

ESTTA Tracking number: **ESTTA607295**

Filing date: **05/30/2014**

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

Proceeding	85937447
Applicant	Blue Lotus Lifestyle LLC
Applied for Mark	LOTUS
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Attachments	Brief of the Applicant.pdf(294466 bytes )
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## I. INTRODUCTION

COMES NOW the Applicant Blue Lotus Lifestyle, LLC (hereinafter “Applicant”), by counsel Matthew H. Swyers, Esq. of The Trademark Company, PLLC, and submits the instant Brief of the Applicant in support of its appeal of the examining attorney’s refusal to register the instant mark.

## II. STATEMENT OF THE CASE

On or about May 20, 2013 Applicant applied to register the trademark LOTUS in connection with an “Energy balancing drink” in International Class 32. The application was based upon Applicant’s use of the mark in interstate commerce since as early as October 15, 2011. In connection with the application, Applicant submitted the following specimen of use in support of registration of the mark:



On or about June 5, 2014 Applicant, prior to the initial review of the application by the office, submitted a revised identification of goods amending the identification to read “Rejuvenation Drink” also in International Class 32.

On or about September 16, 2013 the Office conducted its initial review of the application. In addition to other procedural matters, the Office included a “Request for Information” seeking product literature or other materials on the goods no doubt in an effort to determine the significance of the wording in the mark. See Office Action dated September 16, 2013.

By Examiner’s Amendment dated September 17, 2013 the identification of goods was changed to “Drinking water with vitamins and botanicals”. At this time, all other items appeared to be addressed and the mark appeared to be in a position to be published for opposition.

On September 24, 2013 it appears that the application was even accepted for publication by the examining attorney. See TRAM Snapshot of App at Pub for Opp dated September 24, 2013. However, on October 28, 2013 a third action was taken on this file by the office and, for the first time, the application was refused registration on the grounds that it was merely descriptive.

Of note, however, the Examining Attorney relied upon a critical false assumption in making the instant refusal. Specifically, in the October 28, 2013 third action the Examining Attorney states:

In this instance, the applicant's LOTUS immediately tells something about its drinking water with vitamins and botanicals – drinking water with vitamins and botanicals **presumably** containing lotus flowers/leaves. Lotus flower/leaves are common ingredients used in beverages.

In short, the Examining Attorney based the instant refusal not upon evidence in the file but upon a presumption that such feature or characteristic exists without having evidence of the same in the file.

On February 10, 2014 the Applicant responded to the Examining Attorney’s presumption stating unequivocally:

LOTUS appearing in the mark has no significance nor is it a term of art in the relevant trade or industry or as applied to the goods/services listed in the application, or any geographical significance.

See Office Action Response dated February 10, 2014.

Notwithstanding the lack of any evidence in the file concerning a relationship between the mark and the underlying goods and, moreover, despite the express denial of the same by the Applicant, the Examining Attorney nonetheless went final on this presumption of relatedness leading to the instant appeal at issue.

## **ARGUEMENT**

### **I. The Standard for a Refusal Under Section 2(e)(1).**

Matter that "merely describes" the goods or services on or in connection with which it is used is not registrable on the Principal Register. TMEP § 1209. As noted in *In re Abcor Development Corp.*, 588 F.2d 811, 813, 200 USPQ 215, 217 (C.C.P.A. 1978):

The major reasons for not protecting such marks are: (1) to prevent the owner of a mark from inhibiting competition in the sale of particular goods; and (2) to maintain freedom of the public to use the language involved, thus avoiding the possibility of harassing infringement suits by the registrant against others who use the mark when advertising or describing their own products.

To be refused registration on the Principal Register under §2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), a mark must be merely descriptive or deceptively misdescriptive of the goods or services to which it relates. TMEP § 1209.01(b). A mark is considered merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods or services. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987) (APPLE PIE held merely descriptive of potpourri); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986) (BED & BREAKFAST REGISTRY held merely descriptive of lodging reservations services); *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984)

(MALE-P.A.P. TEST held merely descriptive of clinical pathological immunoassay testing services for detecting and monitoring prostatic cancer); In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979) (COASTER-CARDS held merely descriptive of a coaster suitable for direct mailing).

The determination of whether or not a mark is merely descriptive must be made in relation to the goods or services for which registration is sought, not in the abstract. TMEP § 1209.01(b)(emphasis added). This requires consideration of the context in which the mark is used or intended to be used in connection with those goods or services, and the possible significance that the mark would have to the average purchaser of the goods or services in the marketplace. *Id.* See also *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (C.C.P.A. 1978); *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985).

It is not necessary that a term describe all of the purposes, functions, characteristics or features of a product to be considered merely descriptive; it is enough if the term describes one significant function, attribute or property. *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d1370, 1371 (Fed. Cir. 2004) ("A mark may be merely descriptive even if it does not describe the 'full scope and extent' of the applicant's goods or services," citing *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001)); *In re Gyulay*, 820 F.2d at 1218, 3 USPQ2d at 1010.

To be characterized as “descriptive,” a mark must immediately convey knowledge of the ingredients, qualities or characteristics of the goods or services. *In re Quik-Print Copy Shops Inc.*, 616 F.2d 523, 205 U.S.P.Q. 505, 507 (C.C.P.A. 1980) (emphasis added). In the context of the Lanham Act, “merely” descriptive means “only” descriptive. *Id.* at n. 7. Moreover, the mark

must give some reasonably accurate or tolerably distinct knowledge of the essence of the service. If the information conveyed by the mark is indirect or vague, the mark is being used in a suggestive rather than a descriptive manner. See J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §11:19 ( Ed. 2000); *The Money Store v. Harris Corp. Finance, Inc.* 216 U.S.P.Q. 11, 18 ( Cir. 1982) (“‘THE MONEY STORE’ conveys the idea of a commercial establishment whose service involves supplying money. The term does not, however, necessarily convey ‘the essence of the business, money lending.... Some imagination and perception are therefore required to identify the precise nature of the services . . . .’”); *In re Ralston Purina Company*, 191 U.S.P.Q. 237, 238 (T.T.A.B. 1976) (The term SUPER is not used to describe any real or specific item or characteristic or quality, but merely to connote a vague desirable characteristic or quality and therefore it need not be disclaimed from RALSTON SUPER SLUSH).

In determining whether a particular mark is merely descriptive of a product, a reviewing court must consider the mark in its entirety, with a view toward “what the purchasing public would think when confronted with the mark as a whole.” *In re Hutchinson Technology Inc.* 852 F.2d 552, 552-54 (Fed. Cir. 1988). To the extent that there may be doubt as to whether applicant’s mark is merely descriptive or suggestive of its goods, it is commonly accepted practice to resolve any doubt in the applicant’s favor and publish the mark for opposition. *In re Morton-Norwich Products, Inc.* 209 USPQ 791 (TTAB 1981); *In re Gourmet Bakers Inc.*, 173 USPQ 565 (TTAB 1972).

## **II. Applicant’s Mark is Arbitrary.**

In the instant case, the Applicant’s mark, and the record as a whole, establish that it is arbitrary in regard to the applied-for goods. In short, as has been pointed out above, at some

point the Examining Attorney presumed a relationship between the mark at issue and the goods of the applicant and has largely based this refusal on this erroneous presumption. To the contrary, the record is devoid of any evidence whatsoever that suggests that the term LOTUS describes a feature or quality of the Applicant's goods. To this end, Applicant itself expressly provided that the term LOTUS had no significance to the product.

The determination of whether or not a mark is merely descriptive must be made in relation to the goods or services for which registration is sought, not in the abstract. TMEP § 1209.01(b)(emphasis added). In the instant case, the only support for the Examining Attorney's refusal is the presumption found in the Office Action dated October 28, 2013 wherein the Examining Attorney states:

In this instance, the applicant's LOTUS immediately tells something about its drinking water with vitamins and botanicals – drinking water with vitamins and botanicals **presumably** containing lotus flowers/leaves. Lotus flower/leaves are common ingredients used in beverages.

There is nothing more. However, this presumption is expressly denied by the Applicant that made of record the following statement:

LOTUS appearing in the mark has no significance nor is it a term of art in the relevant trade or industry or as applied to the goods/services listed in the application, or any geographical significance.

See Office Action Response dated February 10, 2014.

LOTUS in connection with the Applicant's goods in this instance is no less arbitrary than AMAZON in connection with online retail store services. Yet AMAZON is now registered because despite its significance as a geographic or potentially otherwise descriptive reference to a major region and river in the world, its use as a service mark to identify online retail store

services based in California is completely arbitrary and one cannot presume facts not in evidence to create a basis for a refusal.

Accordingly, it is submitted that in the absence of evidence in the record as opposed to presumptions the instant mark should not be denied registration as it is arbitrary and not descriptive as the Examining Attorney presumes.

**III. Other Marks for LOTUS.**

Moreover, an examination of registered marks on the Principal Register reveals that the term “LOTUS” in relation to goods or services like those of the Applicant has consistently been treated as inherently distinctive of the respective goods or services without like presumptions affording refusals to register the same:

Mark	Reg No.	Disclaimer	Goods
LOTUS	1501506	NONE	Class 29: CANNED FRESH FRUITS; Class 31: FRESH FRUITS; Class 32: FRUIT JUICES AND FRUIT NECTARS
GOLDEN LOTUS PLUS BÔNG SEN VÀNG	3593785	NONE	Class 32: Mineral water
BLUE LOTUS LIFESTYLE	3714881	NONE	Class 32: Energy drinks
LOTUS	1724030	NONE	Class 30: cakes, pastry, biscuits, cookies
LOTUS	0784122	NONE	Class 30: RICE
RED LOTUS	3352229	NONE	Class 29: soy bean oil
LOTUS YOGURT BAR	3611920	YOGURT BAR	Class 43: Self-service restaurants featuring yogurt and drinks
PINK LOTUS	1798050	NONE	Class 30: rice and flour
LOTUS	2843456	NONE	Class 31: Pet Food
THREE LOTUS	3527908	NONE	Class 30: TAPIOCA FLOUR, RICE STICK, RICE, JASMINE RICE, SWEET RICE
LOTUS VODKA	3124813	VODKA	Class 33: Vodka
LOTUS FOODS RICE IS LIFE	4142267	"FOODS" AND "RICE"	Class 30: Rice
LOTUS BISCOFF COFFEE CORNER	4455309	COFFEE	Class 30: Cakes, pastry, biscuits, cookies; spreads containing biscuits or cookies not including fruits or cheese or vegetable-based or dairy based spreads; coffee,

			confectionery made of sugar
BLUE LOTUS CHAI	4200886	BLUE LOTUS CHAI	Class 30: Chai tea
BOL LYAN LOTUS TREASURE	3989105	NONE	Class 31: Fresh fruit and vegetables

As such, it is respectfully submitted that it would be inconsistent for the Office to deny registration of the Applicant's mark by concluding that the term "LOTUS" is merely descriptive of the Applicant's goods wherein there is no evidence of a nexus between the term and Applicant's goods like those above where the above-referenced marks have been permitted to register on the Principal Register without disclaimers as to the term at issue.

#### **IV. Applicant's Other Registered LOTUS Mark.**

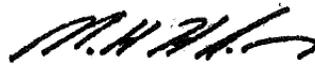
Finally, Applicant is the owner of the mark BLUE LOTUS LIFESTYLE, as more fully identified in U.S. Registration number 3,714,881. It would be inconsistent for the Office to recognize this mark as inherently distinctive and then, on a presumption and not evidence, refuse to register the instant mark.

### **CONCLUSION**

WHEREFORE the Applicant Blue Lotus Lifestyle, LLC, by counsel, respectfully requests that the refusal under Section 2(e)(1) of the Trademark Act of 1946 be reversed and the mark be allowed for publication on the Principal Register.

Respectfully submitted this 30<sup>th</sup> day of May, 2014.

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