

PTO Form 1857 (Rev 9/2005)

OMB No. 0651-0050 (Exp. 04/2009)

## Response to Office Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	78761852
LAW OFFICE ASSIGNED	LAW OFFICE 109
MARK SECTION (no change)	
ARGUMENT(S)	
<p style="text-align: center;"><u>RESPONSE TO OFFICE ACTION</u></p> <p>This communication is in response to the Final Office Action mailed <b>December 5, 2006</b>, whereby the Examining Attorney set forth the following:</p> <p>Registration on the Principal Register is refused on the grounds that <b>"SUGAR PLUM"</b> is descriptive of the featured scent and/or color of the goods.</p> <p style="text-align: center;"><u>REMARKS</u></p> <p>Applicant hereby incorporates all arguments presented in the previous Response to Office Action and respectfully requests reconsideration of the final refusal to register.</p> <p><b><u>The term "SUGAR PLUM" is not descriptive of either a scent or color of skin care products, it is merely suggestive.</u></b></p> <p>The Examining Attorney has made final the refusal to registration because she believes the term <b>"SUGAR PLUM"</b> is descriptive of a scent or color of skin care products. The Examining Attorney has submitted evidence that purports to support her position. Applicant respectfully disagrees that the term <b>"SUGARPLUM"</b> is descriptive of Applicant's goods and disagrees that the "evidence" submitted by the Examining Attorney supports the position that it is.</p> <p>The evidence provided by the Examining Attorney shows merely that several other</p>	

companies have used the term "Sugar Plum" in a suggestive trademark sense to elicit a feeling about their goods or allude to a quality of their product. In most cases the term "Sugar Plum" is printed in all capitals or title case as is traditional in indicating a trademark. The term appears on the packaging itself or as a banner on the webpage advertising the product as is traditional in indicating a trademark. Such usage as a trademark does *not* support the position that the term is merely a descriptive word and not a trademark.

Examples of suggestive usage of the term "SUGAR PLUM" in title case as is traditional for trademark usage are: Sugar Plum – Vegan Whipped Body Frosting (Examining Attorney Attachment 2), Luster Skin Boutique SugarPlum Revitalizing Masque (Examining Attorney Attachment 4), Eminence Organic Skincare Sugarplum Souflee Massage Cream (Examining Attorney Attachment 5), Eminence Organic Sugarplum Whip Moisturizer (Examining Attorney Attachment 6), and Bath and Body Works Sugar Plum Splash Set (Examining Attorney Attachment 7 and 10).

Much of the "evidence" offered by the Examining Attorney shows use of the term "SUGAR PLUM" by cosmetics companies to describe shades of lip gloss or eye shadow. It is well known in the commercial marketplace that cosmetics companies use suggestive terms (not descriptive terms) to suggest the attributes of their products. For example, Maybelline Moisture Extreme Lip Cover Sugar Plum Ice (Examining Attorney Attachment 10) is meant to suggest that the lip product is sweet ("Sugar") and cool ("Ice") on the lips and that the color is somewhat purple ("Plum"). It is not actually true that the product is sweet or cool or necessarily purple (as defined by a Pantone chart). Thus, these terms are not descriptive, but rather suggestive of the characteristics Maybelline thinks its customers want in a lip product.

The same use of "SUGAR PLUM" as a suggestive term is made by Mary Kay Signature Eye Color Sugarplum (Examining Attorney Attachment 3). Sugar Plum has also been used to suggest the scent of a product, for example, fragrance oils (Examining Attorney Attachment 9) which come in such versions as Gingerbread Man, Christmas Splendor and Sugar Plum, none of which are known scents. Clearly these terms do not actually describe the scent of the oils, but are meant to elicit the feeling of the holidays in potential consumers. Thus, they are suggestive, not descriptive. The three products described in Examining Attorney Attachments 12, 13, and 14 are similarly suggestive uses of the term "SUGAR PLUM" by cosmetics companies to elicit a feeling about the characteristics or effect of their cosmetic.

In summary, the Examining Attorney has presented no evidence that the term **SUGAR PLUM** describes a particular color or a particular scent. Applicant maintains that the term **SUGAR PLUM** describes a candy with no particular color or describable scent and that the term is used

suggestively in the cosmetics and other industries to elicit the sweet, fun, holiday feeling that a SUGAR PLUM candy suggests.

**CONCLUSION**

In view of the foregoing remarks, it is believe this Application is in condition for prompt publication. Favorable action is therefore requested.

**SIGNATURE SECTION**

RESPONSE SIGNATURE	/KABM/
SIGNATORY'S NAME	Kiley B. MacDonald, Esq.
SIGNATORY'S POSITION	The Trademark Group, APLC, Attorneys for Applicant
DATE SIGNED	03/05/2007
AUTHORIZED SIGNATORY	YES

**FILING INFORMATION SECTION**

SUBMIT DATE	Mon Mar 05 20:02:57 EST 2007
TEAS STAMP	USPTO/ROA-75.11.54.41-200 70305200257298291-7876185 2-37060bc80f3b98ac1b62c33 53fdb1957479-N/A-N/A-2007 0305195835365943

PTO Form 1957 (Rev 9/2005)

OMB No. 0651-0050 (Exp. 04/2009)

**Response to Office Action**

**To the Commissioner for Trademarks:**

Application serial no. **78761852** has been amended as follows:

**Argument(s)**

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

RESPONSE TO OFFICE ACTION

This communication is in response to the Final Office Action mailed **December 5, 2006**, whereby the Examining Attorney set forth the following:

Registration on the Principal Register is refused on the grounds that “SUGAR PLUM” is descriptive of the featured scent and/or color of the goods.

#### REMARKS

Applicant hereby incorporates all arguments presented in the previous Response to Office Action and respectfully requests reconsideration of the final refusal to register.

**The term “SUGAR PLUM” is not descriptive of either a scent or color of skin care products, it is merely suggestive.**

The Examining Attorney has made final the refusal to registration because she believes the term “SUGAR PLUM” is descriptive of a scent or color of skin care products. The Examining Attorney has submitted evidence that purports to support her position. Applicant respectfully disagrees that the term “SUGARPLUM” is descriptive of Applicant’s goods and disagrees that the “evidence” submitted by the Examining Attorney supports the position that it is.

The evidence provided by the Examining Attorney shows merely that several other companies have used the term “Sugar Plum” in a suggestive trademark sense to elicit a feeling about their goods or allude to a quality of their product. In most cases the term “Sugar Plum” is printed in all capitals or title case as is traditional in indicating a trademark. The term appears on the packaging itself or as a banner on the webpage advertising the product as is traditional in indicating a trademark. Such usage as a trademark does *not* support the position that the term is merely a descriptive word and not a trademark.

Examples of suggestive usage of the term “SUGAR PLUM” in title case as is traditional for trademark usage are: Sugar Plum – Vegan Whipped Body Frosting (Examining Attorney Attachment 2), Luster Skin Boutique SugarPlum Revitalizing Masque (Examining Attorney Attachment 4), Eminence Organic Skincare Sugarplum Souflee Massage Cream (Examining Attorney Attachment 5), Eminence Organic Sugarplum Whip Moisturizer (Examining Attorney Attachment 6), and Bath and Body Works Sugar Plum Splash Set (Examining Attorney Attachment 7 and 10).

Much of the “evidence” offered by the Examining Attorney shows use of the term “SUGAR PLUM” by cosmetics companies to describe shades of lip gloss or eye shadow. It is well known in the commercial marketplace that cosmetics companies use suggestive terms (not descriptive

terms) to suggest the attributes of their products. For example, Maybelline Moisture Extreme Lip Cover Sugar Plum Ice (Examining Attorney Attachment 10) is meant to suggest that the lip product is sweet ("Sugar") and cool ("Ice") on the lips and that the color is somewhat purple ("Plum"). It is not actually true that the product is sweet or cool or necessarily purple (as defined by a Pantone chart). Thus, these terms are not descriptive, but rather suggestive of the characteristics Maybelline thinks its customers want in a lip product.

The same use of "SUGAR PLUM" as a suggestive term is made by Mary Kay Signature Eye Color Sugarplum (Examining Attorney Attachment 3). Sugar Plum has also been used to suggest the scent of a product, for example, fragrance oils (Examining Attorney Attachment 9) which come in such versions as Gingerbread Man, Christmas Splendor and Sugar Plum, none of which are known scents. Clearly these terms do not actually describe the scent of the oils, but are meant to elicit the feeling of the holidays in potential consumers. Thus, they are suggestive, not descriptive. The three products described in Examining Attorney Attachments 12, 13, and 14 are similarly suggestive uses of the term "SUGAR PLUM" by cosmetics companies to elicit a feeling about the characteristics or effect of their cosmetic.

In summary, the Examining Attorney has presented no evidence that the term **SUGAR PLUM** describes a particular color or a particular scent. Applicant maintains that the term **SUGAR PLUM** describes a candy with no particular color or describable scent and that the term is used suggestively in the cosmetics and other industries to elicit the sweet, fun, holiday feeling that a **SUGAR PLUM** candy suggests.

### CONCLUSION

In view of the foregoing remarks, it is believe this Application is in condition for prompt publication. Favorable action is therefore requested.

#### **Response Signature**

Signature: /KABM/ Date: 03/05/2007

Signatory's Name: Kiley B. MacDonald, Esq.

Signatory's Position: The Trademark Group, APLC, Attorneys for Applicant

The signatory has confirmed that he/she is either (1) an attorney who is a member in good standing of the bar of the highest court of a U.S. state; or (2) a Canadian attorney/agent who has been granted reciprocal recognition under 37 C.F.R. §10.14(c) by the USPTO's Office of Enrollment and Discipline. He/she further confirms that (1) the applicant has not previously been represented in this matter by an

authorized attorney; and (2) he/she is the applicant's attorney or an associate of that attorney.

Serial Number: 78761852

Internet Transmission Date: Mon Mar 05 20:02:57 EST 2007

TEAS Stamp: USPTO/ROA-75.11.54.41-200703052002572982

91-78761852-37060bc80f3b98ac1b62c3353fdb

1957479-N/A-N/A-20070305195835365943