

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 REPLY BRIEF

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REPLY

Applicant The Coleman Company, Inc. ("Applicant") respectfully submits this reply to the Examining Attorney's appeal brief.

To rebut Applicant's position that its mark is a distinctive double entendre, the Examining Attorney contends that one of the meanings of THE COOLER COMPANY – that Applicant is *cooler* than other companies – is not readily apparent to consumers. On the contrary, this meaning of THE COOLER COMPANY, which rests on the universally-accepted slang definition of "cool," is evident from the face of the mark. This definition appears in countless dictionaries and has been recognized by the Board on multiple occasions. There is hardly a consumer alive unfamiliar with the slang definition of "cool."

In addition, the Examining Attorney implies, without support, that Applicant's mark cannot be a double entendre because it is not in use. However, Applicant's mark is in use. Applicant filed an amendment to allege use on August 21, 2013.

I. Applicant's Double Entendre is Readily Apparent from the Mark Itself.

Both meanings of THE COOLER COMPANY are "associations that the public would make fairly readily," and they are "readily apparent from the mark itself." T.M.E.P. § 1213.05(c). First, THE COOLER COMPANY conveys that Applicant offers coolers, along with hundreds of other outdoor recreation products. Second, THE COOLER COMPANY suggests that Applicant is *cooler* than its competitors, and *cooler* than Applicant has been in the past. The latter involves the slang definition of "cool," that is, "fashionable" or "hip." As discussed in Applicant's opening brief, this definition can be found in virtually any dictionary, including

Merriam-Webster and the American Heritage dictionaries.¹ As stated on Wikipedia – which includes an entire entry for "Cool (aesthetic)":

Although commonly regarded as slang, it is widely used among disparate social groups, and has endured in usage for generations.

See http://en.wikipedia.org/wiki/Cool_%28aesthetic%29.

The Board itself has already recognized this slang meaning of "cool" on multiple occasions. In *Mattel, Inc. v. Leonard Stitz*, Opposition No. 91117536, 2004 WL 1090659, at *5 (T.T.A.B. April 20, 2004), the Board observed: "It is clear from the dictionary definitions of which we have taken judicial notice that HOT and COOL have numerous informal and slang meanings."

The Board also recognized the dual meanings of "cool" in *Cool Gear International, Inc. v. Carla Dahl*, Opposition No. 91153361, 2004 WL 1703102, at *2 (T.T.A.B. July 22, 2004) non-precedential) (COOL.-GEAR "possesses a double entendre since [the applicant's] goods ... 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."). In another instance, relying on these dual meanings, an applicant overcame a descriptiveness refusal regarding its mark, BIG COOL BAG, for "thermal insulated tote bags for food." *In re H.E. Butt Grocery Co.*, 2004 WL 624566 (T.T.A.B. March 23, 2004) (Examining attorney withdrew descriptiveness refusal based on applicant's argument that "while COOL may be suggestive of a function of the bag in keeping frozen foods 'cold' it also presents a double entendre in the context of the overall mark BIG COOL BAG as being a 'hip' product.").

In support of his position that the slang meaning of THE COOLER COMPANY is not readily apparent, the Examining Attorney cites *In re Brown-Forman Corp.*, 81 U.S.P.Q.2d 1284

¹ See <http://www.merriam-webster.com/dictionary/cool> and <http://www.ahdictionary.com/word/search.html?q=cool>.

(T.T.A.B. 2006). That case is distinguishable and, if anything, it supports Applicant's position. In *Brown-Forman*, the applicant sought registration of GALA ROUGE for wines. The Board affirmed the requirement that the applicant disclaim "ROUGE" (i.e., "red" in French) because it was merely descriptive of a color or type of wine. It rejected the applicant's claim that GALA ROUGE was a unitary expression, with "ROUGE" modifying "GALA".

"Red gala" has no obvious, immediate and inherent unitary significance which would cause purchasers to view ROUGE as modifying GALA, rather than as describing the wine. ... The mere grammatical coherence of "red gala" does not suffice to make GALA ROUGE a unitary expression in the eyes of purchasers.

Id. at 1288. Here, by contrast, the slang meaning of THE COOLER COMPANY - a company cooler than other companies - is obvious. Applicant uses THE COOLER COMPANY as a double entendre not simply because of its "grammatical coherence," but because it suggests a positive aspect of Applicant's business.

The other case cited by the Examining Attorney for this point, *In re RiseSmart*, 104 U.S.P.Q.2d 1931 (T.T.A.B. 2012), is also distinguishable. There, the Board required the applicant to disclaim "TALENT" in its mark, TALENT ASSURANCE for personnel placement and recruitment services. It rejected the applicant's double entendre claim because the two alleged meanings of "TALENT" were essentially the same, and therefore, the descriptive significance of that term was not "lost in the mark as a whole." *Id.* at 1934. The two meanings of THE COOLER COMPANY are quite different, and both are evident to consumers.

In addition, the Examining Attorney relies, as he did in his previous rejections, on *In re The Phone Co., Inc.*, 218 U.S.P.Q. 1027 (T.T.A.B. 1983), which he calls "the seminal case." In *The Phone Co.*, the Board found that THE PHONE COMPANY was merely descriptive for the applicant's telephone products. The applicant did not claim that its mark was a double entendre -

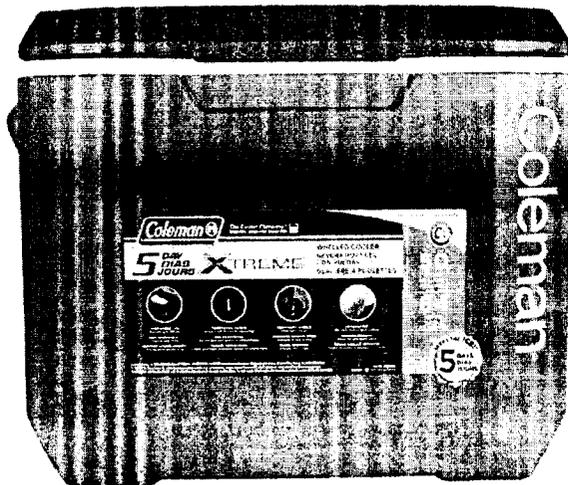
because it was not. "PHONE" has only one meaning. "COOLER" has two. *The Phone Co.* is not relevant to the present situation.

By contrast, the several cases cited in Applicant's opening brief are on point, and confirm that an inventive double entendre such as THE COOLER COMPANY is not merely descriptive. *See, e.g., In re Delaware Punch Company*, 186 U.S.P.Q. 63 (T.T.A.B. 1975) (THE SOFT PUNCH not merely descriptive for noncarbonated soft drink); *In re Delta T Corp.*, Serial No. 85310163, 2012 WL 5196152 (T.T.A.B. Sept. 24, 2012) (non-precedential) (SMASHINGLY DURABLE not merely descriptive for fans).

II. Applicant's Mark is in Use.

In his appeal brief, the Examining Attorney emphasizes, for the first time, his belief that Applicant's mark is not in use. Even if this were true, it would not matter, because the double entendre in Applicant's mark is apparent from the face of the mark itself. In any event, Applicant's mark is in use.

As discussed in Applicant's opening brief, Applicant uses THE COOLER COMPANY in promotional materials, including its website and a recent advertisement in *Outside Magazine*. [Br., pp. 3-4] These materials highlight the dual meanings of THE COOLER COMPANY. Moreover, since approximately January 2012, this mark has appeared on goods identified in the present application. Below is one of Applicant's coolers bearing THE COOLER COMPANY mark, which are sold throughout the United States, followed by a close-up image of the label:



Applicant filed an amendment to allege use on August 21, 2013.²

Thus, the Examining Attorney's statement that "there is no use in commerce" is both inapposite and incorrect.

² Applicant also filed a request to divide because the mark is not yet in use for all goods identified in the application. Applicant also deleted certain goods from the application.

CONCLUSION

Any doubts regarding the distinctiveness of THE COOLER COMPANY must be resolved in favor of Applicant. *In re Intelligent Medical Systems Inc.*, 5 U.S.P.Q.2d 1674, 1676 (T.T.A.B. 1987); *In re Conductive Systems, Inc.*, 220 U.S.P.Q. 84, 86 (T.TAB 1983). For the reasons discussed above, and in Applicant's opening brief, THE COOLER COMPANY is an inventive double entendre. This mark has two distinct meanings that are readily apparent to consumers, and at least one of the meanings is not merely descriptive. Therefore, THE COOLER COMPANY is a distinctive trademark entitled to registration on the Principal Register.

Date: August 21, 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 REPLY BRIEF** was electronically transmitted to the Trademark Trial and Appeal Board on this 21st day of August, 2013.

/Seth I. Appel/

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