

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85681674
LAW OFFICE ASSIGNED	LAW OFFICE 107
MARK SECTION (no change)	
ARGUMENT(S)	
Please see the actual argument text attached within the Evidence section.	
EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_20657114162-165309041 . CANDY BAR PIE 2 e 1 Request for Information.pdf
CONVERTED PDF FILE(S) (6 pages)	\\TICRS\EXPORT16\IMAGEOUT16\856\816\85681674\xml7\RFR0002.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\856\816\85681674\xml7\RFR0003.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\856\816\85681674\xml7\RFR0004.JPG
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	\\TICRS\EXPORT16\IMAGEOUT16\856\816\85681674\xml7\RFR0007.JPG
DESCRIPTION OF EVIDENCE FILE	Arguments against the refusal to register applicant's mark under Section 2(e)(1) of the Lanham Act.
ADDITIONAL STATEMENTS SECTION	
DISCLAIMER	No claim is made to the exclusive right to use CANDY BAR apart from the mark as shown.
MISCELLANEOUS STATEMENT	In the Final Office Action issued on June 12, 2013, the Examining Attorney requested additional information regarding applicant's goods and services. Attached are applicant's answers to the questions asked and a screenshot of applicant's website which provides additional information about the goods.
MISCELLANEOUS FILE NAME(S)	

ORIGINAL PDF FILE	mis-20657114162-165309041_.CANDY_BAR_PIE_Miscellaneous.pdf
CONVERTED PDF FILE(S) (2 pages)	\\TICRS\EXPORT16\IMAGEOUT16\856\816\85681674\xml7\RFR0008.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\856\816\85681674\xml7\RFR0009.JPG
SIGNATURE SECTION	
RESPONSE SIGNATURE	/mjb/
SIGNATORY'S NAME	Michael J. Bales
SIGNATORY'S POSITION	Attorney of record, New York bar member
SIGNATORY'S PHONE NUMBER	212-626-4810
DATE SIGNED	12/12/2013
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Thu Dec 12 17:13:22 EST 2013
TEAS STAMP	USPTO/RFR-206.57.114.162- 20131212171322071514-8568 1674-500969ffcfe1adc12f0f 3627b227d1213846b5398c9b7 515a7e87bb3620641458-N/A- N/A-20131212165309041566

**Request for Reconsideration after Final Action
To the Commissioner for Trademarks:**

Application serial no. **85681674** has been amended as follows:

ARGUMENT(S)

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

Please see the actual argument text attached within the Evidence section.

EVIDENCE

Evidence in the nature of Arguments against the refusal to register applicant's mark under Section 2(e)(1) of the Lanham Act. has been attached.

Original PDF file:

[evi_20657114162-165309041_.CANDY_BAR_PIE_2_e_1_Request_for_Information.pdf](#)

Converted PDF file(s) (6 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

[Evidence-5](#)

[Evidence-6](#)

ADDITIONAL STATEMENTS

Disclaimer

No claim is made to the exclusive right to use CANDY BAR apart from the mark as shown.

Miscellaneous Statement

In the Final Office Action issued on June 12, 2013, the Examining Attorney requested additional information regarding applicant's goods and services. Attached are applicant's answers to the questions asked and a screenshot of applicant's website which provides additional information about the goods.

Original PDF file:

[mis-20657114162-165309041_.CANDY_BAR_PIE_Miscellaneous.pdf](#)

Converted PDF file(s) (2 pages)

[Miscellaneous File1](#)

[Miscellaneous File2](#)

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /mjb/ Date: 12/12/2013

Signatory's Name: Michael J. Bales

Signatory's Position: Attorney of record, New York bar member

Signatory's Phone Number: 212-626-4810

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: 85681674

Internet Transmission Date: Thu Dec 12 17:13:22 EST 2013

TEAS Stamp: USPTO/RFR-206.57.114.162-201312121713220

71514-85681674-500969ffcfe1adc12f0f3627b

227d1213846b5398c9b7515a7e87bb3620641458

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I. INTRODUCTION

In a Final Office Action dated June 12, 2013, the Examining Attorney refused registration of Ben & Jerry's Homemade, Inc.'s ("Applicant's") **CANDY BAR PIE** mark (App. No. 85681674) for "[i]ce cream; frozen confectionery" in Class 30 ("Applicant's Mark") under Section 2(e)(1) of the Lanham Act, 15 U.S.C. § 1052(e)(1), on the basis that Applicant's Mark merely describes an ingredient of Applicant's goods. The Examining Attorney also cited as grounds for refusal that fact that Applicant failed to respond to a request for information made in the Office Action issued on November 17, 2012.

While Applicant is submitting a disclaimer of the term "CANDY BAR" in its response, Applicant respectfully submits that the term "PIE" in Applicant's Mark is not merely descriptive of the goods covered in the instant application, and additionally provides answers to the Examining Attorney's requests for additional information. Thus, for the reasons set forth below, Applicant respectfully requests that the Examining Attorney accept Applicant's response to these issues and withdraw her claim that the term "PIE" is merely descriptive of Applicant's ice cream and frozen confectionery products and approve the instant application for publication.

II. THE TERM "PIE" IN APPLICANT'S MARK IS NOT MERELY DESCRIPTIVE

A. The Term "PIE" in Applicant's Mark Is Suggestive

In categorizing a trademark, it is not sufficient to ask whether a term or phrase is descriptive. The statutory test, set out in 15 U.S.C. § 1052(e)(1), is whether the mark or term at issue is merely descriptive. In this context, the term "merely" is to be taken in its ordinary meaning of 'only' or 'solely' -- that is, when considered with the particular goods or services the mark because of its meaning does nothing but describe them. *See* Trademark Manual of Examining Procedure ("T.M.E.P.") at § 1209.01. Additionally, the "word 'merely' in the Act means that if the mark clearly does not tell the potential customer only what the goods are, their function, characteristics, use or ingredients, then the mark [or term] is not 'merely

descriptive.'" See MCCARTHY, TRADEMARKS AND UNFAIR COMPETITION (4th ed. 2010) § 11.51 (hereinafter "MCCARTHY'S"); *In re Colonial Stores Inc.*, 394 F.2d 549 (C.C.P.A. 1968); and *In re Quik-Print Copy Shops, Inc.*, 616 F.2d 523, 205 U.S.P.Q. 505, n.7 (C.C.P.A. 1980). Terms which may describe the ingredients of the goods, their characteristics, or their function are nonetheless entitled to registration. See *In re Colonial Stores Inc.*, 394 F.2d 549 (C.C.P.A. 1968); *In re DC Comics, Inc.*, 689 F.2d 1042, 1044 (C.C.P.A. 1982); *In re Reynolds Metals Co.*, 480 F.2d 902 (C.C.P.A. 1973).

A term is merely descriptive only if it immediately conveys an idea of the ingredients, qualities or characteristics of the goods. *Equine Technologies, Inc. v. Equitechnology, Inc.*, 68 F.3d 542, 544 (Fed. Cir. 1995). A suggestive term or mark suggests or alludes to a characteristic or function of the goods and is registrable on the Principal Register. *In re Aid Laboratories, Inc.*, 223 U.S.P.Q. 357 (T.T.A.B. 1984); T.M.E.P. § 1209.01(a). It is established law that any doubts regarding whether a mark or portion of a mark is suggestive, as opposed to merely descriptive, are to be resolved in favor of the applicant, *i.e.*, in favor of a finding of suggestiveness and registrability. See *In re Conductive Systems, Inc.*, 220 U.S.P.Q. at 86. Suggestive terms 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. A suggestive term differs from a descriptive term, which immediately tells something about the goods or services. See *In re Shutts*, 217 U.S.P.Q. 363 (T.T.A.B. 1983). See also *In re Quik-Print Copy Shop, Inc.*, 203 U.S.P.Q. 624 (T.T.A.B. 1979), *aff'd*, 616 F.2d 523, 205 USPQ 505 (C.C.P.A. 1980); *In re Aid Laboratories, Inc.*, 223 U.S.P.Q. 357 (T.T.A.B. 1984). Thus, a designation does not have to be devoid of all meaning in relation to the goods or services to be registrable.

In the instant case, Applicant is applying for the mark CANDY BAR PIE for "[i]ce cream; frozen confectionery" in Class 30. The Examining Attorney argues that the mark merely describes an ingredient of Applicant's goods. Applicant has agreed to disclaim the term "CANDY BAR". However, the term PIE is not merely descriptive of an ingredient of Applicant's goods. The Examining Attorney notes that it is common for ice cream manufacturers to use various pies as a major ingredient or flavor in their goods.

As Applicant has clarified in response to the Examining Attorney's request for information, however, pie is not an ingredient in Applicant's goods. Similarly, Applicant's goods do not contain pie crust or candy bar pie.

The term "pie" is defined as follows:

1. a meat dish baked with biscuit or pastry crust
2. a dessert consisting of a filling (as of fruit or custard) in a pastry shell or topped with pastry or both¹

The fact that a primary ingredient of a pie is crust or a pastry shell is supported by the evidence attached by the Examining Attorney. For example, the Examining Attorney attached a number of recipes for "Candy Bar Pie" taken from the internet to the Office Action dated November 17, 2012 and the Final Office Action dated June 12, 2013. Each of these recipes are for a pie shaped dessert containing a crust. Though there are a variety of crusts that are used, each of the recipes attached to the Office Actions include some variety of crust, or "pastry cover of a pie."² The Examining Attorney also attached a page from Cooks.com that displays the results of a search for "Candy Bar Pie." Of the 40 results, 39 recipes require a crust, with the remaining result being a recipe for bars, not pie.³ Finally, the Examining Attorney attached a result to the November 17, 2012 Office Action showing a product sold by Momofuku called "Candy Bar Pie." This product also has a crust that is distinct from the other pie ingredients. Unlike these products, Applicant's goods are ice cream and frozen confectionery which do not have any kind of a crust.

The Examining Attorney also attached numerous examples of ice cream flavors that also use the word PIE and contain pie as either a flavor or an ingredient. The 7 total examples from Coldstone

¹ Definition of "Pie" from Merriam-Webster.com. See <http://www.merriam-webster.com/dictionary/pie> (accessed Dec. 12, 2013).

² Definition of "Crust" from Merriam-Webster.com. See <http://www.merriam-webster.com/dictionary/crust> (accessed Oct. 11, 2013).

³ The recipe for "Creamy Crunch Bars" is not a recipe for pie, and is actually categorized in the "Cookies" section of the website. See <http://www.cooks.com/recipe/ka8mo57c/creamy-crunch-bars.html> (accessed Oct. 4, 2013).

Creamery, Turkey Hill, Ben & Jerry's, Tillamook, and Graeters all contain either pieces of pie or pie crust. Of the examples from the PSU Creamery and Bruesters, 10 of the 12 total flavors with PIE in the name contain pie pieces, pieces of pie crust, pie mix, or wafers that substitute for actual pie crust. Applicant's goods contain no pie pieces, pie crust, pie mix, or pie crust substitutes. Accordingly, the term "PIE" in Applicant's Mark does not merely describe and will not immediately call to mind Applicant's Goods, but will instead suggest or allude to a characteristic or feature of the goods.

Even combinations of merely descriptive components have been found registrable if the juxtaposition of the words is inventive or evokes a unique commercial impression, or if the term has a bizarre or incongruous meaning as applied to the goods. *In re Associated Theatre Clubs Co.*, 9 U.S.P.Q.2d 1660 (T.T.A.B. 1988); *In re Metcal Inc.*, 1 U.S.P.Q.2d 1334 (T.T.A.B. 1986); *In re TBG Inc.*, 229 U.S.P.Q. 759 (T.T.A.B. 1986); *In re Shutts*, 217 U.S.P.Q. 363 (T.T.A.B. 1983); *In re Quik-Print Copy Shop, Inc.*, 205 U.S.P.Q. 505(C.C.P.A. 1980); *In re Gourmet Bakers, Inc.*, 173 U.S.P.Q. 565 (T.T.A.B. 1972). As clarified in Applicant's response to the Examining Attorney's request for additional information, Applicant's goods consist of "peanut butter ice cream with fudge flakes, chocolate nougat and sweet and salty pretzel swirl," and contain no pie crust. Thus, with respect to the term "PIE", to understand the nature of the characteristics of Applicant's products, the consumer will have to use more than a mere modicum of imagination or thought – this is all that is required to overcome a finding of mere descriptiveness.

In cases such as this, any doubt regarding the descriptive nature of the wording in a mark should be resolved in favor of the applicant. Accordingly, Applicant respectfully requests that the Examining Attorney accept Applicant's disclaimer of the term "CANDY BAR" in Applicant's Mark and approve the instant application for publication.

B. The Term PIE Has Been Published or Registered on the Principal Register Without a Disclaimer or 2(f) Limitation for Goods Similar to Applicant's

The term PIE has been held registrable on the Principal Register, without entry of a disclaimer and without a 2(f) limitation, when used in connection with goods that are identical or highly similar to Applicant's. Please see, for example, the following third party registrations and links showing use of these marks:

Reg. No.	Mark	Relevant Goods	Use
4355062	PIE-WICH	Frozen confections; Ice cream in Class 30	http://www.fatboyicecream.com/fatboys/key-lime-sandwich.html
3217147	PIE FACE	Pies, including meat, vegetable and fruit pies in Class 30	http://www.pieface.com.au/#home
2740531	CUTIE PIE	Turnover fruit pies in Class 30	http://www.walmart.com/ip/Cutie-Pie-Cherry-Snacks-12-oz/10451157
2620990	PIZZA PIE ALA MODE	Ice cream based dessert item in Class 30	http://www.seamless.com/food-delivery/miceli-restaurant-los-angeles.19798.r
2106087	COW PIE	Candy and confectionery; namely, chocolate, caramel, nuts, and part milk products in Class 30	http://www.baraboocandy.com/merchant2/merchant.mvc?Screen=PROD&Store_Code=BC&Product_Code=CP3&Category_Code=CP
0893953	ESKIMO PIE	Frozen foods-namely, deserts made of ice cream, custard, ice milk, sherbet, ices, and combinations thereof either with or without a confectionery coating in Class 30	http://www.walmart.com/ip/Nestle-Eskimo-Pie-Dark-Chocolate-No-Sugar-Added-6ct-Frozen-Dairy-Dessert-Bars-6ct/16382066
1942036	CANDY CANE PIE	Pies consumed on or off the premises in Class 30	http://www.bakerssquare.com/pies/candycane/

Allowing numerous other parties to previously register "PIE" or a similar term without requiring a disclaimer or a 2(f) limitation and then holding the same term in the instant mark to be merely descriptive would violate public policy and the spirit of consistent handling of applications and marks by the USPTO. Moreover, such non-uniform treatment of this term and similar terms creates doubt as to whether the term PIE is merely descriptive in connection Applicant's goods and it is well settled that any such doubt is to be resolved in Applicant's favor. Accordingly, the term "PIE" in Applicant's Mark is not merely descriptive and is capable from a registration perspective.

III. CONCLUSION

Based upon the foregoing, the term "PIE" in Applicant's Mark is not merely descriptive. As Applicant has addressed all outstanding issues raised by the Examining Attorney, Applicant respectfully requests that the instant application be approved for publication. Concurrently with this Request for Reconsideration, Applicant is filing a Notice of Appeal with the Trademark Trial and Appeal Board.

Q. What are the major ingredients in the goods?

A. "peanut butter ice cream with fudge flakes, chocolate nougat and sweet and salty pretzel,"

Q. Do the goods contain pieces of candy bars as an ingredient?

A. YES

Q. Do the goods include the ingredients of one or more candy bars in its ingredients?

A. YES

Q. Do the goods contain pieces of pie crust as an ingredient?

A. NO

Q. Do the goods contain the ingredients of pie crusts in its ingredients?

A. NO

Q. Do the goods contain pieces of candy bar pie as an ingredient?

A. NO

Q. Is the flavor of the pie intended to resemble one or more candy bars?

A. THE GOODS DO NOT CONSIST OF OR CONTAIN PIE.

Q. Is the flavor of the pie intended to resemble a pie?

A. THE GOODS DO NOT CONSIST OF OR CONTAIN PIE.

Q. Is the flavor of the pie intended to resemble a candy bar pie?

A. THE GOODS DO NOT CONSIST OF OR CONTAIN PIE.



Screenshot of applicant's website.