

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

In the Matter of Application Serial No. 85520148

Mark: THE COOLER COMPANY

Applicant: The Coleman Company, Inc.

Filing Date: January 19, 2012

**APPLICANT'S BRIEF ON APPEAL
FROM FINAL OFFICE ACTION**

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INTRODUCTION

Applicant The Coleman Company, Inc. ("Applicant"), a well-known producer of outdoor gear, appeals the refusal to register its mark, THE COOLER COMPANY. The Examining Attorney maintains that this mark is merely descriptive of Applicant's goods and has refused registration under Section 2(c)(1) of the Trademark Act, 15 U.S.C. § 1052(c)(1). However, THE COOLER COMPANY is an inventive double entendre: on the one hand, it conveys that Applicant offers coolers, *i.e.*, containers for food and beverages; on the other hand, it suggests that Applicant is *cooler* – that is, more fashionable and hip – than other companies. For this reason, it is not merely descriptive.

The dual meaning of THE COOLER COMPANY is readily apparent from the mark itself, and confirmed by Applicant's promotional materials, which emphasize various "cooler" aspects of Applicant's business. Nonetheless, the Examining Attorney disregarded this dual meaning, comparing THE COOLER COMPANY to THE PHONE COMPANY, a mark that has only one meaning.

It is well-established that a mark with multiple meanings is distinctive, and not merely descriptive, where at least one of the meanings is suggestive. T.M.E.P. § 1213.05(c). Given the dual meaning of THE COOLER COMPANY, the Examining Attorney has failed to meet his burden of establishing that Applicant's mark is merely descriptive. Accordingly, the Board should reverse the Examining Attorney's decision.

ARGUMENT

I. A Double Entendre, Such As THE COOLER COMPANY, is Distinctive.

The rule regarding a double entendre is well-settled:

The mark that comprises the "double entendre" will not be refused registration as merely descriptive if one of its meanings is not merely descriptive in relation to the goods or services.

T.M.E.P. § 1213.05(c). See *In re Simmons*, 189 U.S.P.Q. 352 (T.T.A.B. 1976) (THE HARD LINE not merely descriptive for mattresses and bed springs); *In re National Tea Co.*, 144 U.S.P.Q. 286 (T.T.A.B. 1965) (NO BONES ABOUT IT not merely descriptive for fresh pre-cooked (boneless) ham).

THE COOLER COMPANY has two distinct meanings, both of which are readily apparent to consumers. First, this mark conveys that Applicant offers coolers, among hundreds of other outdoor recreation products.¹ Second, this mark suggests that Applicant is *cooler* than its competitors, and *cooler* than Applicant has been in the past. "Cool," of course, is a slang term with a variety of favorable meanings, including "fashionable" and "hip." See <http://www.merriam-webster.com/dictionary/cool> (Merriam-Webster online dictionary); <http://www.ahdictionary.com/word/search.html?q=cool> (American Heritage online dictionary).²

The Examining Attorney has taken the position that the first meaning of THE COOLER COMPANY is the "primary and overriding meaning," but Applicant disagrees. The slang meaning of "cool" has been used in common parlance for many years, and it can be found in virtually any dictionary. This word is well-known to consumers. As "Joe Cool," "Cool Hand Luke," or LL Cool J could attest, "cool" is just as likely to indicate disposition and it is to indicate temperature.

¹ The present application, as amended, covers the following goods: "Food and drink containers for domestic use; portable water carriers, namely, reusable plastic water bottles and jugs sold empty; insulating sleeve holders for beverage cans; squeeze bottles sold empty; dispensers for disposable cups; portable coolers and jugs of both rigid and fabric construction."

² These dictionary entries are attached as Exhibits A and B to Applicant's Office Action response, submitted on October 26, 2012. The Board also can take judicial notice of these and other dictionary entries. *Marcal Paper Mills, Inc. v. American Can Co.*, 212 U.S.P.Q. 852, 860, n. 7 (T.T.A.B. 1981).

Indeed, the Board has already recognized the dual meanings of "cool" :

Opposer's mark "COOL-GEAR," obviously, is highly suggestive of gear for keeping food and beverages cool, although it also possesses a double entendre since its goods, namely, folding chairs with seats that act as food and beverage coolers, are 'cool gear' in the sense of serving in a first-rate or clever manner the dual purpose of functioning as both a chair and a cooler.

Cool Gear International, Inc. v. Carla Dahl, Opposition No. 91153361, 2004 WL 1703102, at *2 (T.T.A.B July 22, 2004) (non-precedential).

In any event, it is irrelevant which meaning of "cool" is the "primary" meaning. Both are associations the public would make "fairly readily." T.M.E.P. § 1213.05(c). *See In re Colonial Stores Inc.*, 394 F.2d 549, 552-553 (C.C.P.A. 1968) (SUGAR & SPICE not merely descriptive for bakery products because it recalls nursery rhyme); *Ex parte Barker*, 92 U.S.P.Q. 218, 219 (Comm'r Patents 1952) (CHERRY-BERRY-BING not merely descriptive of bing cherries and loganberries because it recalls the song "Chiribiribin").

Taking into account the slang meaning of "cool," THE COOLER COMPANY suggests a general impression about Applicant, in relation to its competitors and to the past. It does not describe any particular quality or characteristic of the goods identified in the application. Therefore, it is not merely descriptive, and Applicant's mark is entitled to registration. *See In re Occidental Petroleum Corp.*, 167 U.S.P.Q. 128, 128 (T.T.A.B. 1970) (SUPER IRON not merely descriptive for a soil supplement because "it takes some roundabout reasoning to make a determination of what the mark actually describes").

The double entendre comprised by THE COOLER COMPANY is reflected in Applicant's promotional materials. Below is a partial screen shot from Applicant's home page, www.coleman.com:



MY ACCOUNT | SIGN IN | VIEW CART
 0 Items \$0.00 CHECKOUT
 Enter Search Term

SHOP | OUTLET | EXPERT INFO | SUPPORT | PARTS



COOLER

COOLER NEW DESIGN • COOLER NEW COLORS • COOLER NEW PORTABILITY
 Make your adventures even cooler with the sleek new design of

COOLER

As shown above, Applicant states that its current products feature a "COOLER NEW DESIGN," "COOLER NEW COLORS," and "COOLER NEW PORTABILITY." Following these statements, Applicant displays its mark, THE COOLER COMPANY.

Applicant has run advertisements similar to the above screenshot in *Outside Magazine*:

In this advertisement, Applicant follows its claims of coolness – "COOLER NEW DESIGN," "COOLER NEW COLORS," "COOLER NEW PORTABILITY" – with the statement: "Our sleek new design that's even cooler than it looks."

As shown in the *Outside* ad above, Applicant promotes its "cool" new coolers along with its "hot" new grills, also relying on a double entendre.

Because THE COOLER COMPANY has multiple meanings, at least one of which is not merely descriptive, this mark should not be refused registration.³

II. Substantial Precedent Supports Applicant's Position.

The Board has repeatedly held that this sort of double entendre is entitled to registration.

In re Delaware Punch Company, 186 U.S.P.Q. 63 (T.T.A.B. 1975) is on point. In that case, the applicant applied to register THE SOFT PUNCH for a noncarbonated soft drink. The Examining Attorney refused registration on the ground that the mark was merely descriptive because it "only serves to inform prospective purchasers that applicant's goods are a non-alcoholic punch." *Id.* at 63. The Board reversed. It agreed with the applicant that the mark conveyed to the purchasing public "that the drink has an impact like a soft punch or a pleasing hit." *Id.* at 63. The Board observed: "[I]t possesses a degree of ingenuity in its phraseology which is evident in the double entendre that it projects." *Id.* at 64. Applicant's mark, THE COOLER COMPANY, represents similar ingenuity.

In re Grand Metropolitan Foodservice Inc., 30 U.S.P.Q.2d 1974 (T.T.A.B. 1994) is also illustrative. There, the Board held that MUFFUNS was not merely descriptive for baked mini muffins -- even though the mark was obviously a misspelling of "muffins" -- and it reversed the Examining Attorney's refusal to register.

As applicant has pointed out, its mark does project a dual meaning or suggestiveness -- that of muffins and of the "fun" aspect of applicant's food product. This aspect of applicant's product is emphasized in its promotion ("What's MuffFun than one?"). We have a situation, therefore, where applicant's

³ Applicant's screenshot and advertisement are attached as Exhibits 1 and 2 to Applicant's Request for Reconsideration, filed on April 29, 2013.

mark has a different commercial impression or connotation from that conveyed by a misspelled generic or descriptive term.

Id. at 1975-1976. Similarly, Applicant's mark projects a dual meaning or suggestiveness, of both coolers and the "cool" aspect of Applicant. This latter meaning is emphasized in Applicant's promotional materials.

Another example is *In re Best Software, Inc.*, Serial No. 75457359, 2001 WL 256151 (T.T.A.B. Feb. 27, 2001) (non-precedential). There, the applicant sought registration of BUDGET DIRECTOR for "computer software for use in accounting, financial management and planning, and budget forecast and analysis." The Examining Attorney determined that this mark was merely descriptive because it described the intended users of the applicant's products, *i.e.*, budget directors. The Board reversed, recognizing that BUDGET DIRECTOR was a double entendre: "[W]hile the term is commonly understood to identify a 'person,' when it is considered in connection with these goods, the term suggests that this software can be useful in setting the direction of an organization's budget." *Id.* at *2.

Last year, the Board held that the applicant's mark SMASHINGLY DURABLE, for fans, was a double entendre and therefore not merely descriptive. *In re Delta T Corp.*, Serial No. 85310163, 2012 WL 5196152 (T.T.A.B. Sept. 24, 2012) (non-precedential). It reversed the Examining Attorney's refusal to register this mark without a disclaimer. The Board explained that "smashing" could mean something that smashes or crushes, or it could mean something that is extraordinarily impressive or effective. "Based upon this definition, SMASHINGLY DURABLE connotes, on the one hand, goods that are extraordinarily durable and, on the other, goods possessing durability that 'crushes' in a literal or colloquial sense." *Id.* at *4.

Many other cases – both before the Board and the federal courts – also recognize that a double entendre in the nature of THE COOLER COMPANY is not merely descriptive. *See, e.g.*,

American Historic Racing Motorcycle Ass'n, Ltd. v. Team Obsolete Promotions, 33 F.Supp.2d 1000, 1005 (M.D. Fla. 1998), *aff'd*, 233 F.3d 577 (11th Cir. 2000) (BEARS not merely descriptive for motorcycle events even though short for British-European-American Racing Series: "BEARS doubles for an animal and an abbreviation. Consequently, a consumer who sees BEARS in connection with motorcycle racing may associate the word with any number of things, and not immediately think that BEARS is an abbreviation."); *Blisscraft of Hollywood v. United Plastics Co.*, 294 F.2d 694, 700 (2d Cir. 1961) (POLY PITCHER not merely descriptive for polyethylene pitchers, because it is "reminiscent or suggestive of Molly Pitcher of Revolutionary time."); *In re Pecan Ridge Vineyards*, Serial No. 77071957, 2009 WL 4073496 (T.T.A.B. May 13, 2009) (FROZEN ROSE not merely descriptive for prepared wine cocktails: "[I]n addition to describing a frozen cocktail that is made of or contains rosé wine, [the mark] has a non-descriptive meaning of a flower that is frozen."); *In re Tea and Sympathy, Inc.*, 88 U.S.P.Q.2d 1062, 1064 (T.T.A.B. 2008) (THE FARMACY not merely descriptive for retail store services featuring natural herbs and organic products: "[T]he mark conveys a dual meaning, that of the natural aspect of the goods sold by applicant and of a pharmacy.").

In his initial Office Action, the Examining Attorney stated that the present situation is "just like THE PHONE COMPANY case," *In re The Phone Co.*, 218 U.S.P.Q. 1027 (T.T.A.B. 1983), in which the Board held that THE PHONE COMPANY was merely descriptive for telephone products. The Examining Attorney again cited this case in his denial of Applicant's Request for Reconsideration. This analogy reflects the flaw in the Examining Attorney's analysis. THE PHONE COMPANY has a single meaning, while THE COOLER COMPANY has two. Unlike THE PHONE COMPANY, THE COOLER COMPANY tells consumers something about Applicant's offerings under the mark, and it also suggests a favorable idea about

Applicant generally. *See Cool Gear International, supra*, 2004 WL 1703102, at *2 (recognizing COOL-GEAR is a double entendre).

CONCLUSION

In this context, "where reasonable men may differ, it is the Board's practice to resolve the doubt in applicant's favor and publish the mark for opposition." *In re Intelligent Medical Systems Inc.*, 5 U.S.P.Q.2d 1674, 1676 (T.T.A.B. 1987) (quoting *In re Morton-Norwich Products, Inc.*, 209 U.S.P.Q. 791, 791 (T.T.A.B. 1981)). *See In re Conductive Systems, Inc.*, 220 U.S.P.Q. 84, 86 (TTAB 1983) (reversing refusal to register MULTI-POINT: "[W]e have doubts about the 'merely descriptive' character of the mark before us and, unlike the situation in determining likelihood of confusion under Section 2(d) of the Trademark Act, it is clear that such doubts are to be resolved in favor of applicants.").

For the reasons discussed above, THE COOLER COMPANY is an inventive double entendre, and at least one of the meanings is not merely descriptive. Therefore, the Board should reverse the Examining Attorney, and allow Applicant's mark to proceed to publication.

Date: July 2, 2013

Respectfully submitted,

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CERTIFICATE OF ELECTRONIC FILING

I, Seth I. Appel, an attorney for Applicant, hereby certify that a copy of the foregoing **APPLICANT'S BRIEF ON APPEAL FROM FINAL OFFICE ACTION** was electronically transmitted to the Trademark Trial and Appeal Board on this 2nd day of July, 2013.

/Seth I. Appel/

Seth I. Appel