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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	85757665
Applicant	Neato Robotics, Inc.
Applied for Mark	BOTVAC
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of:

U.S. Application Serial No. 85/757,665

For the Mark: BOTVAC

NEATO ROBOTICS, INC,

*Applicant/Appellant.*

*Ex Parte* Appeal No. 85757665

**APPLICANT/APPELLANT'S OPENING *EX PARTE* APPEAL BRIEF**

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## **II. Preliminary Statement**

This *ex parte* appeal concerns the proper trademark classification for the portmanteau “botvac” (*i.e.*, the combination of “bot” and “vac”) used in connection with Applicant’s goods, namely, robotic vacuum-cleaning applications. The Examining Attorney refused to publish Applicant’s mark for opposition on the grounds that the “botvac” is merely descriptive of Applicant’s goods. However, as Applicant will demonstrate *infra*, the Examining Attorney’s mere descriptiveness refusal is belied by the record evidence in at least three (3) respects.

First, the record evidence supports classifying BOTVAC, when used in connection with Applicant’s goods, as either a/an: (i) fanciful; (ii) arbitrary; or (iii) suggestive trademark. Second, the Examining Attorney’s adopted definitions and meanings of “bot” and “vac” ignore the *fact* that such terms have numerous modern day meanings. Third, the Examining Attorney failed to produce any evidence regarding consumer understanding and recognition of Applicant’s applied-for mark. Accordingly, the Examining Attorney’s mere descriptiveness refusal should be reversed, and Applicant’s BOTVAC mark should proceed to publication.

## **III. Description of Record**

### **A. Prosecution History**

#### **1. The ‘665 Application**

On October 18, 2012, Applicant/Appellant Neato Robotics, Inc. (“Applicant”) filed U.S. Trademark Serial Number 85/757,665 (the “‘665 Application”) for the mark BOTVAC in International Class 7 for “vacuum cleaners, robotic vacuum cleaners and parts thereof.” Applicant filed the ‘665 Application on an Intent-to-Use basis. However, Applicant currently uses the BOTVAC mark in United States commerce on and in connection with the goods identified in the ‘665 Application.

## **2. The Non-Final Office Action**

On February 13, 2013, the Examining Attorney assigned to the '665 Application issued a non-final office action (the "Non-Final Action"), refusing to publish the '665 Application for opposition on the grounds that BOTVAC was merely descriptive of Applicant's goods within the meaning of 15 U.S.C. §1052(e)(1). In support of its contention, the Examining Attorney stated:

"Use of BOTVAC in connection with [A]pplicant's goods merely indicates that [A]pplicant's vacuum cleaners operates automatically or by remote control, specifically, a robotic vacuum cleaner. Functioning in this manner, this wording is merely descriptive."

The Examining Attorney further stated: "BOT and VAC when combined does not create a unique, incongruous or nondescriptive [mark]."

## **3. Applicant's Response to the Non-Final Office Action**

On August 13, 2013, Applicant responded to the Non-Final Office Action ("Applicant's Response"), refuting that BOTVAC was merely descriptive of Applicant's goods because:

"The term BOTVAC, as applied to Applicant's goods, is suggestive because it has a sufficient degree of ambiguity to remove it from the category of a merely descriptive mark and because a consumer would be unable to determine anything else about the applicant's goods without additional information, investigation, or further thought."

## **4. The Final Office Action**

On September 4, 2013, the Examining Attorney issued a final office action (the "Final Office Action"). In the Final Office Action, the Examining Attorney sustained its contention that the term BOTVAC was merely descriptive of Applicant's goods within the meaning of 15 U.S.C. § 1052(e)(1). In support of its contention, the Examining Attorney stated:

"Robotic vacuum cleaners are also referred to as 'robot vacuum cleaners.' The trademark examining attorney refers to the excerpted materials from the Google search engine in which references to 'robot' and to 'bot,' used in connection with vacuum cleaners and other household appliances, appeared in several stories. This evidence demonstrates that consumers are familiar with the terms 'bot' and

‘robots’ used in connection with vacuum cleaners and other household appliances featuring robot technology.”

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[B]oth the individual components [*i.e.* BOT and VAC] and the composite result [*i.e.*, BOTVAC] 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. Specifically, [BOTVAC] merely sets forth two descriptive features of the product that is the goods featuring robotic technology and the goods are vacuum cleaners.”

## **5. Applicant’s Notice of Appeal**

On March 4, 2014, Applicant noticed the instant appeal. On December 30, 2014, Applicant was granted until February 27, 2015, to file the instant appeal brief.

### **B. Examining Attorney’s Evidence**

#### **1. The Non-Final Office Action**

The Examining Attorney cited the following evidence in the Non-Final Office Action to support its position that BOTVAC was merely descriptive of Applicant’s goods: (i) the abbreviation for “bot” from abbreviations.com; (ii) dictionary definitions for “robot,” “robotic”; and “vac”; and (iii) Google search engine results for “robot vacuum cleaner.”

#### **2. The Final Office Action**

The Examining Attorney cited the following evidence in the Final Office Action to support its mere descriptiveness refusal: (i) the abbreviation for “bot” from abbreviations.com; (ii) dictionary definitions for “robot,” “robotic”; and “vac”; and (iii) Google search engine results “in which references to ‘robot’ and ‘bot,’ used in connection with vacuum cleaners and other house appliances.” The Examining Attorney then attached excerpts from 165 Internet articles and/or consumer review websites referencing and/or discussing robotic household appliances, including certain of Applicant’s robotic vacuum-cleaning appliances.

## **C. Applicant's Evidence**

### **1. The Response**

As Exhibit A to its Response, Applicant submitted the dictionary definition of “bot,” including: (i) “the larva of a botfly”; (ii) “a device or piece of software that can execute commands, reply to messages, or perform routine tasks, as online search, either automatically or with minimal human intervention (often used in combination): *intelligent infobots; shopping bots that help consumers find the best prices*”; (iii) botanical; (iv) botanist; (iv) botany; and (v) bottle. (emphasis in original). As Exhibit B to its Response, Applicant submitted copies of 24 U.S. Trademark Registration certificates for marks composite trademarks including “bot.” Included among those 24 registered trademarks was HOM-BOT, “for: robots for personal use, namely, robots for cleaning.” The publicly-available file wrapper for the HOM-BOT mark reveals that it was published for opposition without objection from the Examining Attorney assigned to review the application for same.

## **IV. Legal Standard**

The Examining Attorney, *not* Applicant, “bears the burden of showing that [BOTVAC] is merely descriptive of the identified goods [in the ‘662 Application].” *In re Tofasco of America, Inc.*, 2013 WL 5407234, at \*1 (TTAB, 2013); *see also In re Mistler*, 2014 WL 2967641, at \*2 (TTAB, June 4, 2014) (“The burden is initially on the Office to make a *prima facie* showing that the mark is merely descriptive from the vantage point of purchasers of applicant’s goods.”).

## **V. Argument**

As a threshold matter, the Examining Attorney’s mere descriptiveness refusal should be reversed because, as discussed *infra*, the term BOTVAC, as applied to Applicant’s goods, may be properly classified as either a/an: (i) fanciful trademark; (ii) arbitrary trademark; or (iii) suggestive trademark. Nonetheless, as discussed further *infra*, the Examining Attorney’s

mere descriptiveness refusal cannot be sustained on this record because: (i) the Examining Attorney's adopted definitions of "bot" and "botvac" are arbitrary and ignore the numerous definitions and meanings of same, and (ii) the Examining Attorney failed to proffer evidence regarding consumer understanding and meaning of the composite mark BOTVAC altogether, let alone in connection with goods of the genus as Applicant's goods.

### **A. Trademarks Classifications**

As the Board is aware, there are five (5) trademark classifications: (1) fanciful; (2) arbitrary; (3) suggestive; (4) descriptive; and (5) generic. *See Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976). As discussed *infra*, the mark BOTVAC, when used in connection with Applicant's goods, may be properly classified as either a/an: (i) fanciful; (ii) arbitrary; (iii) suggestive trademark.

#### **1. BOTVAC is a Fanciful Trademark**

Applicant's BOTVAC mark is a fanciful trademark. Pursuant to TMEP § 1209.01(a), fanciful trademarks "comprise terms that have been invented for the sole purpose of functioning as a trademark or service mark. Such marks comprise words that are either unknown in the language [...] or are completely out of common usage." *See also* 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 11:5 (4th ed., 2014) ("If, in the process of selecting a new mark, a seller sits down and invents a totally new and unique combination or letters or symbols that results in a mark that has no prior use in the language, then the result is a 'coined' or 'fanciful' mark"); and *Lane Capital Management, Inc. v. Lane Capital Management, Inc.*, 192 F.3d 337, 344 (2d Cir. 1999) (holding a "fanciful mark is not a real word at all, but is invented for its use as a mark.").

Here, in the Non-Final and Final Office Actions, the Examining Attorney proffered definitions for "bot," "robot," "robotic," "vac," and "vacuum" to support its mere descriptiveness

refusal. Yet, the Examining Attorney did not proffer a single definition for “botvac”—and that is because “botvac” is not a real word. Rather, Applicant coined the unique phrase “botvac,” and then used same as a source identifier in the marketplace for its highly-regarded and sought after robotic vacuum-cleaning appliances. In fact, a simple Internet search for “botvac” reveals that consumers uniquely associate BOTVAC with Applicant’s goods provided thereunder. Accordingly, Applicant’s BOTVAC mark may be properly classified as a fanciful trademark, and the Examining Attorney’s mere descriptiveness refusal constitutes clear, reversible error.

## **2. BOTVAC is an Arbitrary Trademark**

The term BOTVAC, as applied to Applicant’s goods may also be properly classified as an arbitrary trademark. Arbitrary trademarks “comprise words that are in common linguistic use but, when used to identify particular goods or services, do not suggest or describe a significant ingredient, quality, or characteristic of the goods or services.” TMEP § 1209.01(a).

Applicant’s Response establishes that the noun “bot” may be properly defined as: (i) “the larva of a botfly”; (ii) “a device or piece of software that can execute commands, reply to messages, or perform routine tasks, as online search, either automatically or with minimal human intervention (often used in combination): intelligent infobots; shopping bots that help consumers find the best prices”; (iii) botanical; (iv) botanist; (iv) botany; or (v) bottle. Assuming the Examining Attorney is correct that the definition of “vac” is “vacuum,” then the natural combination of the above-referenced definitions of “bot” and “vac” results in a term that describes for example: (i) goods or services concerning vacuums and botfly larvae, (ii) or goods and services concerning vacuums and Internet-based searches. However, none of these combinations of “bot” and “vac” suggest or describe robot vacuum-cleaning appliances, like Applicant’s goods. Accordingly, Applicant’s use of “botvac” is arbitrary and uncommon.

Based on the foregoing, the term BOTVAC mark may also be properly classified as an arbitrary trademark as applied to Applicant's goods, and the Examining Attorney's mere descriptiveness refusal should be reversed.

### **3. BOTVAC is a Suggestive Trademark**

The Examining Attorney's mere descriptiveness refusal should further be reversed because the record evidence supports classifying BOTVAC as a suggestive trademark when applied to Applicant's goods.

As discussed *supra*, Applicant's Response establishes that "bot" has numerous definitions and common understandings beyond simply "robot." Thus, even if consumers are familiar with Applicant's products, when they encounter "bot" combined with "vac" in the marketplace, they are just as likely to assume that BOTVAC suggests goods related to vacuums and botfly larvae, or vacuums and automated shopping assistants, as they are to assume it suggests Applicant's goods. It is also possible that consumers do not see the mark as "bot-vac," but instead as "boat-vac" or "bo-t-vac." Thus, upon encountering BOTVAC in the marketplace, consumers must momentarily pause, work through the numerous potential definitions and meanings of BOTVAC, and then take a mental leap in order to correctly determine the nature and characteristics Applicant's products. This is the *sine qua non* of a suggestive trademark. See TMEP § 1209.01(a) (Suggestive trademarks "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"); see also *In re David P. Cooper*, 2013 WL 5407254, \*2 (TTAB, June 10, 2013) ("If, however, when goods or services are encountered under a mark, a multistage reasoning process, or resort to imagination, is required in order to determine the attributes or characteristics of the product or services, the mark is suggestive rather than merely descriptive").

Indeed, as the Board held in *In re James Stanfield and Asso'c.*, 2007 WL 3336387, \*1 (TTAB, Oct. 12, 2007):

“A term is deemed to be suggestive, not merely descriptive (and thus not barred from registration under Section 2(e)(1)), if it does not immediately inform the purchaser of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services, but instead conveys such information only after giving the purchaser mental pause, requiring the exercise of thought or imagination to determine the significance of the term as applied to the goods or services.”

*See also In re George Weston Ltd.*, 228 USPQ 57 (TTAB 1985) (SPEEDI BAKE for frozen dough found to fall within the category of suggestive marks because it only vaguely suggests a desirable characteristic of frozen dough, namely, that it quickly and easily may be baked into bread); and *In re The Noble Co.*, 225 USPQ 749 (TTAB 1985) (NOBURST for liquid antifreeze and rust inhibitor for hot-water-heating systems found to suggest a desired result of using the product rather than immediately informing the purchasing public of a characteristic, feature, function, or attribute).

Based on the foregoing, the record supports a finding that the term BOTVAC, as applied to Applicant's goods, is a suggestive trademark. Accordingly, the Examining Attorney's mere descriptiveness refusal should be reversed.

**4. The Examining Attorney Failed to Carry its Burden of Establishing that BOTVAC is Merely Descriptive of Applicant's Goods**

To the extent the Board disagrees that BOTVAC may be classified as a fanciful, arbitrary, and suggestive trademark as applied to Applicant's goods, then this *ex parte* appeals turns on whether there is sufficient record evidence to affirm the Examining Attorney's mere descriptiveness refusal. Applicant contends there is not.

Here, Applicant seeks registration of the coined mark BOTVAC. Thus, the Examining Attorney must establish four factors in order to carry its burden of showing that BOTVAC is

merely descriptive as applied to Applicant's goods. *See, e.g. In re Siemens Aktiengesellschaft*, 2014 WL 986174, \*4 (TTAB, March 4, 2014) *citing to In re Harco Corp.*, 220 U.S.P.Q. 1075, 1076 (TTAB 1984).

*First*, the Examining Attorney must establish the individual definitions and meanings of “bot” and “vac.” *Second*, the Examining Attorney must establish the definition and meaning of BOTVAC. *See In re Whitewave Services, Inc.*, 2015 WL 496138, \*2 (TTAB, Jan. 27, 2015) (reversing the mere descriptiveness finding with regard to CLASSICMAC for a typical macaroni and cheese dish; holding that “[w]e need to analyze each portion of the composite [CLASSICMAC] mark to determine whether such portion is merely descriptive of the goods and then look at the composite mark in its entirety”); *see also In re Wisconsin Tissue Mills*, 173 U.S.P.Q. 319 (TTAB, 1972) (“It does not follow as a matter of law that because component words of a mark may be descriptive, the composite [mark] is unregistrable. The established rule is that a composite mark must be considered in its entirety and the question then is whether the entirety is merely descriptive.”). (emphasis supplied).

*Third*, the Examining Attorney must establish that BOTVAC (as defined in step two (2)) merely describes Applicant's goods and services. *Fourth*, the Examining Attorney must proffer sufficient evidence to prove that a relevant consumer encountering the BOTVAC mark in the marketplace would *immediately* recognize and understand it as describing the nature, quality, or characteristics of Applicant's goods and services. *See In re Shutts*, 217 U.S.P.Q. 363, 364 (T.T.A.B. 1983) (mark is merely descriptive when it “readily and immediately evoke[s] an impression and understanding” of the goods identified by the mark); and *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 189 USPQ 759, 765 (2nd Cir. 1976) (*accord*); *see also Oreck Holdings, LLC v. Bissell Homecare, Inc.*, 2010 WL 985352, at \*5 (TTAB, Feb. 16, 2010)

(“the question is whether someone who knows what the goods or services are will understand the mark to convey information about them”; holding HEALTHY HOME VACUUM suggestive for vacuum cleaners.).

With respect to the first factor, the Examining Attorney’s definition of “bot” as “robot” is arbitrary because it ignores altogether the numerous definitions and meanings of “bot” established in Applicant’s Response. Furthermore, because the record supports numerous definitions and meanings, Applicant respectfully submits that arriving at a single definition or meaning of “bot” is impossible. Accordingly, the first factor favors reversing the Examining Attorney’s mere descriptiveness refusal.

With respect to the second factor, the Examining Attorney contends in the Final Office Action that BOTVAC “merely sets forth two descriptive features of the product that is the goods featuring robotic technology and the goods are vacuum cleaners.” However, like its definition of “bot,” the Examining Attorney’s definition of BOTVAC is arbitrary because it ignores altogether that the numerous definitions and meanings of “bot,” in turn, create numerous definitions and meanings of BOTVAC. Accordingly, because a precise definition or meaning of BOTVAC cannot be established on this record, it follows that the Board cannot evaluate the third factor—whether the Examining Attorney is correct that the definition and meaning of BOTVAC merely describes Applicant’s goods. Thus, the second and third factors favor reversing the Examining Attorney’s mere descriptiveness refusal.

With respect to the fourth factor, assuming *arguendo* that the Examining Attorney is correct that the definition and meaning of BOTVAC is “robotic vacuum cleaners,” the Examining Attorney’s mere descriptiveness refusal must still be reversed because it failed to proffer evidence regarding consumer recognition or understanding of BOTVAC in the

marketplace. For example, in *In re Future Ads LLC*, 103 U.S.P.Q.2d 1571 (TTAB, 2012), the Examining Attorney issued a disclaimer requirement based on the alleged mere descriptiveness of ARCADEWEB. The “examining attorney’s position [wa]s essentially that the terms ‘arcade’ and web’ merely describe[d] a feature of the applicant’s services because:

applicant promotes the goods and services of others by operating an online arcade web site. The applicant provides its advertising and promotional services through an arcade on the web, such that it disseminates advertising and promotes goods and services of others by means of arcade games on the web.” *In re Future Ads LLC*, 103 U.S.P.Q.2d at 10.

However, the Board reversed the Examining Attorney’s disclaimer requirement because, *inter alia*:

the “examining attorney did not submit any evidence with her two Office actions showing the term ‘arcadeweb’ or ‘arcade web’ used or referenced in connection with services of the type identified in applicant’s application [...] [n]or has the examining attorney submitted any evidence that the mark, used in conjunction with the identified services, immediately and directly conveys to consumers that the services involve arcade games.” *Id.* at 3, 11.

Here, like the Examining Attorney in *In re Future Ads LLC*, the Examining Attorney failed to proffer any evidence regarding consumer understanding or recognition of Applicant’s applied-for mark in the marketplace. Specifically, in the Final Office Action, the Examining Attorney’s position was that:

“Robotic vacuum cleaners are also referred to as ‘robot vacuum cleaners.’ The trademark examining attorney refers to the excerpted materials from the Google search engine in which references to ‘robot’ and to ‘bot,’ used in connection with vacuum cleaners and other household appliances, appeared in several stories. This evidence demonstrates that consumers are familiar with the terms ‘bot’ and ‘robots’ used in connection with vacuum cleaners and other household appliances featuring robot technology.”

However, Applicant does *not* seek registration of “robot,” “robots,” “bot,” or any combination thereof. Rather, Applicant seeks registration of BOTVAC. Yet, noticeably absent from the Examining Attorney’s “excerpted materials” is any reference to BOTVAC.

Furthermore, as noted *supra* a current Internet search for the actual mark that Applicant seeks to register—BOTVAC—reveals that consumers already uniquely associate BOTVAC with Applicant’s goods provided thereunder. More to the point, without evidence regarding consumer recognition or understanding of BOTVAC in the marketplace, it cannot be determined on this record whether consumers would *immediately* understand BOTVAC to be merely descriptive of Applicant’s goods. Accordingly, the fourth factor, like the first, second and third factors, favors reversing the Examining Attorney’s mere descriptiveness refusal.

**5. Any Doubt Regarding Whether BOTVAC is a Suggestive or Descriptive Trademark When Applied to Applicant’s Goods *Must* be Resolved in Applicant’s Favor**

If, after the foregoing analysis, the Board has any doubt regarding whether BOTVAC is a suggestive or descriptive trademark as applied to Applicant’s goods, such doubt must be resolved in Applicant’s favor. *In re Morton-Norwich Prods., Inc.*, 209 U.S.P.Q. 791 (TTAB 1981) (“[W]here reasonable [persons] may differ, it is the Board’s practice to resolve the doubt in the applicant’s favor and publish the mark for opposition”) *referencing In re The Gracious Lady Service, Inc.*, 175 U.S.P.Q. 380 (TTAB 1971) and *In re Gourmet Bakers*, 173 U.S.P.Q. 565 (TTAB, 1972); *In re Tofasco of America, Inc.*, 2013 WL 5407234 at \*1 (“To the extent there is any doubt in drawing the line of demarcation between a suggestive mark and a merely descriptive mark, such doubt is resolved in applicant’s favor”); *In re David P. Cooper*, 2013 WL 5407254 at \*2 (*accord*); and *In re Atavio Inc.*, 25 U.S.P.Q.2d 1361 (TTAB 1992) (*accord*). Such doubt must be resolved in Applicant’s favor because, as the Board held in *Oreck Holdings, LLC v. Bissell Homecare, Inc.*, 2010 WL 985352, \*9 (TTAB, Feb. 16, 2010): “[t]here is often a fine line between merely descriptive marks and those which are just suggestive. These determinations

are often subjective [...] The determination of whether a mark is descriptive or suggestive is not an exact science. [As the Board] has observed:

In the complex world of etymology, connotation, syntax, and meaning, a term may possess elements of suggestiveness and descriptiveness at the same time. No clean boundaries separate these legal categories. Rather, a term may slide along the continuum between suggestiveness and descriptiveness depending on usage, context, and other factors that affect the relevant public's perception of the term. *In re Nett Designs, Inc.*, 57 USPQ2d at 1566.

The Board then went on to hold in *Oreck Holdings, LLC* that:

The mark at issue, 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.” *Oreck Holdings, LLC*, 2010 WL 985352 at \*9.

Here, like the mark HEALTHY HOME VACUUM, Applicant’s BOTVAC mark is “highly suggestive [because it] tells consumers something general about [Applicant’s] products, without being specific or immediately telling consumers anything with a degree of particularity.” Indeed, as discussed *supra*, consumers must take a mental leap in order to correctly determine the nature and characteristics of Applicant’s goods because BOTVAC suggests numerous different definitions and meanings. As a result of this mental leap, BOTVAC, when applied to Applicant’s goods, is suggestive, not descriptive, and any doubt regarding same must be resolved in Applicant’s favor.

## **VI. Conclusion**

Based on the foregoing, Applicant respectfully requests that: (i) reverse the Examining Attorney’s mere descriptiveness refusal based on BOTVAC’s alleged mere descriptiveness of Applicant’s goods, and (ii) Order that the ‘665 Application be published for opposition.

Dated: February 27, 2015  
New York, New York

Respectfully submitted,



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