In re Hines*, 32 U.S.P.Q.2d 1376, 1377 (T.T.A.B. 1994) (disparaging marks rejection); *In re In Over Our Heads, Inc.*, 16 U.S.P.Q.2d 1653, 1654-55 (T.T.A.B. 1990) (scandalous and disparaging marks rejection); *In re Gourmet Bakers, Inc.*, 173 U.S.P.Q. 565 (T.T.A.B. 1972) (descriptiveness rejection).

Indeed, the Federal Circuit has recognized and approved this practice. See *In re Maverty Media Group Ltd.*, 31 U.S.P.Q.2d 1923, 1928 (Fed. Cir. 1998). To uphold the Serial No. 77/729,594 refusal on the grounds of requiring a disclaimer would effectively resolve any doubt with respect to the registerability of NEWSWEEK GREEN RANKINGS against Applicant, contrary to the policy of the Board and contrary to the explicit guidelines set forth in *In re Merrill, Lynch, Pierce, Fenner, and Smith, Inc.*, 828 F.2d 1567, 1571 (Fed. Cir. 1987) ("It is incumbent on the Board to balance the evidence of public understanding of the mark against the degree of descriptiveness encumbering the mark and to resolve reasonable doubt in favor of the Applicant in accordance with practice and precedent."). Thus, the refusal to register Applicant's mark on the basis of requiring a disclaimer for descriptiveness should be withdrawn in accordance with PTO practice and precedent.

III. CONCLUSION

In view of the foregoing, Applicant respectfully requests that the refusal to register on the ground of requiring a disclaimer be withdrawn and the application be forwarded to publication. Prompt and favorable action is respectfully requested.

Respectfully Submitted,

EVIDENCE SECTION

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DESCRIPTION OF EVIDENCE FILE	Exhibit 1 (Definition of "green rankings" from Merriam-Webster Online Dictionary), Exhibit 2 (Definition of "green" from the June 24, 2009 Office Action Attachments 1-3), Exhibit 3 (Definition of "ranking" from the January 13, 2010 Office Action Attachments 42-43), and Exhibit 4 (Definition of "ranking" from Merriam-Webster Online Dictionary).
SIGNATURE SECTION	
RESPONSE SIGNATURE	/Scott T. Harlan/
SIGNATORY'S NAME	Scott T. Harlan
SIGNATORY'S POSITION	Attorney of record, District of Columbia bar member
DATE SIGNED	02/10/2011
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
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**Request for Reconsideration after Final Action
To the Commissioner for Trademarks:**

Application serial no. **77729594** has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

Applicant submits the following remarks in response to the Final Office Action mailed on August 10, 2010.

REMARKS

Applicant respectfully requests that the Examining Attorney reconsider her refusal to register the mark NEWSWEEK GREEN RANKINGS as a trademark for Applicant's various goods and services.

I. Introduction

The Examining Attorney has refused registration of the subject mark NEWSWEEK GREEN RANKINGS under Section 6(a) of the Trademark Act on the basis that a disclaimer is required for the wording GREEN RANKINGS because it is descriptive of the subject matter of the goods and a feature of the identified services. Applicant respectfully disagrees that the wording GREEN RANKINGS is descriptive. First, it appears that the Examining Attorney has improperly dissected the terms GREEN and RANKINGS from the GREEN RANKINGS term in its analysis. Moreover, Applicant submits that GREEN RANKINGS is suggestive and does not immediately or directly convey anything about the products to the consumer.

II. Argument

1. GREEN RANKINGS Must be Considered as a Whole

It is certainly appropriate for the Examining Attorney to discuss the implications of each part of a compound mark. However, it has long been accepted that the final determination of descriptiveness must be based on consideration of the mark as a whole. *See Concurrent Technologies, Inc. v. Concurrent Technologies Corp.*, 12 U.S.P.Q.2d 1054, 1057 (T.T.A.B. 1989) (finding CONCURRENT TECHNOLOGIES CORPORATION to be suggestive and stating "we must consider the descriptiveness of the mark [] by looking at the mark as a whole.").

In requiring the disclaimer of GREEN RANKINGS, the Examiner appears to have improperly dissected and considered a single separate meaning each for the terms "green" and "ranking," and then combined them into one arbitrary definition for "green rankings," which does not have a dictionary listing. *See* Definition of "green rankings" from *Merriam-Webster Online Dictionary*, attached as *Exhibit 1*. Specifically, the Examining Attorney argues that "green rankings" means "a listing of items in a group according to a system of rating or record of performance in the field of being a supporter of a social and political movement that espouses global environmental protection, bioregionalism, social responsibility,

and nonviolence.” In essence, the Examining Attorney has focused on one of many dictionary definitions for “green” and “ranking” individually, and then combined them into one definition. In doing so, the Examiner ignored eleven definitions of “green,” and six definitions of “ranking” from the definitions the Examiner supplied in the first and second office actions, not to mention the myriad possible combinations of the unitary term GREEN RANKINGS. See Definition of “green” from the June 24, 2009 Office Action Attachments 1-3, attached as *Exhibit 2*; Definition of “ranking” from the January 13, 2010 Office Action Attachments 42-43, attached as *Exhibit 3*. As discussed in more detail below, it is precisely these possible combinations that will cause consumers to consider or imagine the many “green” entities, things, or people that Applicant may be “ranking” or that are “ranking,” particularly in combination with the incongruous term “newsweek,” which also has no dictionary listing. A composite term requiring this kind of thought process is a suggestive term. See The Trademark Manual of Examining Procedure (“T.M.E.P.”) § 1209.01(a) (“Suggestive marks are those that, when applied to the goods or services at issue, require imagination, thought or perception to reach a conclusion as to the nature of those goods or services. Thus, a suggestive term differs from a descriptive term, which immediately tells something about the goods or services.”); *In re George Weston Limited*, 228 U.S.P.Q. 57, 58 (T.T.A.B. 1985) (finding SPEEDI BAKE for frozen dough suggestive because it only vaguely suggests a desirable characteristic of frozen dough, namely, that it quickly and easily may be baked into bread). Accordingly, the Examining Attorney has improperly not considered the meaning of GREEN RANKINGS as a whole.

2. GREEN RANKINGS As a Whole Is Suggestive

The Examining Attorney argues that the subject application requires a disclaimer of GREEN RANKINGS because the wording is “descriptive of the subject matter of the goods and a feature of the identified services.” Wording is considered “merely descriptive” if it *immediately* conveys information concerning the function, characteristics, purpose or use of the products or services in connection with which it is used.

See T.M.E.P. § 1209.01(a); *In re Application of Quick-Print Copy Shops, Inc.*, 616 F.2d 523, 525 (C.C.P.A. 1980) (“A mark is merely descriptive if it immediately conveys knowledge of the ingredients, qualities or characteristics of the goods or services....”); *In re The Stroh Brewery, Co.*, 34 U.S.P.Q.2d 1796, 1797 (T.T.A.B. 1994) (“As has been stated repeatedly, a term is merely descriptive if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods.”). Suggestive

marks, on the other hand, are those that, when applied to the goods or services at issue, require imagination, thought, or perception to reach a conclusion as to the nature of those goods or services. T.M.E.P. § 1209.01(a); *In re George Weston Limited*, 228 U.S.P.Q. 57, 58 (T.T.A.B. 1985) (finding SPEEDI BAKE for frozen dough suggestive because it only vaguely suggests a desirable characteristic of frozen dough, namely, that it quickly and easily may be baked into bread). The Trademark Trial and Appeal Board (“Board”) has thus imposed a high standard for categorizing a mark as merely descriptive. Accordingly, the Examining Attorney has the burden of proof in establishing that a mark is merely descriptive and must make a substantial showing based on more than mere opinion. *See In re Kopy Kat, Inc.*, 182 U.S.P.Q. 372, 373 (C.C.PA 1971).

Applicant respectfully submits, however, that the Examining Attorney has not met its burden that the composite wording GREEN RANKINGS *as a whole* immediately conveys the characteristics and subject matter of Applicant’s goods and services. Applicant acknowledges and admits that “GREEN” does convey to consumers that the environment is somehow involved, and therefore GREEN has been disclaimed. But, Applicant notes that the word “ranking” is defined as:

1. having a high position;
2. of the highest rank <the ranking officer>; or
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See Definition of “ranking” from *Merriam Webster Online Dictionary*, attached as *Exhibit 4*. Under this definition, the word “RANKINGS” is completely arbitrary and vague and does not inform consumers at all about the criteria involved, the nature or characteristics about what is being measured, or who or what is being measured. Rather, all that is immediately conveyed by the wording GREEN RANKINGS is that the environment is somehow involved and that items of some sort, such as, companies, people, or consumer products, are being put in an order of status or position.

Moreover, as discussed above, it is well settled that in determining whether a term is descriptive it must be considered in its entirety and not separated into its component parts. *See Concurrent Technologies, Inc. v. Concurrent Technologies Corp.*, 12 U.S.P.Q.2d 1054, 1057 (T.T.A.B. 1989) (“We must consider the descriptiveness of the mark [] by looking at the mark as a whole”). Indeed, even when two descriptive words are combined into a unitary whole, an entirely different commercial impression is created. *See In*

re Matsushita Elec. Corp. of Am., 1998 WL 574336, at *3 (T.T.A.B. 1998) (“Whereas the individual words . . . each have descriptive significance, when the words are combined the significance of [the composite mark] is only suggestive.”). Similarly, even if “green” and “rankings” have some descriptive qualities, when considered together, GREEN RANKINGS does not immediately convey particular information about the characteristics of Applicant’s goods or services.

The reason that GREEN RANKINGS cannot be descriptive is because it is difficult to compare different industries, entities, or people regarding their environmental performance—there is no set standard that consumers can rely on to know what is being compared in a “green rankings.” Indeed, nothing in the wording GREEN RANKINGS informs consumers at all about who or what is being listed or measured, or how they are being measured. For example, GREEN RANKINGS could rate any number of entities: companies, consumer products, or people, such as politicians, celebrities, supporters, or corporate executives. Similarly, GREEN RANKINGS could refer to strong environmental performance, the environment’s worst offenders, or a random sample of entities based on type. Finally, there is no way to know how these entities are being measured, because there is no universally-accepted standard. Accordingly, significant thought on behalf of the relevant consumers is required to determine the particular characteristics, purpose, and subject matter of the goods and services that are associated with the GREEN RANKINGS wording. This is the essence of a suggestive mark, not a descriptive mark. *See* T.M.E.P. § 1209.01(a) (“Suggestive marks are those that, when applied to the goods or services at issue, require imagination, thought or perception to reach a conclusion as to the nature of those goods or services. Thus, a suggestive term differs from a descriptive term, which immediately tells something about the goods or services.”).

The Examining Attorney’s own evidence demonstrates why the wording as a whole is suggestive. By the Examining Attorney’s own definition, Applicant’s GREEN RANKINGS should describe or consist of “a system of rating or record of performance in the field of being a supporter” of environmental issues. Of course, this ignores the many other possible meanings of “green” and “rankings” and “green rankings,” which does not have a dictionary listing. Moreover, the very marketplace evidence submitted by the Examining Attorney suggests that the subject matter of Applicant’s GREEN RANKINGS are the largest American companies regardless of whether they are a “supporter,” and does not rank them according to

how much they “support” these issues. Of course, a supporter could be a person or a company. Accordingly, the many possible meanings for GREEN RANKINGS as a whole demonstrate that it cannot *immediately* convey particular information about the ingredients, qualities or characteristics of the Applicant’s goods or services. Rather, GREEN RANKINGS requires thought, imagination, and/or further research on behalf of the consumer to figure out what GREEN RANKINGS means. Again, such thought or imagination is the hallmark of a suggestive term.

This conclusion is further supported by an analogous case, where the Board dismissed a Section 2(e)(1) refusal to register the mark HEALTHY HOME VACUUM, finding the mark not merely descriptive of vacuum cleaners, and only required a disclaimer of “VACUUM.” The Board concluded that the mark “does not, in any clear or precise way, serve to immediately describe a particular characteristic or feature of the goods with any degree of particularity.” *See Oreck Holdings, LLC v. Bissell Homecare, Inc.*, Opposition No. 91173831 (T.T.A.B. Feb. 16, 2010). Similarly here, GREEN RANKINGS does not in any clear or precise way immediately describe a particular characteristic or feature of the goods or services with any degree of particularity. The mark does not immediately inform consumers as to what is being listed, what characteristics are being measured, or what is being featured. In *Oreck Holdings*, consumers understood vacuums were involved, and therefore that term was disclaimed. Likewise, in the present application, consumers understand that the environment is involved and therefore GREEN is disclaimed, but the wording as a whole, “GREEN RANKINGS,” is not merely descriptive.

Moreover, in its decision the Board recognized that HEALTHY HOME VACUUM, is typical of so many marks that consumers encounter in the marketplace: a highly suggestive mark that tells consumers something general about the product, without being specific or immediately telling consumers anything with a degree of particularity. The information given by the mark is indirect and vague. The mark here conjures up indirect mental associations in the consumer’s mind; the thought process beginning with the mark HEALTHY HOME VACUUM and leading to a characteristic or feature of a vacuum cleaner is neither immediate nor direct

The mark HEALTHY HOME VACUUM does not serve to directly tell a consumer anything other than a vacuum cleaner is involved. The mark is an ephemeral concept and consumers are likely to have various ideas about how a vacuum cleaner results in a more environment-friendly home. That is, the mark conveys a nebulous and amorphous concept, almost like, as applicant contends, an aspirational goal.

Id. at 22-24.

Similarly here, the information given by the wording GREEN RANKINGS is indirect and vague. It conveys the idea of a list of things in relation to the environment, but does not serve to directly tell the consumer anything other than the environment is somehow involved. GREEN RANKINGS does not tell consumers what is being listed, what characteristics or features are being measured and whether they are positive or negative, or how or why. Consumers are likely to have various ideas about what is being listed and why. Thus, GREEN RANKINGS conveys a nebulous and amorphous concept that is suggestive and cannot be considered merely descriptive.

Additionally, in *Oreck Holdings*, the Board recognized that the third-party registrations submitted in support of a finding that HEALTHY HOME VACUUM was descriptive were part of the record, but such registrations were found to be of "very limited probative value," as the prior issuance of registrations for similar marks is not binding on the Board. *Id.* at 7. Here, the third-party registrations identified by the Examining Attorney are also of limited probative value because such registrations do not reflect or establish what consumers understand when viewing the subject mark "GREEN RANKINGS."

Accordingly, when GREEN RANKINGS is viewed as a whole it functions as a suggestive term for Applicant's goods and services, and Applicant respectfully requests that the refusal to register be withdrawn.

3. Any Doubt Must Be Resolved in Applicant's Favor

It is also well established that the Board has a policy of resolving doubts in the Applicant's favor in *ex parte* cases. See *In re Benthin Management*, 37 U.S.P.Q.2d 1332, 1334 (T.T.A.B. 1995) (merely a surname rejection); *In re Hines*, 32 U.S.P.Q.2d 1376, 1377 (T.T.A.B. 1994) (disparaging marks rejection); *In re In Over Our Heads, Inc.*, 16 U.S.P.Q.2d 1653, 1654-55 (T.T.A.B. 1990) (scandalous and disparaging marks rejection); *In re Gourmet Bakers, Inc.*, 173 U.S.P.Q. 565 (T.T.A.B. 1972) (descriptiveness rejection).

Indeed, the Federal Circuit has recognized and approved this practice. See *In re Maverty Media Group Ltd.*, 31 U.S.P.Q.2d 1923, 1928 (Fed. Cir. 1998). To uphold the Serial No. 77/729,594 refusal on the grounds of requiring a disclaimer would effectively resolve any doubt with respect to the registerability of NEWSWEEK GREEN RANKINGS against Applicant, contrary to the policy of the Board and contrary to

the explicit guidelines set forth in *In re Merrill, Lynch, Pierce, Fenner, and Smith, Inc.*, 828 F.2d 1567, 1571 (Fed. Cir. 1987) (“It is incumbent on the Board to balance the evidence of public understanding of the mark against the degree of descriptiveness encumbering the mark and to resolve reasonable doubt in favor of the Applicant in accordance with practice and precedent.”). Thus, the refusal to register Applicant’s mark on the basis of requiring a disclaimer for descriptiveness should be withdrawn in accordance with PTO practice and precedent.

III. CONCLUSION

In view of the foregoing, Applicant respectfully requests that the refusal to register on the ground of requiring a disclaimer be withdrawn and the application be forwarded to publication. Prompt and favorable action is respectfully requested.

Respectfully Submitted,

EVIDENCE

Evidence in the nature of Exhibit 1 (Definition of "green rankings" from Merriam-Webster Online Dictionary), Exhibit 2 (Definition of "green" from the June 24, 2009 Office Action Attachments 1-3), Exhibit 3 (Definition of "ranking" from the January 13, 2010 Office Action Attachments 42-43), and Exhibit 4 (Definition of "ranking" from Merriam-Webster Online Dictionary). has been attached.

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Evidence-1

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Evidence-4

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Evidence-1

Evidence-2

Evidence-3

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Scott T. Harlan/ Date: 02/10/2011

Signatory's Name: Scott T. Harlan

Signatory's Position: Attorney of record, District of Columbia bar member

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 77729594

Internet Transmission Date: Thu Feb 10 16:38:49 EST 2011

TEAS Stamp: USPTO/RFR-63.88.112.229-2011021016384913

9725-77729594-480ca232462dd68acda573bf63

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EXHIBIT 1

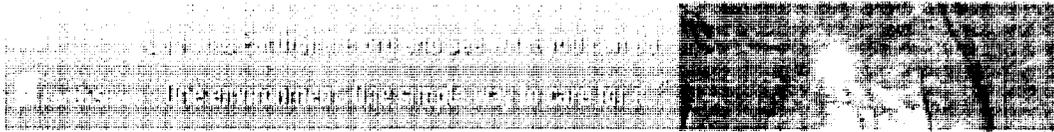
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green rankings

green rankings

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green (grĕn)

Word of the Day

ensender
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- NOUN:**
- The hue of that portion of the visible spectrum lying between yellow and blue, evoked in the human observer by radiant energy with wavelengths of approximately 490 to 570 nanometers; any of a group of colors that may vary in lightness and saturation and whose hue is that of the emerald or somewhat less yellow than that of growing grass, one of the additive or light primaries, one of the psychological primary hues.
 - Something green in color.
 - greens** Green growth or foliage, especially:
 - The branches and leaves of plants used for decoration.
 - Leafy plants or plant parts eaten as vegetables.
 - A grassy lawn or plot, especially:
 - A grassy area located usually at the center of a city.

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Other

- or town and set aside for common use, a common
- b. *Sports* A putting green.
- 5. **greens** A green uniform. "a young . . . sergeant in dress greens" (Nelson DeMille).
- 6. *Slang* Money
- 7. **Green** A supporter of a social and political movement that espouses global environmental protection, bioregionalism, social responsibility, and nonviolence.



ADJECTIVE:
green-er, green-est

1. Of the color green.
2. Abounding in or covered with green growth or foliage: *the green woods.*
3. Made with green or leafy vegetables: *a green salad.*
4. Characterized by mild or temperate weather: *a green climate.*
5. Youthful, vigorous: *at the green age of 18.*
6. Not mature or ripe, young: *green tomatoes.*
7. Brand-new, fresh.
8. Not yet fully processed, especially:
 - a. Not aged: *green wood.*
 - b. Not cured or tanned: *green pelts.*
9. Lacking training or experience. See Synonyms at *young*.
10.
 - a. Lacking sophistication or worldly experience; naive.
 - b. Easily duped or deceived; gullible.
11. Having a sickly or unreal pallor indicative of nausea or jealousy, for example.
12.
 - a. Beneficial to the environment: *green recycling policies.*
 - b. Favoring or supporting environmentalism: *green legislators who strengthened pollution controls.*

tr. & Intr.v.
greened, green-ing, greens

To make or become green

IDIOM:
green around/about the gills

Pale or sickly in appearance

ETYMOLOGY:

Middle English grene, from Old English grēne, see grē- in Indo-European roots N, sense 7 translation of German (die) Grunen, (*the*) *Greens*, from grun, *green*

OTHER FORMS:

greenly (*Adverb*), **green'ness** (*Noun*)

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Nearby Words

- ranine artery
- ranitidine
- ranjit singh
- rank
- rank (out)
- rank amateur
- rank and file

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rank-ing ˈræŋk-ɪŋ *n* **?** Show IPA

-adjective

1. senior or superior in rank, position, etc.: *a ranking diplomat.*
2. prominent or highly regarded: *a ranking authority on Soviet affairs.*
3. occupying a specific rank, position, etc. (often used in combination): *a low-ranking executive.*

-noun

4. an act or instance of indicating relative standing.
5. a list showing such standing.

Origin:
1860-65; RANK 1 + -ING 1, -ING 1

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- » elaborate
- » diacritic
- » syllable

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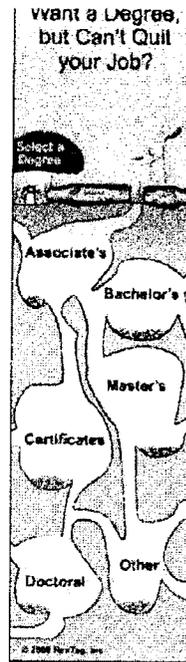
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rank·ing ^{ˈræŋkɪŋ} *n.*
adj. Of the highest rank; prominent.

- n.
- 1. **rankings** A listing of items in a group, such as schools or sports teams, according to a system of rating or a record of performance.
- 2. A position in such a list.

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- ranking jumper

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rank·ing *adj* \ˈrɑŋ-kiŋ\

Definition of RANKING

- : having a high position: as
- a** : of the highest rank <the *ranking* officer>
- b** : being next to the chairman in seniority <*ranking* committee member>
- See ranking defined for English-language learners »

Examples of RANKING

- Who is the *ranking* officer here?
- the country's *ranking* law school

First Known Use of RANKING

1847

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- Previous Word in the Dictionary: Rankine
- All Words Near: ranking

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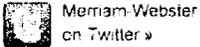


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