

To: Organic Sales & Marketing, Inc. (MLandergan@richmaylaw.com)
Subject: U.S. TRADEMARK APPLICATION NO. 85400903 - EGG WIPES HYGIENE - N/A
Sent: 8/6/2012 3:58:31 PM
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[Attachment - 5](#)
[Attachment - 6](#)

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

APPLICATION SERIAL NO. 85400903

MARK: EGG WIPES HYGIENE

85400903

CORRESPONDENT ADDRESS:

MARY E. LANDERGAN, ESQ.

RICH MAY, A PROFESSIONAL CORPORATION

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http://www.uspto.gov/trademarks/teas/response_forms.jsp

APPLICANT: Organic Sales & Marketing, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO :

N/A

CORRESPONDENT E-MAIL ADDRESS:

MLandergan@richmaylaw.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 8/6/2012

THIS IS A FINAL ACTION.

This action addresses the applicant's 05/23/12 response to the 12/05/11 office action. The office action required that the applicant provide a disclaimer of the wording "Eggs", "Wipes", and "Hygiene". The office action also required that the applicant amend the identification of goods/services and to address a drawing requirement. The applicant provided an acceptable amended identification of goods and provided a substitute drawing to address the drawing requirement. As a result, these issues are now satisfied.

In regard to the disclaimer, the applicant argues that the descriptive terms should be considered in their entirety and that the words are combined in a unique and unusual combination. In particular, the applicant argues that "one does not customarily associate sanitizing eggs in a coop in the same manner that one sanitizes hands or babies. Nor does one normally apply the term "hygiene" to a chicken coop." See the applicant's May 23, 2012 response. Furthermore, the applicant argues that "egg wipes" is a new innovative product used to clean eggs in a coop. Upon careful review of the applicant's response, the undersigned finds the arguments unpersuasive. As a result, the disclaimer requirement is now made **FINAL**.

The applicant argues that the descriptive wording should be considered in its entirety, however, the applicant's mark includes additional elements that include design components of the mark. Furthermore, the words are separated by the same design elements and are not presented as one whole mark, e.g. as a hyphenated word or conjunction. As presented, if all of the wording was not descriptive, only certain words may have required a disclaimer, but unfortunately, here, all of the wording is descriptive. Interestingly, the applicant states that all of the descriptive wording must be construed in its entirety, yet the applicant then argues that "[p]lacing the wording 'egg' with 'wipes' is a unique combination," in other words, the applicant has unilaterally dissected the descriptive words to provide individual analysis of the limited wording "egg wipes". The applicant argues that the term "wipe" is commonly used in connection with hand wipes and baby wipes, however, simply because the applicant is the first to use a term, does not obviate the descriptiveness of the term. The fact that an applicant may be the first and only user of a merely descriptive designation is not dispositive on the issue of descriptiveness where, as here, the evidence shows that the word or term is merely descriptive. See *In re Sun Microsystems, Inc.*, 59 USPQ2d 1084, 1087 (TTAB 2001); *In re Acuson*, 225 USPQ 790, 792 (TTAB 1985); TMEP §1209.03(c).

Further, the applicant argues that "[c]ommon words in which no one may acquire a trademark because they are descriptive or generic, may, when used in combination become a valid trademark." *Association of Co-operative Members, Inc. v. Farmland Industries, Inc.*, 684 F.2d 1134 (5th Cir. 1982) First, this case concerned two similar design marks and the issue was whether the latter mark would be prohibited because it was an invalid trademark. The court noted that the appellee did not present a likelihood of confusion argument, therefore the holding was limited to the issue of whether the mark was a valid trademark. Here, the present issue concerned descriptive wording that must be disclaimed. Descriptive words may be used in combination and then be registrable, but only under certain circumstances.

Generally, a mark that merely combines descriptive words is not registrable if the individual components retain their descriptive meaning in relation to the goods and/or services and the combination results in a composite mark that is itself descriptive. TMEP §1209.03(d); see, e.g., *In re King Koil Licensing Co. Inc.*, 79 USPQ2d 1048, 1052 (TTAB 2006) (holding THE BREATHABLE MATTRESS merely descriptive of beds, mattresses, box springs and pillows where the evidence showed that the term "BREATHABLE" retained its ordinary dictionary meaning when combined with the term "MATTRESS" and the resulting combination was used in the relevant industry in a descriptive sense); *In re Associated Theatre Clubs Co.*, 9 USPQ2d 1660, 1663 (TTAB 1988) (holding GROUP SALES BOX OFFICE merely descriptive of theater ticket sales services because such wording "is nothing more than a combination of the two common descriptive terms most applicable to applicant's services which in combination achieve no different status but remain a common descriptive compound expression").

Only where the combination of descriptive terms creates a unitary mark with a unique, incongruous, or otherwise nondescriptive meaning in relation to the goods and/or services is the combined mark registrable. See, e.g., *In re Colonial Stores, Inc.*, 394 F.2d 549, 551, 157 USPQ 382, 384 (C.C.P.A. 1968).

In this case, both the individual components and the composite result are descriptive of applicant's goods and/or services and do not create a unique, incongruous or nondescriptive meaning in relation to the goods and/or services. Specifically, all of the wording maintains its descriptive meaning. Simply, because an applicant is the first to use a term, does not create a valid trademark. Instead, all of the wording maintains its descriptive meaning, namely "egg", "wipes", and "hygiene" for the applicant's egg cleaning wipes, which are used to clean eggs in a hygienic or sterile manner.

The applicant also argues that “hygiene” used in connection with eggs found in a chicken coop is unusual. To support this conclusion, the applicant cites “Roach Motel” in *American Home Products Corporation v. Johnson Chemical C. Inc.*, 589 F. 2d 103, 106 (2d Cir. 1978) to support the proposition that the combination of the descriptive wording creates an incongruity because one does not customarily associate sanitizing eggs in a coop in the same manner that one sanitizes hands or babies. Unlike the “Roach Motel” case, where the court found the term “motel” suggestive and not descriptive, the terms here are descriptive. By way of example, the applicant’s own identification of goods, which clearly states that the goods are disposable wipes with a natural cleaning solution for cleaning eggs from a coop. Therefore, unlike the American Home Products case, there is no suggestive wording, but instead descriptive wording because the applicant states itself that the wipes are used to clean or sanitize eggs. So while, this may be unusual, the applicant itself has stated in its own description that the goods are used in this manner.

Alternatively, the applicant argues that the term “egg wipes” was selected as a trademark because it parodies or played upon established terms of “hand wipes” and “baby wipes”. See *Jordache Enterprises, Inc. v. Hogg Wyld, Ltd.*, 828 F.2d 1482 (10th Cir. 1987). Again, this argument is untenable because hand wipes are used to wipe hands, baby wipes are used to wipe babies and egg wipes are used to wipe eggs. As a result, the selected are clearly descriptive and describe how the goods will be used, which is bolstered by the applicant’s own identification of goods, which state the same.

Disclaimer Requirement- Final

The applicant must disclaim the descriptive wording “Egg”, “Wipes”, and “Hygiene” apart from the mark as shown. Trademark Act Section 6, 15 U.S.C. §1056; TMEP §§1213 and 1213.03(a). Macmillan.com defines “hygiene” as follows: “ the practice of keeping yourself and the things around you clean, in order to prevent illness and disease.” [Captured December 5, 2011] The submitted specimen states that the wipes are “soft biodegradable wet wipes for cleaning eggs from the coop.” Eggs are a foodstuff that comes from an animal. See the attached on-line website “Wipes” are defined as “a piece of absorbent cloth or paper used for **wiping** or drying. See that attached definition. The applicant’s describes wipes as a biodegradable cloth that is impregnated with cleaning solution. See the applicant’s identification. The wording is merely descriptive because it describes a significant feature or characteristic of the applicant’s egg cleaning wipes, which are used to clean eggs in a hygienic or sterile manner.

The computerized printing format for the Office’s *Trademark Official Gazette* requires a standardized format for a disclaimer. TMEP §1213.08(a)(i). The following is the standard format used by the Office:

No claim is made to the exclusive right to use “Egg”, “Wipes”, and “Hygiene” apart from the mark as shown.

TMEP §1213.08(a)(i); see *In re Owatonna Tool Co.*, 231 USPQ 493 (Comm’r Pats. 1983).

The Office may require an applicant to disclaim exclusive rights to an unregistrable part of a mark, rather than refuse registration of the entire mark. Trademark Act Section 6(a), 15 U.S.C. §1056(a). Under Trademark Act Section 2(e), 15 U.S.C. §1052(e), the Office may refuse registration of the entire mark where it is determined that the entire mark is merely descriptive, deceptively misdescriptive, or primarily geographically descriptive of the goods. Thus, the Office may require the disclaimer of a portion of a mark which, when used in connection with the goods or services, is merely descriptive, deceptively misdescriptive, primarily geographically descriptive, or otherwise unregistrable (e.g., generic). TMEP §1213.03(a). If an applicant does not comply with a disclaimer requirement, the Office may refuse registration of the entire mark. TMEP §1213.01(b).

A “disclaimer” is thus a written statement that an applicant adds to the application record that states that applicant does not have exclusive rights, separate and apart from the entire mark, to particular wording and/or to a design aspect. The appearance of the applied-for mark does not change.

A disclaimer does *not* physically remove the disclaimed matter from the mark, but rather is a written statement that applicant does not claim exclusive rights to the disclaimed wording and/or design separate and apart from the mark as shown in the drawing.

The following cases explain the disclaimer requirement: *Dena Corp. v. Belvedere Int’l Inc.*, 950 F.2d 1555, 21 USPQ2d 1047 (Fed. Cir. 1991); *In re Kraft, Inc.*, 218 USPQ 571 (TTAB 1983); *In re EBS Data Processing, Inc.*, 212 USPQ 964 (TTAB 1981); *In re National Presto Industries, Inc.*, 197 USPQ 188 (TTAB 1977).

Proper Response

If applicant does not respond within six months of the mailing date of this final Office action, the application will be abandoned. 15 U.S.C. §1062(b); 37 C.F.R. §2.65(a). Applicant may respond to this final Office action by:

- (1) Submitting a response that fully satisfies all outstanding requirements, if feasible; and/or
- (2) Filing an appeal to the Trademark Trial and Appeal Board, with an appeal fee of \$100 per class.

37 C.F.R. §§2.6(a)(18), 2.64(a); TBMP ch. 1200; TMEP §714.04.

In certain rare circumstances, a petition to the Director may be filed pursuant to 37 C.F.R. §2.63(b)(2) to review a final Office action that is limited to procedural issues. 37 C.F.R. §2.64(a); TMEP §714.04; *see* 37 C.F.R. §2.146(b); TBMP §1201.05; TMEP §1704 (explaining petitionable matters). The petition fee is \$100. 37 C.F.R. §2.6(a)(15).

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TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/ mailing date before using TEAS, to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using Trademark Applications and Registrations Retrieval (TARR) at <http://tarr.uspto.gov/>. Please keep a copy of the complete TARR screen. If TARR shows no change for more than six months, call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

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