

ESTTA Tracking number: **ESTTA716667**

Filing date: **12/28/2015**

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

| | |
|------------------------|--|
| Proceeding | 86513069 |
| Applicant | Carden, Harvey |
| Applied for Mark | CHRONIC ILLNESS ASSOCIATION |
| Correspondence Address | CARDEN, HARVEY 8313 E Arrowhead Way Anaheim, CA 92808-2374 UNITED STATES CardenCompany@yahoo.com |
| Submission | Applicants Request for Remand and Amendment |
| Attachments | Motion to Remand.pdf(123841 bytes) Motion to Remand - Exhibit 1 - Request to Reconsider.pdf(428137 bytes) |
| Filer's Name | Matthew H. Swyers |
| Filer's e-mail | mswyers@TheTrademarkCompany.com |
| Signature | /Matthew H. Swyers/ |
| Date | 12/28/2015 |

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of Harvey Carden
Serial No. 86513069
Trademark: CHRONIC ILLNESS ASSOCIATION
Filing Date: Jan. 23, 2015

MOTION TO REMAND APPLICATION

COMES NOW the Applicant Harvey Carden (hereinafter “Applicant”), by and through counsel The Trademark Company, and pursuant to TBMP § 1209.04 respectfully moves the Trademark Trial and Appeal Board (hereinafter “Board”) for an order remanding the instant Application to the examination level so that the Examining Attorney may consider the attached Request for Reconsideration.

By way of history, Applicant applied to register the trademark CHRONIC ILLNESS ASSOCIATION for use in connection with the following services:

“Charitable fundraising services for people with chronic illnesses” in International Class 36.

To this end, the application was refused registration pursuant to Section 2(e)(1). Applicant, *pro se* at the time, never truly presented an argument in support of registration at the examination level. To this end, Applicant recently retained the undersigned to assist in the prosecution of this matter including, but not limited to, filing a full response to the original office action refusing registration of the instant application.

Applicant is not making this motion to delay the proceedings but in good faith so that an argument in support of registration by Applicant’s new counsel can be considered by the

Examining Attorney and, it is hoped, remove from an impediment the refusal to register the trademark.

Accordingly, pursuant to TBMP § 1209.04 it is respectfully requested that the Board grant the instant motion and remand the matter to the Examining Attorney so that the Examining Attorney may make of record and consider the Request for Reconsideration attached hereto as Exhibit 1.

WHEREFORE it is respectfully submitted that good cause exists and/or the TBMP provides that the instant request be granted and the application be remanded to the Examining Attorney for further consideration of the Application and arguments set forth by Applicant's new counsel.

Respectfully submitted this 28th day of December, 2015

The Trademark Company, PLLC

/Matthew H. Swyers/

Matthew H. Swyers, Esq.

344 Maple Avenue West, PMB 151

Vienna, VA 22180

Telephone (800) 906-8626 x100

Facsimile (270) 477-4574

mswyers@TheTrademarkCompany.com

Counsel for Applicant

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of Harvey Carden
Serial No. 86513069
Trademark: CHRONIC ILLNESS ASSOCIATION
Filing Date: Jan. 23, 2015

REQUEST TO RECONSIDER

COMES NOW, the Applicant Harvey Carden (hereinafter "Applicant") by Counsel Matthew H. Swyers, Esq. of The Trademark Company, PLLC, and respectfully requests the Examining Attorney to reconsider the refusal of the instant application on the grounds of Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); 37 C.F.R. §2.64(a), stating as follows:

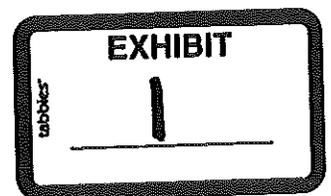
**ARGUMENT IN SUPPORT OF REGISTRATION
Refusal under Section 2(e)(1) of the Trademark Act of 1946**

The Examining Attorney refused registration based upon a finding that the mark is merely descriptive of the Applicant's services. Insofar as Applicant's proposed mark is not merely descriptive of the services identified in the application, Applicant respectfully submits that there is no basis to maintain the instant refusal and that registration of the Applicant's trademark is appropriate.

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 (CCPA 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 (hereinafter "the 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 (CCPA 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 USPQ2d 1370, 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.

However, use of a descriptive term in conjunction with other distinguishing elements does not render the entire mark "merely descriptive". Instead, 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 USPQ 505, 507 (CCPA 1980) (*emphasis added*). In the

context of the 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 USPQ 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 USPQ 237, 238 (TTAB 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 is tasked with considering 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).

Applicant respectfully submits that the instant mark is suggestive of the Applicant’s services and not merely descriptive as contended by the Examining Attorney.

If a consumer has to exercise “mature thought or follow a multi-stage reasoning process” to determine the characteristics of a product or service, then the mark is suggestive, not descriptive. *In re Tennis in the Round, Inc.* 199 USPQ 496, 498 (TTAB 1978) (“This association of applicant’s mark with the phrase ‘theater-in-the-round’ creates an incongruity...,” thus TENNIS IN THE ROUND is not merely descriptive of tennis facilities.). *See also, Blisscraft of Hollywood v. United Plastics Co.* 294 F.2d. 694, 131 USPQ 55 (2d. Cir. 1961) (POLY PITCHER not merely descriptive of polyethylene pitchers;

suggestive of Molly Pitcher of Revolutionary time); *In re Colonial Stores, Inc.* 394 F.2d 549, 157 USPQ 382 (CCPA 1968) (SUGAR & SPICE not merely descriptive of bakery products; suggestive of nursery rhyme); *Douglas Laboratories Corp. v. Copper Tan, Inc.* 210 F.2d 453, 100 USPQ 237 (2d Cir. 1954), cert. denied 347 U.S. 968, 101 USPQ 505 (1954) (finding COPPERTONE for sun tan oil suggestive, not descriptive); *In re Realistic Co.* 440 F.2d 1393, 169 USPQ 610 (CCPA 1971) (finding CURV for permanent wave solution suggestive, not descriptive); and, *Colgate-Palmolive Co. v. House for Men, Inc.* 143 USPQ 159 (TTAB 1964) (finding RAPID-SHAVE for shaving cream suggestive, not descriptive).

In *Equine Technologies Inc. v. Equitechology Inc.* 68 F.3d 542 (1st Cir. 1995), the court was required to determine whether the mark EQUINE TECHNOLOGIES was descriptive or suggestive when used in connection with high-tech hoof pads for horses. The court cited authorities indicating that the hallmark of the descriptive term is a specific identification of the marked good. *Id.* at 544. In holding the mark EQUINE TECHNOLOGIES to be correctly characterized as suggestive rather than descriptive, the court noted that while there is no dispute that the term “equine” is descriptive of horses, the question is whether the mark, in its entirety, is merely descriptive of the plaintiff’s product — hoof pads for horses. *Id.* at 545. In this case, the court found that the mark itself does not convey information about the plaintiff’s products or its intended consumers. Rather, it requires imagination to connect the term “Equine Technologies” to hoof care products in general, and to the plaintiff’s product in particular.

In *Ex Parte Club Aluminum Products Co.* 105 USPQ 44 (Commissioner 1955), the mark COOK-N-LOOK was held registrable for transparent glass covers for cooking utensils. The mark was somewhat suggestive of a property the goods might have, but like Applicant’s mark, did not describe the goods *per se*:

The mark is a compound word mark which describes what one who uses the covers can do, *i.e.* look into the utensil to see the cooking process, but this does not make the mark descriptive of the covers. The necessity for analysis removes it from the category of mere descriptiveness.

Id.

In *Independent Nail & Packing Co. v. Stronghold Screw Products, Inc.* 205 F.2d 921, 925 (Cir. 1953), cert. denied 346 U.S. 491 (1953), the court held that STRONGHOLD as applied to ribbed nails was not descriptive, stating that:

Although the word ‘stronghold’ is suggestive of one of the attributes of plaintiff’s nail with the annular thread, it is not descriptive of a nail, let alone that type of nail. A person unaware of the particular product of the manufacturer, upon seeing or hearing the name ‘stronghold’ would find it virtually impossible to identify the product to which it might have been applied.
Id.

In *Worthington Foods, Inc. v. Kellogg Co.* 732 F. Supp. 1417, 1435 (S.D. Ohio 1990), the court found that a multi-stage reasoning process was necessary before a consumer could understand the message conveyed by the mark HEARTWISE, that is, food which is healthful for the heart. The court also noted that assuming HEARTWISE meant “wise for one’s heart,” it might refer to a large number of goods or services such as running shoes, a treadmill, a calorie counter, or an Ann Landers newspaper column. The court held that HEARTWISE was a suggestive rather than descriptive mark as the consumer could not directly cull a message concerning the healthful characteristics of the goods simply from looking at the mark.

A brief review of other suggestive marks helps clarify this dichotomy:

- (1) SUGAR & SPICE for use on bakery products held to be suggestive not descriptive. *In re Colonial Stores, Inc.* 394 F.2d 549, 157 USPQ 382 (CCPA 1968).
- (2) 100 YEAR NITE-LITE for light with life expectancy of 500 years held to be suggestive not descriptive. *Donsky v. Bandwagon, Inc.* 193 USPQ 336 (D. Mass. 1976).
- (3) TENNIS IN THE ROUND held not descriptive of tennis facilities. *In re Tennis in the Round, Inc.* 199 USPQ 496 (TTAB 1978).
- (4) RAILROAD SALVAGE for sale of goods from bankruptcy liquidations and discontinued goods held to be suggestive. *Railroad Salvage of Comm., Inc. v. Railroad Salvage, Inc.* 561 F.Supp. 1014 (D.R.I. 1983).
- (5) UNDERNEATH IT ALL for undergarment products held to be suggestive in *Maidenform, Inc. v. Munsingwear, Inc.* 195 USPQ 297 (SDNY 1977).
- (6) CITIBANK for urban banking services held to be suggestive in *Citibank, N.A. v. Citibanc Group, Inc.* 724 F.2d 1540 (11th Cir. 1984).

(7) CHARRED KEG for bourbon whiskey held to be suggestive, even though bourbon is an American-type whiskey that is made in part by aging carried out in new charred oaken containers. *In re Majestic Distilling Co., Inc.* 164 USPQ 386 (CCPA 1970).

(8) LONGTONG for barbecue tongs held to be suggestive in *Ex parte Nixdorff Krein Mfg Co.*, 115 USPQ 362 (Comm. Pat. 1957).

(9) BRAKLEEN for a brake parts cleaner held to be suggestive and not descriptive in *C.J. Webb, Inc.* 182 USPQ 63 (TTAB 1974).

(10) DRI-FOOT held to be suggestive of foot deodorant in *In re Pennwalt Corp.* 173 USPQ 317 (TTAB 1972).

(11) CHEW 'N CLEAN was held not to be descriptive of tooth powder in *In re Colgate-Palmolive Company* 160 USPQ 733 (CCPA 1969).

(12) COPPERTONE was found not to be descriptive of a suntan preparation in *Douglas Lab Corp. v. Copper Tan, Inc.* 210 F.2d 453, 100 USPQ 237 (2d Cir. 1954), cert denied 347 U.S. 968 (1954).

In the present case, the “mental link” between the trademark CHRONIC ILLNESS ASSOCIATION and the Applicant’s services as identified in the application is neither immediate nor instantaneous.

Applicant’s Trademark is Suggestive Under the TTAB’s Three-Part Test

The Trademark Trial and Appeal Board has adopted a three-part test to help determine whether a mark is descriptive or suggestive:

- (1) The degree of imagination necessary to understand the product;
- (2) A competitor’s need to use the same terms; and
- (3) Competitors’ current use of the same or similar terms.

See No Nonsense Fashions, Inc. v. Consolidated Food Corp., 226 USPQ 502 (TTAB 1985).

(1) Degree of Imagination

Under the degree of imagination test, the greater the number of “imaginative steps” required for a consumer to arrive at a tolerably accurate or direct description of the product or service from the mark itself, the more likely the term is accurately characterized as “suggestive” and not “merely descriptive”.

See Railroad Salvage of Connecticut, Inc. v. Railroad Salvage, Inc., 561 Fed. 1014 (DCRI 1983). Since

there is no instantaneous connection as to the nature of the services provided by the Applicant, it is far more likely that the trademark is correctly deemed suggestive rather than descriptive. *See Stix Products, Inc. v United Merchants and Manufacturers, Inc.*, 295 Fed. Supp. 479 (SDNY 1968).

(2) Competitor's Need to Use Applicant's Trademark

Next, we consider Applicant's competitor's need to use Applicant's Trademark. Provided that alternative wording exists this part of the test favors registration of the Applicant's trademark. In the instant case, it is clear that Applicant's competitors have numerous choices in regard to alternative language that can be used to identify their own respective services.

Specifically, Applicant's competitors could use the following: LONG-LASTING SICKNESS ASSOCIATION, HABITUAL DISEASE ASSOCIATION, or CONTINUAL MALADY ASSOCIATION. Accordingly, in consideration of this second factor, it is again far more likely that the trademark is accurately categorized as suggestive rather than descriptive.

(3) Competitor's Current Use of Applicant's Trademark

Finally, we consider Applicant's actual competitor's current use of the trademark at issue. There is little evidence of such use. Moreover, the use, if any, that has been provided, should not be deemed persuasive as those competitors are, in the Applicant's view, making unauthorized use and potentially infringing upon Applicant's trademark and may soon have to answer to Applicant for these transgressions.

That being said, it is requested that the evidence provided, limited in nature, and most likely simply of infringing activity, should also not be considered to support a finding of descriptiveness.

In the instant case, although the Examining Attorney may find that the first two prongs of this analysis may be satisfied, the third prong cannot. Specifically, based upon AcronymFinder.com, the applied-for Trademark is not a well-known or popular acronym for the

specific wording at issue here. As such, under the aforementioned test the acronym as applied for is not descriptive and, accordingly, the refusal should be withdrawn.

CONCLUSION

In sum, applying the Trademark Trial and Appeal Board's tests and relevant standards to the refusal at hand, the relevant consuming public would not form an immediate impression of the features, functions, qualities or characteristics of the goods claimed by Applicant by mere sight of the trademark at issue. In view of the above arguments, Applicant believes that the proposed mark is entitled to registration on the Principal Register.

If, however, the Examining Attorney remains unsure, the Office is respectfully reminded that because of the thin line between suggestive and descriptive marks, it is the practice of the USPTO to resolve doubt in Applicant's favor and publish the mark for opposition. *See In re Morton-Norwich Products, Inc.* 209 USPQ 791 (TTAB 1981); and *In re Grand Metropolitan Foodservice Inc.* 30 USPQ2d 1974, 1976 (TTAB 1994).

WHEREFORE the Applicant Harvey Carden, by Counsel respectfully requests the Examining Attorney to reconsider the refusal under Section 2(e)(1) of the Trademark Act of 1946 and allow the publication of CHRONIC ILLNESS ASSOCIATION on the Principal Register.

Respectfully submitted this 28th day of December, 2015

The Trademark Company, PLLC

/Matthew H. Swyers/

344 Maple Avenue West, PMB 151

Vienna, VA 22180

Tel. (800) 906-8626 x100

Facsimile (270) 477-4574

mswers@thetrademarkcompany.com