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Subject: U.S. TRADEMARK APPLICATION NO. 85520148 - THE COOLER COMPANY - N/A - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85520148

MARK: THE COOLER COMPANY



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: The Coleman Company, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

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EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has appealed the trademark examining attorney's refusal to register the trademark THE COOLER COMPANY on the ground that it is merely descriptive within the meaning of §2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1).

FACTS

The mark at issue is THE COOLER COMPANY for 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 (emphasis and underlining added). The filing basis was and remains based on an intent to use the mark in commerce. The applicant has adduced a definition of "cool" and the examining attorney has made a definition of "cooler" of record. The applicant contends its mark is a double entendre, and therefore not merely descriptive of its goods.

ARGUMENT

THE MARK IS MERELY DESCRIPTIVE BECAUSE IT APTLY DESCRIBES THE GOODS

A mark is merely descriptive if it describes a quality, characteristic, feature or use of an applicant's goods. See *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012).

A "cooler" is defined as "a device, container or room that cools or keeps cool." *The Free Dictionary* by Farlex (copy attached to the 10/29/12 Final action). The applicant's goods include coolers and other food and drink containers. As stated in *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 989, 228 USPQ 528, 530 (Fed. Cir. 1986), quoting *Weiss Noodle Co. v. Golden Cracknel & Specialty Co.*, 290 F.2d 845, 847, 129 USPQ 411, 413 (C.C.P.A. 1961), "[t]he name of a thing is in fact the ultimate in descriptiveness."

The determination of whether a mark is merely descriptive must be made in relation to the goods for which registration is sought, not in the abstract. *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012). The mark need not describe all the goods identified, as long as it merely describes one of them. See *In re Stereotaxis Inc.*, 429 F.3d 1039, 1041, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005).

Per the seminal case of *In re The Phone Co., Inc.*, 218 USPQ 1027 (TTAB 1983) (THE PHONE COMPANY merely descriptive of telephones), adding "company" to the generic name for the goods only adds another merely descriptive term (of the entity) to the proposed mark. As such,

THE COOLER COMPANY must be held to be merely descriptive of the applicant's goods.

Terms that describe the provider of a product or service may also be merely descriptive of the product and/or service. See *In re Major League Umpires*, 60 USPQ2d 1059, 1060 (TTAB 2001) (holding MAJOR LEAGUE UMPIRE merely descriptive of clothing, face masks, chest protectors and shin guards).

Here, THE COOLER COMPANY, used on or in connection with coolers, immediately indicates to consumers that the goods are coolers from a company that makes coolers – i.e., THE COOLER COMPANY. Since the mark immediately identifies a characteristic of the goods, it must be refused per Section 2(e)(1) of the Trademark Act.

THE MARK IS NOT A DOUBLE ENTENDRE

Applicant argues that THE COOLER COMPANY is not merely descriptive of coolers because applicant believes the mark to be a double entendre. Applicant's argument has been carefully considered, but found to be unpersuasive.

The multiple interpretations that make an expression a "double entendre" must be associations that the public would make fairly readily, and **must be readily apparent from the mark itself**. See *In re RiseSmart Inc.*, 104 USPQ2d 1931, 1934 (TTAB 2012) (finding that TALENT ASSURANCE does not present a double entendre such that "the merely descriptive significance of the term [TALENT] is lost in the mark as a whole").

The applicant's position is summed up by the first two sentences of the second paragraph of the 4/29/13 Request for Reconsideration:

On the one hand, THE COOLER COMPANY suggests that

Applicant offers coolers, i.e., containers for food and drink

products. On the other hand, THE COOLER COMPANY suggests that Applicant is *cooler* than other companies.

The applicant proffers a slang definition of "cool" to buttress its assertion that the mark is a double entendre. The applicant also refers to some advertisements it has prepared which state in relevant part:

COOLER NEW DESIGN – COOLER NEW COLORS – COOLER
PORTABILITY

THE COOLER COMPANY

Based on the slang meaning of "cool" and ads for goods that aren't even in use in commerce, the applicant contends that THE COOLER COMPANY is a double entendre. The first meaning is of a company that sells coolers. The alleged second meaning is of a company that is more cool than other companies.

While the applicant's intent may be to make its mark a double entendre, there is no proof that it has done so. This is an ITU application. There is no use in commerce. Thus, there is no evidence that consumers would perceive anything other than the mark's merely descriptive meaning.

More importantly, the alleged double entendre association is not readily apparent from the mark itself. The multiple meanings that make an expression a "double entendre" must be well-recognized by the public and readily apparent from the mark itself. See *In re Brown-Forman Corp.*, 81 USPQ2d 1284, 1287 (TTAB 2006) (finding GALA ROUGE not a double entendre in relation to wines and affirming requirement to disclaim ROUGE).

A "double entendre" is an expression that has a double connotation or significance as applied to the goods. See *In re Colonial Stores Inc.*, 394 F.2d 549, 552-53, 157 USPQ 382, 384-85 (C.C.P.A. 1968) (finding SUGAR & SPICE a double entendre and not descriptive for bakery products because it evokes the nursery rhyme "sugar and spice and everything nice").

Consequently, THE COOLER COMPANY does not present a double entendre such that "the merely descriptive significance of [THE COOLER COMPANY] is lost in the mark as a whole." *RiseSmart, supra*.

Since "cooler" is the generic term for some of the goods at issue, and the applicant is a company that makes and sells coolers, THE COOLER COMPANY merely describes the goods and nothing more, and must therefore be considered merely descriptive under the Trademark Act. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012).

CONCLUSION

THE COOLER COMPANY immediately describes the goods. The only meaning that is readily apparent from the mark itself is its merely descriptive connotation. Since this is an ITU case, there is no use of the mark in commerce to even try to establish a double entendre of the mark. For the foregoing reasons, the refusal to register on the basis of §2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), for the reason that the mark is merely descriptive, should be affirmed.

Respectfully submitted,