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

Proceeding	85637294
Applicant	Innovation Ventures, LLC
Applied for Mark	HOURS OF ENERGY NOW
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application of
Innovation Ventures, LLC

Mark: HOURS OF ENERGY NOW

Serial No.: 85/637294
Filed: 12/12/2013

Examining Attorney:
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APPLICANT'S REPLY BRIEF

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INTRODUCTION

Applicant respectfully submits this Reply Brief in response to the Examining Attorney's Appeal Brief filed on November 21, 2013. Applicant seeks registration of the mark "HOURS OF ENERGY NOW" for the following goods:

International Class 005: Dietary supplements

International Class 032: Non-alcoholic liquids for human consumption, namely energy shots.

Applicant is appealing the Examining Attorney's final refusal under Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051, 1052, 1112, and 1127, that the "HOURS OF ENERGY NOW" mark is merely descriptive and fails to function as a trademark on the specimen of record.

SUMMARY OF PROCEEDINGS

In his November 21, 2013 brief, the Examining Attorney filed his Appeal Brief on November 21, 2013, withdrew the descriptiveness refusal (Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1)) but maintained his refusal that the applied-for-mark fails to function as a trademark (Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051-1052, and 1127), Applicant now files its timely Reply Brief and asserts that the Examining Attorney's remaining refusal has been overcome. Accordingly, Applicant respectfully requests that this Board grant the the applied-for- mark to be approved for publication.

ARGUMENT

The Examining Attorney has failed to meet his burden of showing the applied-for-mark "HOURS OF ENERGY NOW" fails to function as a trademark to indicate source.

The critical inquiry in determining whether a slogan or term functions as a trademark is how the proposed mark would be perceived by the relevant public. *In re Eagle Crest, Inc.* 96 USPQ 2d 1227, 1229-30 (TTAB 2010). If there is any doubt as to the character of the Applicant's mark, that doubt must be resolved in favor of the Applicant. *In re Shutts*, 217 USPQ 363 (TTAB 1983). The examining attorney has the burden to provide evidence that the mark is a slogan or term incapable of being perceived as a trademark. TMEP §1202.04. Applicant's mark is not a phrase that is merely informational and does not constitute a common term or slogan in Applicant's industry; is recognized by consumers as a source indicator; as used on the specimen of record shows that the mark is used is as a trademark to distinguish and identify Applicant as the source of its goods; the Examining Attorney has failed to present evidence that the applied-for-mark is incapable of being perceived as a trademark.

I. "HOURS OF ENERGY NOW" IS NOT INFORMATIONAL MATTER.

The Examining Attorney maintains his refusal of the applied-for-mark as being informational matter premised upon TMEP §§904.07(b) and 1202.04. "Slogans and other terms that are merely informational in nature or common laudatory phrases or statements that would ordinarily be used in business or in the particular trade or industry, are not registrable." TMEP §1202.04. "The **more** commonly a phrase is used in everyday parlance, the **less likely** the phrase will be recognized by purchasers as a trademark…." *Id.*; quoting *In re Eagle Crest*, at 1229-30 (emphasis added). Because the function of a trademark is to identify a single commercial source for particular goods or services, if consumers are accustomed to seeing a slogan used in connection with good/services from **many different sources**, it is likely that consumers would not view the slogan as a source identifier for such goods/services. *Id* (emphasis added). A slogan can function as a trademark if it is not merely descriptive and/or

merely informational. *Id*. In support of the refusal, the examining attorney must provide evidence that the mark is a slogan or term incapable of being perceived as a trademark…. This support may include evidence of decorative or informational use by other manufacturers on goods of a similar nature and evidence that the term or slogan is frequently use by parties in connection with the goods sale of their goods or services." *Id*.

A. The Applied-For-Mark Is Not Merely Informational In Nature Or Laudatory.

The Examining Attorney has accepted that the applied-for-mark is suggestive through the withdrawal of the descriptiveness refusal. Applicant argued in its Appeal Brief that the mark "HOURS OF ENERGY NOW" is suggestive of a desired result. As a desired result, the applied-for-mark suggests a potential result of the goods upon consumption and does not inform the consuming public of a characteristic, feature, function or attribute. See *In re The Noble Co*., 225 USPQ 749 (TTAB 1985). Through the withdrawal of the descriptiveness refusal, the Examining Attorney agrees that the applied-for-mark is suggestive of a desired result. Therefore, the Examining Attorney's arguments that the applied-for-mark is informational or laudatory must be disregarded.

The Examining Attorney, through his refusal, places "HOURS OF ENERGY NOW" on par with CLOTHING FACTS[1], SPECTRUM[2], DRIVE SAFELY[3], THINK GREEN[4], PROUDLY MADE IN THE USA[5], WATCH THAT CHILD[6], and FRAGILE[7], which were all refused registration for being merely informational and devoid of a source-identifying function. It is quite clear from appearance alone that the applied-for-mark is strikingly dissimilar to these

[1] *In re T.S. Designs, Inc.,* 95 USPQ2d 1669 (TTAB 2010)
[2] *In re Aerospace Optics, Inc.*, 78 USPQ2d 1861 (TTAB 2006)
[3] *In re Volvo Cars of N. Am., Inc.,* 46 USPQ2d 1455 (TTAB 1998)
[4] *In re Manco Inc.*, 24 USPQ2d 1938, 1942 (TTAB 1992)
[5] *In re Remington Prods., Inc.*, 3 USPQ2d 1714 (TTAB 1987)
[6] *In re Tilcon Warren, Inc.*, 221 USPQ 86 (TTAB 1984)
[7] *In re Schwauss,* 217 USPQ 361, 362 (TTAB 1983)

previously refused marks. "HOURS OF ENERGY NOW" does not have an informational nature as it does not inform the public of a characteristic, feature, function or attribute of the goods; it suggests a desired end result.

B. The Applied-for-Mark Is Not A Common Laudatory Phrase Ordinarily Used in The Particular Industry.

As previously stated the applied-for-mark is suggestive of a desired result and cannot now be argued that it is also a laudatory phrase. Additionally, the Examining Attorney fails to establish that the phrase is a common phrase ordinarily used in business or in the particular trade or industry. The Examining Attorney has the burden to provide evidence establishing that the phrase is commonly used in everyday parlance. Consumers will not be able to identify a single commercial source when they are accustomed to seeing a slogan from many different sources. TMEP §1202.04.

The Examining Attorney states "usage by applicant and one [of] its competitors clearly show[s] that the term is commonly used to describe a feature of energy shots." (Examining Attorney's Appeal Brief, pg. 4). This statement is erroneous for numerous reasons. First, the TMEP clearly states that for a term to be commonly used, it must be used by many different sources. The Examining Attorney's use of "one of its competitors" does not meet the definition of "many different sources." The TMEP provides that the evidence submitted by the examining attorney may show use by other manufacturers on goods of a similar nature and evidence that the term or slogan is frequently use by parties in connection with the goods sale of their goods or services. The terms used in the TMEP are specifically crafted in the plural tense to require examining attorneys show evidence of multiple manufacturers and parties using the applied-for-mark. Here, the Examining Attorney has shown one example. Therefore, the Examining

Attorney clearly fails to provide sufficient evidence that the applied-for-mark is a commonly used phrase.

Secondly, the Examining Attorney appears to argue the mark fails to function as a trademark by applying the merely descriptive standard. A veiled merely descriptiveness argument simply under another name should be disregarded as the Examining Attorney has acknowledged the mark is suggestive.

C. The Specimen Of Record Shows The Mark Operates As A Source Indicator.

The Examining Attorney references "specimens" and "[b]oth specimens" throughout his Appeal Brief. On January 2, 2013, Applicant filed a substitute specimen that overcame rejections by the Examining Attorney's that were based on the originally filed specimen. The Examining Attorney recognizes the substitute specimen but continues to reference and analyze the original specimen. Applicant's substitute specimen is a point-of-sale display (hereinafter "POS") that contains the applied-for-mark in a large bold-type black font against a white background. The location and use of large, black lettering with a white background is the focal point of the POS and attracts consumers' attention. The remaining indicia on the POS is essentially a space-filler and disclaimer language.

Yet, the Examining Attorney focuses his attention on the small lettering depicted within a picture within the POS. By doing so, the Examining Attorney has failed to provide a supported argument as to why the placement of the applied-for-mark in large black lettering against a white background on POS materials fails to function as a source identifier. The substitute specimen should be determined an acceptable demonstration of the applied-for-mark as a trademark.

The Examining Attorney has also argued that Applicant's use of the applied-for-mark in conjunction with its other registered trademarks and product depictions increases the likelihood

that consumers will not perceive it as a source identifier. This reasoning is unsupported and is inconsistent with established USPTO policies. Numerous Specimens of record depict an applied-for-mark used in combination with a previously registered trademark. Examples include:

[8]

[9]

It follows from the Examining Attorney's argument that neither of these specimens presents a mark used as a source identifier. Like the instant proceeding, Applicant's registered "FIXES TIRED FAST" mark contains a similar specimen of record, namely a POS, containing a number of Applicant's registered trademarks, depicting Applicant's goods, and contains the phrases "Sugar Free" and "4 Calories." The Examining Attorney's argument is also contrary to well established case law. "The fact that a slogan is used in conjunction with a previously existing trademark does not mean that the slogan does not also function as a mark, for a product can bear more than one mark." 1 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition §7:21 (4th ed. 2013); citing *Carter-Wallace, Inc. v. Procter & Gamble Co.*, 434 F.2d 794, 167 U.S.P.Q. 713 (9th Cir. 1970); *Grotrian, Helfferich, Schulz, Th. Steinweg Nachf. v. Steinway & Sons*, 523 F.2d 1331, 186 U.S.P.Q. 436 (2d Cir. 1975).

[8] "FIXES TIRED FAST" Registration No. 4,144,236
[9] "JUST DO IT" Registration No. 1,817,919

D. Examining Attorney's Third-Party Use Evidence Is Unpersuasive.

The Examining Attorney contends the third-party use evidence demonstrates that the applied-for-mark fails to function as a trademark. The Examining Attorney's argument is founded on assumptions and unsupported conclusions.

The Examining Attorney cites **one** competitor using HOURS OF ENERGY NOW to sell its product, as evidence establishing that the phrase is "commonly used to describe a feature of energy shots." (Examining Attorney's Appeal Brief pg. 4). The Examining Attorney fails to provide any support that only **one** competitor out of the currently hundreds, and cumulatively thousands, of competing products leads to the conclusion that it is a commonly used term. In fact, even though the competitor uses the applied-for-mark, consumers still recognize the mark as Applicant's:

[10]

The Examining Attorney has failed to submit persuasive evidence supporting the contention that the applied-for-mark fails to function as a trademark.

[10] http://www.ebay.com/itm/Kirkland-Signature-Energy-Shot-5-Hour-Energy-7-Count-Berry-Flavor-2-oz-New-/321266473067?pt=LH_DefaultDomain_0&hash=item4accf9586b&nma=true&si=D%252Bf6WenDon0KP78EvPKsiORCojQ%253D&orig_cvip=true&rt=nc&_trksid=p2047675.l2557

E. Applicant's Use of Search Engine Results.

The Examining Attorney argues that the evidence Applicant provided showing results from filtered searches from the Google search engine does not show that the public perceives the applied-for-mark as a trademark. "If the examining attorney refuses registration, he or she ***must*** support the refusal with appropriate evidence." TMEP §1209.02. The Examining Attorney has failed to provide relevant evidence to support his argument and instead makes "several assumptions" as to why the applied-for-mark fails to function as a source identifier. To the contrary, Applicant submitted this evidence to demonstrate that the consumers do indeed view "HOURS OF ENERGY NOW" as a source identifier.

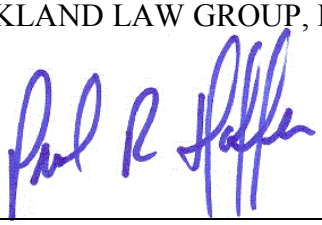
CONCLUSION

For the foregoing reasons, Applicant respectfully submits that Applicant's argument supports a finding that the applied-for-mark functions as a trademark. Furthermore, Applicant respectfully submits that all outstanding requirements identified in the Examining Attorney's Appeal Brief filed on November 21, 2013 have been satisfied and that this application is now in condition for publication.

Reversal of the Examining Attorney's decision, therefore, is respectfully requested.

Respectfully submitted,

OAKLAND LAW GROUP, PLLC



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