

PTO Form 1957 (Rev 9/2005)

OMB No. 0651-0050 (Exp. 04/2009)

Response to Office Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	78667452
LAW OFFICE ASSIGNED	LAW OFFICE 116
MARK SECTION (no change)	
ARGUMENT(S)	
<p><u>REQUEST FOR RECONSIDERATION</u></p> <p>In an Office Action dated September 28, 2006, the Examining Attorney maintained and made final the refusal to register Applicant's mark on the basis that the mark LUXURY PORTFOLIO FINE BROKER COLLECTION & Design is merely descriptive of Applicant's goods. However, the Applicant respectfully disagrees with the Examiner's refusal based on descriptiveness and, in light of the arguments set forth below, requests reconsideration of the application.</p> <p style="text-align: center;"><u>REMARKS REGARDING REFUSAL UNDER SECTION 2(e)(1)</u></p> <p>The Examining Attorney refused registration, citing concerns that the mark is primarily merely descriptive. As previously argued, a mark is merely descriptive only if it "immediately describes" the Applicant's goods or services with <i>particularity</i>. <i>In re Econoheat Inc.</i>, 218 U.S.P.Q. 381, 383 (T.T.A.B. 1983) (SOLAR QUARTZ held suggestive, not descriptive, of infrared heaters); <i>In re Vaughn Furniture Co.</i>, 24 U.S.P.Q. 1068, 1069 (T.T.A.B. 1992) ("While furniture making may be considered a craft, this does not make PINE CRAFTS merely descriptive of furniture."); <i>In re George Weston Limited</i>, 228 U.S.P.Q. 57, 58 (T.T.A.B. 1985) (SPEEDI BAKE does not convey an immediate idea of the ingredients, qualities or characteristics of dough that quickly bakes into bread); <i>In re Pennwalt Corp.</i>, 173 U.S.P.Q. 317, 319 (T.T.A.B. 1972) (DRI-FOOT held suggestive, not descriptive, of foot antiperspirant). Furthermore, for a mark to be merely descriptive, it must serve no other function than to describe some characteristic of the product or service at issue. See <i>In re Colonial Stores, Inc.</i>, 157</p>	

U.S.P.Q. 382, 385 (C.C.P.A. 1968) (SUGAR 'N SPICE found not merely descriptive of bakery goods because the "mark clearly does not tell the potential purchaser *only* what the goods are, their function, their characteristics or their use") (emphasis in the original).

The fact that a trademark serves not only to identify the source of particular goods or services, but also provides some information to the public as to the nature of those goods or services is not a bar to registration. 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS §11:19 (4th ed. 2002). See also Glamorene Products Corp. v. Boyle-Midway, Inc., 188 U.S.P.Q. 145 (S.D.N.Y 1975) (finding that the mark SPRAY 'N VAC is not merely descriptive of a no scrub rug cleaner and stating "a mark is not merely descriptive unless descriptiveness is its *principal significance*. A mark is not descriptive if it merely suggests the nature or class of the product on which it is used"). Indeed, in *In re The House Store, Ltd.*, 221 U.S.P.Q. 92 (T.T.A.B. 1983), the Board faced similar facts and found the applicant's THE HOUSE STORE service mark suggestive for retail store services in the field of furniture and housewares sales. The Examining Attorney had refused registration, stating that the mark conveyed information regarding the overall theme or motif of applicant's services – selling goods for one's house. The Board reversed, explaining that the word "house" encompassed a much broader range of goods than those sold by the applicant, and therefore fell short of describing applicant's services with a sufficient amount of particularity, and that the discrepancies between what the applicant actually sold and what might be conjured up by the word "house" created an incongruity. 221 U.S.P.Q. at 92-93.

Similarly, in *Equine Technologies, Inc. v. Equitechnology, Inc.*, 36 U.S.P.Q.2d 1659 (1st Cir. 1995), the court held that plaintiff's EQUINE TECHNOLOGIES mark was suggestive of hoof pads for horses. The court stated that the mark was too broad to "convey information about plaintiff's product or its intended consumers," and that "[s]imply hearing the name gives virtually no idea of the product except that it has to do with horses." *Id.* at 1662. Likewise, in *In re TMS Corporation of the Americas*, 200 U.S.P.Q. 57, 59 (T.T.A.B. 1978), the Board determined that THE MONEY SERVICE as used for money transfer services was too broad to describe the Applicant's services with immediacy and particularity and was thus suggestive rather than descriptive, noting as follows:

because the mark "THE MONEY SERVICE" is composed of commonly used words of the English language it suggests a number of things, but yet falls short of describing applicant's service in any degree of particularity.

Like the trademarks in these cited cases, the LUXURY PORTFOLIO FINE BROKER COLLECTION &

design mark also suggests, but does not describe or convey information with *any degree of particularity*. See *In re The House Store, Ltd.*, 221 U.S.P.Q. at 92-93.

Applicant uses its LUXURY PORTFOLIO FINE BROKER COLLECTION & Design mark in connection with electronic or print publications in the field of real estate. The Examining Attorney points out that the term "luxury" can be defined as an adjective meaning "luxurious, or of the character of a luxury," while the term "portfolio" can be defined as "the complete range of products or designs offered by a company." The Examining Attorney also states that the term "fine" can be defined as "outstanding" and the term "broker" can be defined as a "commercial agent." While this may be true, many of these terms have several meanings and the LUXURY PORTFOLIO FINE BROKER COLLECTION & Design mark, when taken in its entirety, does not immediately tell a consumer about the Applicant's products with any degree of particularity. Indeed, the mark does not convey that Applicant's products are real estate related.

As in *In re The House Store, Ltd.* and *Equine Technologies, Inc.*, the Applicant's proposed mark is too broad to "convey information about plaintiff's product or its intended consumers," and that "[s]imply hearing the name gives virtually no idea of the product except that it has to do with horses." *Equine Technologies, Inc.* at 1662. Accordingly, Applicant's mark is at most suggestive, not merely descriptive.

Finally, it is well-established that any doubts as to descriptiveness should be resolved in favor of Applicant. "[T]here is a thin line between a suggestive and a merely descriptive designation, an where reasonable men may differ, it is the Board's practice to resolve the doubt in the Applicant's favor and publish the mark for opposition." *In re Morton-Norwich Prods., Inc.*, 209 U.S.P.Q. 791 (T.T.A.B. 1981).

IV. Conclusion

In view of the foregoing, and since a search of the Office records did not locate any similar marks that would bar registration, Applicant respectfully requests that its application be passed on to publication.

SIGNATURE SECTION	
RESPONSE SIGNATURE	/Natalie Kernisant/
SIGNATORY'S NAME	Natalie Kernisant
SIGNATORY'S POSITION	Attorney

DATE SIGNED	03/28/2007
AUTHORIZED SIGNATORY	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Wed Mar 28 18:33:22 EDT 2007
TEAS STAMP	USPTO/ROA-206.181.141.34- 20070328183322568489-7866 7452-37057b4bd6c2133138ff 3e6616f4619451-N/A-N/A-20 070328182944204858

PTO Form 1957 (Rev 9/2005)

OMB No. 0651-0050 (Exp. 04/2009)

Response to Office Action

To the Commissioner for Trademarks:

Application serial no. **78667452** has been amended as follows:

Argument(s)

In response to the substantive refusal(s), please note the following:

REQUEST FOR RECONSIDERATION

In an Office Action dated September 28, 2006, the Examining Attorney maintained and made final the refusal to register Applicant's mark on the basis that the mark LUXURY PORTFOLIO FINE BROKER COLLECTION & Design is merely descriptive of Applicant's goods. However, the Applicant respectfully disagrees with the Examiner's refusal based on descriptiveness and, in light of the arguments set forth below, requests reconsideration of the application.

REMARKS REGARDING REFUSAL UNDER SECTION 2(e)(1)

The Examining Attorney refused registration, citing concerns that the mark is primarily merely descriptive. As previously argued, a mark is merely descriptive only if it "immediately describes" the Applicant's goods or services with *particularity*. *In re Econoheat Inc.*, 218 U.S.P.Q. 381, 383 (T.T.A.B. 1983) (SOLAR QUARTZ held suggestive, not descriptive, of infrared heaters); *In re Vaughn Furniture Co.*, 24 U.S.P.Q. 1068, 1069 (T.T.A.B. 1992) ("While furniture making may be considered a craft, this does not make PINE CRAFTS merely descriptive of furniture."); *In re George Weston Limited*, 228

U.S.P.Q. 57, 58 (T.T.A.B. 1985) (SPEEDI BAKE does not convey an immediate idea of the ingredients, qualities or characteristics of dough that quickly bakes into bread): *In re Pennwalt Corp.*, 173 U.S.P.Q. 317, 319 (T.T.A.B. 1972) (DRI-FOOT held suggestive, not descriptive, of foot antiperspirant).

Furthermore, for a mark to be merely descriptive, it must serve no other function than to describe some characteristic of the product or service at issue. See *In re Colonial Stores, Inc.*, 157 U.S.P.Q. 382, 385 (C.C.P.A. 1968) (SUGAR 'N SPICE found not merely descriptive of bakery goods because the "mark clearly does not tell the potential purchaser *only* what the goods are, their function, their characteristics or their use") (emphasis in the original).

The fact that a trademark serves not only to identify the source of particular goods or services, but also provides some information to the public as to the nature of those goods or services is not a bar to registration. 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS §11:19 (4th ed. 2002). See also *Glamorene Products Corp. v. Boyle-Midway, Inc.*, 188 U.S.P.Q. 145 (S.D.N.Y. 1975) (finding that the mark SPRAY 'N VAC is not merely descriptive of a no scrub rug cleaner and stating "a mark is not merely descriptive unless descriptiveness is its *principal significance*. A mark is not descriptive if it merely suggests the nature or class of the product on which it is used"). Indeed, in *In re The House Store, Ltd.*, 221 U.S.P.Q. 92 (T.T.A.B. 1983), the Board faced similar facts and found the applicant's THE HOUSE STORE service mark suggestive for retail store services in the field of furniture and housewares sales. The Examining Attorney had refused registration, stating that the mark conveyed information regarding the overall theme or motif of applicant's services – selling goods for one's house. The Board reversed, explaining that the word "house" encompassed a much broader range of goods than those sold by the applicant, and therefore fell short of describing applicant's services with a sufficient amount of particularity, and that the discrepancies between what the applicant actually sold and what might be conjured up by the word "house" created an incongruity. 221 U.S.P.Q. at 92-93.

Similarly, in *Equine Technologies, Inc. v. Equitechnology, Inc.*, 36 U.S.P.Q.2d 1659 (1st Cir. 1995), the court held that plaintiff's EQUINE TECHNOLOGIES mark was suggestive of hoof pads for horses. The court stated that the mark was too broad to "convey information about plaintiff's product or its intended consumers," and that "[s]imply hearing the name gives virtually no idea of the product except that it has to do with horses." *Id.* at 1662. Likewise, in *In re TMS Corporation of the Americas*, 200 U.S.P.Q. 57, 59 (T.T.A.B. 1978), the Board determined that THE MONEY SERVICE as used for money transfer services was too broad to describe the Applicant's services with immediacy and particularity and was thus suggestive rather than descriptive, noting as follows:

because the mark "THE MONEY SERVICE" is composed of commonly used words of the English language it suggests a number of things, but yet falls short of describing applicant's service in any degree of particularity.

Like the trademarks in these cited cases, the LUXURY PORTFOLIO FINE BROKER COLLECTION & design mark also suggests, but does not describe or convey information with *any degree of particularity*. See *In re The House Store, Ltd.*, 221 U.S.P.Q. at 92-93.

Applicant uses its LUXURY PORTFOLIO FINE BROKER COLLECTION & Design mark in connection with electronic or print publications in the field of real estate. The Examining Attorney points out that the term "luxury" can be defined as an adjective meaning "luxurious, or of the character of a luxury," while the term "portfolio" can be defined as "the complete range of products or designs offered by a company." The Examining Attorney also states that the term "fine" can be defined as "outstanding" and the term "broker" can be defined as a "commercial agent." While this may be true, many of these terms have several meanings and the LUXURY PORTFOLIO FINE BROKER COLLECTION & Design mark, when taken in its entirety, does not immediately tell a consumer about the Applicant's products with any degree of particularity. Indeed, the mark does not convey that Applicant's products are real estate related.

As in *In re The House Store, Ltd.* and *Equine Technologies, Inc.*, the Applicant's proposed mark is too broad to "convey information about plaintiff's product or its intended consumers," and that "[s] imply hearing the name gives virtually no idea of the product except that it has to do with horses." *Equine Technologies, Inc.* at 1662. Accordingly, Applicant's mark is at most suggestive, not merely descriptive.

Finally, it is well-established that any doubts as to descriptiveness should be resolved in favor of Applicant. "[T]here is a thin line between a suggestive and a merely descriptive designation, and where reasonable men may differ, it is the Board's practice to resolve the doubt in the Applicant's favor and publish the mark for opposition." *In re Morton-Norwich Prods., Inc.*, 209 U.S.P.Q. 791 (T.T.A.B. 1981).

IV. Conclusion

In view of the foregoing, and since a search of the Office records did not locate any similar marks that would bar registration, Applicant respectfully requests that its application be passed on to publication.

Response Signature

Signature: /Natalie Kernisant/ Date: 03/28/2007
Signatory's Name: Natalie Kernisant
Signatory's Position: Attorney

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

Serial Number: 78667452
Internet Transmission Date: Wed Mar 28 18:33:22 EDT 2007
TEAS Stamp: USPTO/ROA-206.181.141.34-200703281833225
68489-78667452-37057b4bd6c2133138ff3e661
6f4619451-N/A-N/A-20070328182944204858