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

Proceeding	87528703
Applicant	Shaklee Corporation
Applied for Mark	PERFORMANCE
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Serial No. 87/528,703
Mark: PERFORMANCE
Applicant: Shaklee Corporation
Class: 5
Examining Attorney: Andrea B. Cornwell
Law Office 115

APPLICANT'S EX PARTE APPEAL REPLY BRIEF

The Examining Attorney's Appeal Brief argues that Applicant's mark, PERFORMANCE, is allegedly merely descriptive because:

1. There are dictionary definitions of "performance" as:
 - a. "The action or process of carrying out or accomplishing an action, task, or function"
 - b. "the way in which someone or something functions"
 - c. "the ability to perform." (Examining Attorney's Appeal Brief, p. 2).
2. There are allegedly 17 Internet websites allegedly identifying "performance" as a purpose of a supplement or as a category of supplements. (Examining Attorney's Appeal Brief, p. 2).
3. There are allegedly 34 trademark registrations for dietary and nutritional supplements where "performance" has been disclaimed. (Examining Attorney's Appeal Brief, p. 3-5).

The dictionary definitions do not suggest that "the mental leap between the word and the product's attribute is ... almost instantaneous" and that "strongly indicates suggestiveness, not direct

descriptiveness.” *Nautilus Grp., Inc. v. ICON Health & Fitness, Inc.*, 372 F.3d 1330, 1340 (Fed. Cir. 2004). Moreover, the *de minimus* alleged Internet evidence and the citation to registrations without indication of whether the registrants in those cases disputed any allegations of descriptiveness (and which are contradicted by recent registrations where PERFORMANCE is not disclaimed) fail to show descriptiveness. In sum, the Examining Attorney’s Appeal Brief does not show that Applicant’s mark, PERFORMANCE, is merely descriptive of its identified goods.

First, the definitions cited by the Examining Attorney’s Appeal Brief do not demonstrate that Applicant’s mark is merely descriptive. Applicant’s products are not characterized by “the action or process of carrying out or accomplishing a task, or function;” “the way in which someone or something functions;” or “the ability to perform,” which are the definitions alleged in the Examining Attorney’s Appeal Brief. Rather, a consumer viewing Applicant’s trademark PERFORMANCE on Applicant’s products would be required to think about what the products are, realize that the products are a nutritional supplement of some sort, then realize that the products, if ingested and combined with some exercise, might at some point in the future (if the products are continued to be ingested and the exercise continued) cause the consumer to build muscle or endurance that might assist the consumer in executing the exercise. A consumer would not immediately believe that the product would result in “performance” – i.e., “the action or process of carrying out or accomplishing a task, or function;” “the way in which someone or something functions;” or “the ability to perform.” That the cited definitions do not fit Applicant’s products shows clearly that Applicant’s identified goods are not described by PERFORMANCE.

Second, that 17 Internet websites allegedly identify “performance” as an alleged purpose of a supplement or allegedly as a category of supplements does not prove that the term is descriptive. Rather, 17 Internet websites is an insignificant number that should be discounted as *de minimus*.

That only 17 Internet websites allegedly identify “performance” as an alleged purpose of or category of a supplement (and Applicant disagrees that “performance” is identified as a purpose of or category of a supplement in each of the cases cited) is evidence that the term is not descriptive since there are so many Internet websites for supplements.

Third, the Examining Attorney’s Appeal Brief cites 34 trademark registrations in which “performance” was disclaimed or which are on the Supplemental Register as evidence that the term is descriptive. Importantly, there is no discussion of whether the applicants in those cases disputed the claim of alleged descriptiveness or tried first to register the marks on the Principal Register. We must assume that the applicants in those case simply went along with any allegations of descriptiveness and chose to enter disclaimers or apply for the Supplemental Register for expediency, simply to obtain a registration. Accordingly, the registrations cited by the Examining Attorney have little to no meaning in this context.

On the other hand, Applicant demonstrated that in just the last several years, 7 registrations issued that included PERFORMANCE without a disclaimer of “performance.” (March 25, 2019, Request for Reconsideration, pp. 2-4). That shows that the Patent and Trademark Office does not consider PERFORMANCE to be merely descriptive.

The Examining Attorney’s Appeal Brief also discounts the impact of Applicant’s incontestable registrations for PERFORMANCE (Reg. 2694345) and SHAKLEE PERFORMANCE (Reg. 1576685). (Examining Attorney’s Brief, p. 6). The Examining Attorney’s Appeal Brief spends about a page explaining why the fact that Applicant’s PERFORMANCE and SHAKLEE PERFORMANCE are for somewhat different goods means that Examining Attorney can refuse Applicant’s current application. But that misses the point. The point is not whether Applicant’s current application is technically different from its prior registrations, but rather whether those prior

registrations should inform the current matter – and they clearly should since they identify nutritional products.

Applicant’s Registration 2694345 for PERFORMANCE and Registration 1576685 for SHAKLEE PERFORMANCE recite “[p]owdered concentrate for making an electrolytic soft-drink,” a nutritionally enhanced food product in class 32. Applicant’s current application identifies nutritionally enhanced food products in class 5. The PTO has consistently determined that such goods are highly related as evidenced by the number of registrations that identify goods in both classes. As can be seen in Exhibit B to Applicant’s Response of March 25, 2019, there are thousands of such registrations. Applicant actively markets its powdered electrolyte concentrate as a nutritionally enhanced product, intended to promote health and endurance, and has done so since the inception of its PERFORMANCE branded products in 1989 (Exhibit D to Applicant’s Response of March 25, 2019). The nutritionally enhanced goods listed in the present application are simply a continuation of Applicant’s nutritionally enhanced PERFORMANCE branded product line, offering nutritional supplements in alternative food mediums such as candy, energy bars, capsules, etc.

The goods provided under Applicant’s PERFORMANCE and SHAKLEE PERFORMANCE Registrations, and its present application for PERFORMANCE, both include nutritionally enriched food products designed to promote health, well-being and endurance of the human body. The inherent nature of these goods is the same.¹ It follows that the relevant purchaser of Applicant’s goods would view Applicant’s present application for PERFORMANCE as a natural extension of

¹ *Kellogg Co. v. Gen. Mills, Inc.*, 82 USPQ2d 1766, 1771 (T.T.A.B. 2007) provides guidance regarding relatedness, noting that the requirement for intrinsic evidence is not required “in cases where the identifications of goods alone reveal sufficient facts about the respective goods from which a conclusion, not based on mere conjecture, as to the relationship between the goods may be made.”

Applicant's existing PERFORMANCE branded nutritional product line. In fact, Applicant actively markets some of these Class 5 products as part of its existing PERFORMANCE product line to its consumers. (Exhibit E to Applicant's Response of March 25, 2019). This provides further evidence of a "strong likelihood that the mark's established trademark function will transfer to these related goods when use in commerce occurs." See *In Re Rogers*, 53 USPQ2d 1741, 1745 (TTAB 1999).

The Examining Attorney also attempts to distinguish this case from the cases cited in Applicant's Brief finding that marks concerning an intended result are not merely descriptive.² In that regard, the Examining Attorney argues that PERFORMANCE is a category of products and purpose of the goods and not an intended result. (Examining Attorney's Brief, p. 5). However, the Examining Attorney is incorrect.

It has not been demonstrated that "performance" is a category of products. And Applicant's mark reflects an intended result rather than a purpose of the products. This case is like the precedential cases noted in Applicant's Brief and in footnote 2 to this Reply finding not descriptive e.g.,: RECOVERY for assisting persons to recover after psychiatric or other professional counseling, VERI-CLEEN for anti-fouling additives, BRAKLEEN (as part of CRC BRAKLEEN) for a brake cleaning agent, CURV' for wave curling solutions, PEST PRUF for animal shampoo with insecticide,

² *The Realistic Company*, 440 F.2d 1393, 169 USPQ 610 (CCPA 1971) (CURV' not descriptive for "Permanent wave curling solutions"); *In re Aid Labs., Inc.*, 221 U.S.P.Q. 1215, 1216 (T.T.A.B. 1983) (PEST PRUF for animal shampoo with insecticide held suggestive of a possible end result of the use of Applicant's goods); *In re Nobile Co.*, 225 U.S.P.Q. 749, 750 (T.T.A.B. 1985) (NOBURST held suggestive as the Board did not "believe this conclusion is readily arrived at by merely observing the mark on the goods but that it requires interpretation by the viewer"); *In re Shutts*, 217 U.S.P.Q. 363 (T.T.A.B.1983) (SNO-RAKE held not merely descriptive of snow removal hand tool); *In re Recovery, Inc.*, 196 USPQ 830 (TTAB 1977) (RECOVERY not merely descriptive of services of, inter alia, providing group therapy in the form of self-help aftercare to follow psychiatric or other professional counseling and/or treatment, and training lay leaders to provide such therapy); *In re Frank J. Curran Co.*, 189 USPQ 560 (TTAB 1975) (CLOTHES FRESH not merely descriptive as applied to clothes and shoe spray deodorant); *In re Pennwalt Corp.*, 173 USPQ 317 (T.T.A.B. 1972) (DRI-FOOT not merely descriptive of "Anti-Perspirant Deodorant for Feet").

PURITY for water filtering units, water filter cartridges and water softening units, CLOTHES FRESH for a clothes and shoe spray deodorant; and DRI-FOOT for an anti-perspirant deodorant for feet.

In sum, as can be seen from the above, and Applicant's Brief, none of the arguments in the Examining Attorney's Appeal Brief demonstrate that Applicant's mark is merely descriptive.

That makes sense because PERFORMANCE is not a characteristic of Applicant's goods. Though Applicant's mark has some meaning, "[a] designation does not have to be devoid of all meaning in relation to the goods/services to be registrable." TMEP §1209.01(a). Rather, to be deemed merely descriptive and initially unregistrable, a mark must "directly and immediately convey[] some knowledge of the characteristics of a product." 2 *J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition* §11:16, p. 11-28 (5th Ed. 2018). "If the mental leap between the word and the product's attribute is not almost instantaneous, this strongly indicates suggestiveness, not direct descriptiveness." *Nautilus Grp., Inc. v. ICON Health & Fitness, Inc.*, 372 F.3d 1330, 1340 (Fed. Cir. 2004). In this case a consumer would have to make a multiple-stage mental leap to connect the word "performance" to Applicant's goods. That leap would not be instantaneous, as is required before a term can be considered merely descriptive.

Applicant's current application for PERFORMANCE for its nutritional goods is not descriptive for the reasons discussed above and in its Appeal Brief. PERFORMANCE used in the context of Applicant's goods is obviously at most suggestive.

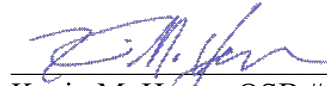
Therefore, Applicant requests that, while there should be no doubt that its mark is not merely descriptive, any existing doubt be resolved in its favor, that this appeal determine that Applicant's mark is not merely descriptive, and that Applicant's application be published for opposition. *See In re Intelligent Medical Systems Inc.*, 5 U.S.P.Q.2d 1674, 1676 (T.T.A.B. 1987) ("there 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 Applicant's favor and publish the mark for opposition”); *In re Gourmet Bakers, Inc.*, 173 U.S.P.Q. 565 (T.T.A.B. 1972) (the determination of whether a mark is merely descriptive or suggestive is more often than not “determined largely on a subjective basis with any doubt in the matter being resolved in Applicant’s behalf on the theory that any person believed damaged by the registration would have the opportunity...to oppose registration of the mark and to present evidence, usually not present in the *ex parte* application”) (emphasis added).

Respectfully submitted,

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