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

Proceeding	86019951
Applicant	Little Green LLC dba Paneltech
Applied for Mark	PETRO FREE
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Date	12/18/2014

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Serial No.: 86019951
Mark: PETRO FREE
Applicant: Little Green LLC
Examining Attorney: Morgan L. Meyers, Law Office 117

EX PARTE APPEAL

APPLICANT'S BRIEF

INTRODUCTION

Applicant Little Green LLC, by and through its counsel, hereby respectfully appeals the Examining Attorney's refusal to register the mark PETRO FREE based on a finding that the mark "merely describes a missing ingredient in applicant's resin goods, namely, that the applicant's goods do not contain petro, or petroleum." See Office Action dated April 7, 2014. This argument does not appear to consider the value of the evidence regarding other meanings of "petro" and "free" that could also apply to this mark when used in relation to environmentally-friendly countertop goods. If a mark has a double entendre meaning—which PETRO FREE does—it cannot be merely descriptive.

II. DESCRIPTION OF RECORD

A. Prosecution History

The Examining Attorney initially refused registration of the PETRO FREE mark on November 22, 2013 in a non-final office action. Applicant filed a response to the office action on March 17, 2014. The Examining Attorney then issued a final office action on April 7, 2014 for the same reasons the Examiner initially refused registration. The Examiner did not appear to consider Applicant's evidence or arguments submitted in response to the first office action. Applicant submitted a request for reconsideration on October 1, 2014. The Examiner denied the request on October 23, 2014 maintaining the requirements and refusal made final in the second office action.

B. Examining Attorney's Evidence

1. November 22, 2013 Office Action

In claiming that the applied-for mark PETRO FREE merely described a missing ingredient of Applicant's environmentally-friendly countertop goods, the Examiner included definitions of the terms "petro" and "free." This evidence demonstrated multiple meanings for

the terms that could apply to and be suggestive of Applicant's goods. In addition, the Examiner included a definition of "petrology," which indicated that the word meant "the branch of geology that deals with the classification, location, composition, structure, and origin of rocks"—a definition not cited or considered by the Examiner in either office action response. The petrology definition also indicates that the mark PETRO FREE is not merely descriptive of petroleum as the Examiner claims. The Examiner also included a definition for "phenol" that has no bearing on the office actions. Finally, the Examiner included screen shots from Applicant's website that demonstrate why the mark PETRO FREE actually has multiple suggestive meanings.

2. April 7, 2014 Office Action

The Examining Attorney did not include any additional evidence in the final office action.

C. Applicant's Evidence

Applicant did not have to submit any additional evidence because it could rely on the Examining Attorneys' evidence to demonstrate that the mark PETRO FREE is not merely descriptive. Specifically, Applicant pointed to the evidence from its website submitted by the Examiner to demonstrate that the mark PETRO FREE actually did not merely mean "petroleum free." In addition, Applicant stated that the Examiner's evidence of multiple applicable meanings of the terms "petro" and "free" undercut the Examiner's conclusion of mere descriptiveness.

Applicant also listed examples of marks incorporating the components "petro" or "free" to demonstrate the established Trademark Office practice of treating composite marks having these terms as more than merely descriptive.

III. ARGUMENT

A. The Examining Attorney Does Not Meet the Standard for Refusal.

"The examining attorney bears the burden of showing that a term is merely descriptive of the relevant goods." *HEB Grocery Co., LP*, 2012 TTAB LEXIS 251, *7 (TTAB June 29, 2012) (citations omitted). "To the extent that any of the evidence and arguments based thereon raise doubts about the merely descriptive character of applicant's mark, such doubts are to be resolved in applicant's favor and the mark should be published, thus allowing a third party to file an opposition and develop a more comprehensive record." *Id.* at *8 (citations omitted). Given this standard and the clear double meanings of the applied-for mark, Applicant respectfully requests that the Board grant Applicant's appeal and allow registration of the mark PETRO FREE because the Examiner has not met the burden for refusal.

B. PETRO FREE is Not Merely Descriptive.

The mark “PETRO FREE” is not merely descriptive when applied to Applicant’s countertop goods. The mark is informational in that it conveys multiple potential desirable characteristics of the goods, including that the countertops are made without stone or rock and without petroleum. The informational nature of the mark relates to the fact that both components of the mark “PETRO” and “FREE” have double meanings in relation to the goods. The use of “FREE” also suggests the more loose interpretation that the goods are “freeing” because they do not use stone or petroleum like most other countertop products. Where marks are suggestive and informational and also represent double entendre, they cannot be refused registration as merely descriptive.

“A term is merely descriptive if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods.” *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978). The immediate idea must be conveyed forthwith with a “degree of particularity.” *In re TMS Corp. of the Americas*, 200 USPQ 57, 59 (TTAB 1978). “It is not fatal that a mark is informational. One may be informed by suggestion as well as by description.” *HEB Grocery*, 2012 TTAB LEXIS at *9 (“the terms ‘descriptive’ and ‘suggestive’ are not mutually exclusive. There is some description in any suggestion or the suggestive process does not occur.”)

A clear line delineating descriptive marks from suggestive marks are marks that have more than one meaning. “When a term or phrase, as applied to the goods or services in question, possesses double meaning . . . it is not merely descriptive of the goods and may be registered under the Trademark Act.” *In re Computer Business Systems Group*, 1985 TTAB LEXIS 19, *3 (TTAB Nov. 20, 1985). “A ‘double entendre’ is a word or expression capable of more than one interpretation. For trademark purposes, a ‘double entendre’ is an expression that has a double connotation or significance as applied to the goods or services. The mark that comprises the ‘double entendre’ will not be refused registration as merely descriptive if one of its meanings is not merely descriptive in relation to the goods or services.” *In re Societe des Produits Nestle S.A.*, 2013 TTAB LEXIS 586, *10 (TTAB Nov. 18, 2013); *see also e.g., In re Madson Prods., LLC*, 2007 TTAB LEXIS 388, *6-8 (TTAB Sept. 13, 2007) (mark YAK SAK not merely descriptive and “is a double entendre when considered in connection with ‘fluid-tight paper or plastic utility bags used for motion sickness and disposal of unpleasant matter’ because it could mean a bag to yack in or could suggest that the bag is tough like a yak); *In re Zico Bev. LLC*, 2013 TTAB LEXIS 250, *7-8 (TTAB May 9, 2013) (“applicant’s NATURALLY POWERED mark is a double entendre. . . . NATURALLY POWERED connotes, on the one hand, goods that are powered by forces of nature and, on the other, goods that are powered in a natural manner, without special intervention.”). Where the term at issue is not commonly used to describe the goods, the double entendre mark is not merely descriptive. *See In re Computer Business Systems Group*, 1985 TTAB LEXIS 19 at *1-4 (finding that “AUTO*MATE” is “not a term commonly used to describe computer programs” and could be understood as either automated or an automotive jobber companion).

As the Examiner states, the determination of whether a mark is merely descriptive is considered in relation to the identified goods. *See* Office Action dated April 7, 2014. The wording PETRO FREE is not merely descriptive of Applicant’s “unprocessed phenolic resins” used to make countertops because it does not immediately convey or describe an idea relating to

the goods with the required degree of particularity. Indeed, PETRO FREE cannot immediately describe the goods because both mark components “PETRO” and “FREE” have double meanings when considered in relation to Applicant’s environmentally-friendly countertop goods.

With regard to “PETRO,” the first definition that the Examiner cites is “indicating stone or rock.” The second and third definitions refer to petroleum and its products. When applied to resins and countertop products, both stone and petroleum could be used in manufacturing. Therefore, the Examiner makes an unwarranted and incorrect leap in assuming that all consumers will tie the word “PETRO” to petroleum. When viewed in connection with Applicant’s goods, consumers could associate the word “PETRO” with “indicating stone or rock.” Applicant’s website states that Applicants’ products are made of PaperStone and that “PaperStone® is a sustainable composite material made from 100% post-consumer recycled paper . . .” Thus, the most natural connection is that while some countertops are made of stone or rock, Applicant’s materials are not. A second, and different, meaning for PETRO is that the goods are petroleum free.

Considering the products at issue—countertops—neither the stone nor petroleum meaning of “petro” is more applicable or likely to be perceived by consumers, and the word petro takes on a double meaning. Both meanings—free of stone and free of petroleum—suggest and inform the consumer about desirable characteristics of the products and therefore cannot be merely descriptive. *See In re George Weston Limited*, 1985 TTAB LEXIS 51, *1-4 (TTAB Sept. 19, 1985) (finding mark “SPEEDI BAKE” suggestive of quality of frozen dough and finding that a mark may include “a desirable characteristic” of applicant’s product and still be considered suggestive rather than merely descriptive); *see also HEB Grocery*, 2012 TTAB LEXIS at *8-9 (finding mark XTREME HEAT “does not immediately describe any specific characteristic or feature of applicant’s snack foods with any degree of particularity. At most, the mark is highly suggestive that the snack foods are very spicy, but falls short of being merely descriptive as a flavor characteristic or taste.”) (citing *In re Andes Candies Inc.*, 478 F.2d 1264, 178 USPQ 156 (CCPA 1973) (finding CREME DE MENTHE merely descriptive of candy)).

In addition, as noted in the Examiner’s refusal, the word “free” has at least 35 definitions. Among other things, the Examiner admits that “free” can mean “not exact,” “costing nothing,” “available,” and “chemically uncombined.” All of these definitions could apply to Applicant’s products. For instance, Applicant’s countertops, while referred to as “PaperStone” are not exactly made with stone. Similarly, while both stone and petroleum are both available for use in countertop making, a consumer buying Applicant’s products will not pay for either of these materials. Finally, neither stone nor petroleum have been chemically combined in Applicant’s goods. While some of these different meanings inform consumers about the products, none of these meanings of “free” are commonly used to describe resin countertops and thus are not merely descriptive.

Further, the use of “FREE” for non-petroleum resin countertops suggests a riff on the less literal definitions of free. In other words, Applicant is suggesting that its products are “freeing” because their use helps curb oil-dependence and mining and promotes environmental consideration. This marketing is in line with other slogans used on Applicant’s website, including the phrase “The Countertop with a Conscience.” This double entendre as well as the

other multiple meanings of PETRO FREE demonstrates, as a matter of TTAB law, that the term cannot be merely descriptive.

C. Third-Party Registrations in a Variety of Fields Reflect Office Practice of Allowing Composite Marks Having a “PETRO” Prefix to Proceed Through Registration.

While not determinative, the Board also should consider the presence of other PETRO marks registered or allowed to proceed with application on the Principal Register.

Among many others, the following marks employ the same PETRO term Applicant now seeks to register:

- PETROCLEAN (Reg. No. 4163762) – for waste water treatment services
- PETRO HARVESTER OIL & GAS (Reg. No. 3999758) – for production and exploration of oil and gas
- PETROWIKI (Reg. No. 4445362) – for an interactive website that enables users to access information targeted at the oil and gas industry
- PETROFLEX (Reg. No. 4377498) – for educational services in the field of petroleum engineering and distributing printed and electronic-format course materials in connection therewith
- PETROPOWER (Reg. No. 4213124) – for instruments controlling oil field operations and pumps
- PETROBRIGHT (Reg. No. 4317287) – for electrical lighting fixtures
- TRISTAR PETROSERV (Reg. No. 4425866) – for treatment services of materials such as crude and fuel oil
- PETROCHOICE (Reg. No. 4439247) – for distributorship services in the field of oil, petroleum and chemical products and for custom construction of equipment for use in reprocessing synthetic oils
- PETRO SOLUTIONS (Serial No. 85552135, published for opposition 1/22/13) – for wholesale store services featuring gas station equipment
- PETROBOSS (Serial No. 86015028, published for opposition 12/10/13) – for business consulting services for the energy industry

Similarly, the Board should consider the presence of other FREE marks such as:

- SNOT~FREE (Reg. No. 4480974) – for nasal aspirators
- GMO FREE (Reg. No. 4475297) – for dietary and nutritional supplements that are free of genetically-modified organisms
- HANDS-FREE CLEANING (Reg. No. 4460373) – for retail services by sales agents in the field of vacuum cleaners and power-operated floor scrubbers
- UV FREE GEL (Reg. No. 4496475) – for nail polish and other cosmetic preparations
- CUSS FREE COMEDY (Reg. No. 4486623) – for entertainment in the nature of live visual and audio performances by comedians

- FREE AUTOMOTIVE (Reg. No. 4492819) – for advertising services include promoting car dealerships and for providing a searchable online advertising website in the field of automotive vehicles and services

The prevalence of these PETRO and FREE marks reflects the established Office practice of treating composite marks having these terms as more than merely descriptive. *See In re Cigars Int'l, Inc.*, 2011 TTAB LEXIS 307, *12-20 (Trademark Trial & App. Bd. Sept. 14, 2011) (using same reasoning and finding prefix MEGA when used in MEGA-SAMPLER for sample package of cigars to be suggestive). The Board should do the same here.

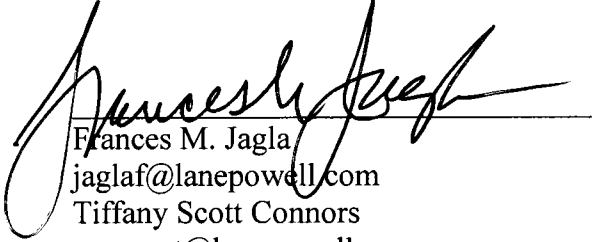
IV. CONCLUSION

The applied-for mark PETRO FREE is not merely descriptive of Applicant's environmentally-friendly resin countertop products. While the mark may inform the customer about possible desirable characteristics of the goods, because both components of the mark have multiple meanings, the mark informs about multiple qualities rather than describing one singular ingredient. As a matter of law, because PETRO FREE has multiple meanings, including a double entendre meaning, in relation to Applicant's goods, the mark cannot be merely descriptive. Applicant therefore respectfully requests that the Board grant this appeal and allow the mark to proceed.

V. NOTE REGARDING EXAMINER'S REQUIREMENT TO AMEND APPLICATION

After issuing a refusal, the Examiner stated that the "use or intended use of the applied-for mark on goods that do not in fact have or exhibit petroleum free resin is or will be deceptive." *See* Office Action dated April 7, 2014. The Examiner requested that the PETRO FREE identification be amended to "Unprocessed phenolic resins that contain no petroleum." However, for the reasons discussed above, the PETRO FREE mark does not only suggest the fact that Applicant's goods are free of petroleum but also suggests a number of other characteristics and connotations, most importantly, that the products are free of stone or rock. The PETRO FREE mark is not deceptive because the goods do not contain petroleum or stone, but no amendment is necessary because the mark suggests several different features and connections with the goods.

Dated this 18th day of December, 2014.



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