


IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Robert M. Legg, a United States Citizen
Serial Number : 77/668,464
Mark : 
Filing Date : February 11, 2009
Class : 025
Trademark Attorney : Aaron Brodsky
Law Office : 110

Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

RESPONSE TO OFFICE ACTION

In response to the Office Action dated May 18, 2009, Applicant makes the following remarks:

**I.
APPLICANT'S MARK IS NOT MERELY
DESCRIPTIVE OF APPLICANT'S GOODS**

Applicant seeks registration on the Principal Register of the mark DEEP CONCEAL WEAR (& Design) in connection with clothing, namely, pants, jackets, and vests containing a pocket for carrying a handgun in International Class 025. The Office has refused registration on the basis that Applicant's Mark is merely descriptive. Applicant respectfully disagrees with the Office's position and asserts that its application should be allowed for the following reasons: (1) Applicant's Mark is suggestive; (2) the

overall commercial impression of the Mark is unique and new; and (3) the Office's evidence in support of its descriptive refusal consists only of examples of the individual terms that make up Applicant's Mark.

A. Applicant's Mark is suggestive

DEEP CONCEAL WEAR does not immediately describe clothing, namely, pants, jackets, and vests containing a pocket for carrying a handgun.¹ A mark is merely descriptive under Section 2(e)(1) if it immediately conveys information concerning a significant quality, characteristic, function, ingredient, attribute, or feature of the product or services in connection with which it is used, or intended to be used. *See In re Abcor Development Corp.*, 200 U.S.P.Q. 215, 217-8 (CCPA 1978); *In re Engineering Systems Corp.*, 2 U.S.P.Q.2d 1075 (TTAB 1986). The immediate idea must be conveyed with a "degree of particularity." *In re TMS Corporation of the Americas*, 200 U.S.P.Q. 57, 59 (TTAB 1978). The Office has not offered clear and convincing evidence that the term DEEP CONCEAL WEAR conveys the immediate idea of Applicant's clothing, namely, pants, jackets, and vests containing a pocket for carrying a handgun with a degree of particularity. *See In re Pennzoil Products Co.*, 20 U.S.P.Q.2d 1753, 1758 (TTAB 1991). It is not likely that a consumer will correctly ascertain a relationship between DEEP CONCEAL WEAR and Applicant's goods without some additional information. A suggestive term differs from a descriptive term, which immediately tells the public something about the goods or services. TMEP §1209.01(a).

DEEP CONCEAL WEAR requires some exercise of imagination, thought, or perception to reach a conclusion as to the nature of Applicant's goods. The term DEEP

¹ Applicant is entering a disclaimer of the term "WEAR" in this response to the Office Action.

CONCEAL is suggestive of a quality or characteristic of a feature of the clothes with which Applicant's Mark will be used. And there is no evidence in the record to indicate that DEEP CONCEAL WEAR would be immediately understood by consumers to mean clothing, namely pants, jackets, and vests containing a pocket for carrying a handgun. *See 20th Century Wear, Inc. v. Sanmark-Stardust, Inc.*, 224 U.S.P.Q. 98 (2d Cir. 1984). Under the "imagination test," the question is, how immediate and direct is the thought process from the mark to the particular product or service. Therefore, if one must exercise "mature thought or follow a multi-stage reasoning process" to determine the attributes of the product or service, the term is suggestive, not descriptive. *In re Tennis in the Round, Inc.* 199 U.S.P.Q. 496 (TTAB 1978) (held that TENNIS IN THE ROUND is not descriptive of tennis facilities); *see also In re Nobile Co.*, 222 U.S.P.Q. 749, 750 (TTAB 1985) (NOBURST held suggestive with respect to a product that reduces the likelihood that pipes of a water system in which it is used will burst since 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."); *The Firestone Tire & Rubber Company v. The Goodyear Tire & Rubber Company*, 186 U.S.P.Q. 557 (TTAB 1975) (BIASTEEL held not merely descriptive of tires); *In re Wisconsin Tissue Mills*, 173 U.S.P.Q. 319 (TTAB 1972) (POLYTISSUE held not merely descriptive of a combination paper and plastic table cover).

Applicant attaches the TARR status for the mark TOTAL CONCEAL (Registration No. 3,102,343) registered in connection with hunting blinds in International Class 028 as an example of the Office's position that such a mark is – at a minimum – considered to be suggestive. *See Exhibit A*. The purpose of hunting blinds is to conceal

the hunter from the hunted. *See* “How Does a Hunting Blind Work?” accessible at http://www.ehow.com/how-does_4645870_hunting-blind-work.html (last visited November 16, 2009). While Applicant recognizes that each application must be considered on its own and each case stands on its own merits, Applicant asserts that its DEEP CONCEAL WEAR mark is akin to the TOTAL CONCEAL mark. That is, Applicant’s Mark is suggestive of the clothing with which it will be used like TOTAL CONCEAL is suggestive of the hunting blinds with which it is used.

The term DEEP CONCEAL WEAR does not describe clothing, namely pants, jackets and vests containing a pocket for carrying a handgun. The term WEAR is the only term in Applicant’s Mark that gives any clue as to with which goods or services Applicant’s goods might be associated. And, as Applicant has already referenced, a disclaimer of the term “WEAR” is being entered contemporaneously herewith. The term DEEP CONCEAL, on the other hand, provides no such clue as to Applicant’s goods. Thus, when taken as a whole, DEEP CONCEAL WEAR requires imagination, cogitation or gathering of further information in order to perceive any significance of the term relating to Applicant’s goods. Determination of whether a mark is merely descriptive must necessarily be made in relation to the goods or services at issue, not in the abstract or on the basis of guesswork. Whether consumers could guess what the product or service is from consideration of the mark alone is not the test. *In re American Greetings Corp.*, 226 U.S.P.Q. 365, 366 (TTAB 1985).

In addition, a mark may be shown to be suggestive rather than descriptive by the lack of necessity for a competitor to use the mark when describing their goods or the lack of competitors actually using the mark to describe their goods. The record is devoid of

any evidence that the term DEEP CONCEAL WEAR is used to describe any third party's clothing, nor is there any evidence that a competitor would have to use the term DEEP CONCEAL WEAR in order to describe their clothing. The "competitors' use test" and "competitors' need test" have been adopted by the Board to evaluate whether a mark is suggestive rather than descriptive. *See No Nonsense Fashions, Inc. v. Consolidated Foods Corp.*, 222 U.S.P.Q. 502 (TTAB 1985). The Office presents no evidence indicating that Applicant's competitors are likely to use the term DEEP CONCEAL WEAR or actually do use the term DEEP CONCEAL WEAR, therefore, this weighs against the Office's position that DEEP CONCEAL WEAR is descriptive. In fact, there are numerous examples of competitors describing their clothing with the terms "concealed carry clothing" or "concealment clothing", but not DEEP CONCEAL WEAR. *See Exhibit B* attached hereto of examples from competitors' websites.²

B. Overall commercial impression of the Mark

Moreover, it is the combination of the individual terms DEEP, CONCEAL and WEAR that evokes a new and unique commercial impression apart from its individual terms. *See In re Colonial Stores, Inc.*, 374 F.2d 549, 157 U.S.P.Q. 382 (CCPA 1968) (SUGAR & SPICE held not merely descriptive of bakery products); *In re Shutts*, 217 U.S.P.Q. 363 (TTAB 1983) (SNO-RAKE held not merely descriptive of a snow removal hand tool). The Office has improperly isolated the individual terms that comprise DEEP CONCEAL WEAR to purport to show that the mark is descriptive. The examples of use

² As the Office notes in the Office Action, "[m]aterial obtained from the Internet is generally accepted as competent evidence in examination and ex parte proceedings. *See In re Rodale, Inc.*, 80 U.S.P.Q.2d 1696, 1700 (TTAB 2006) (Internet evidence accepted by the Board to show genericness); *In re Fitch IBCA, Inc.*, 64 U.S.P.Q.2d 1058, 1060 (Internet evidence accepted by the Board to show descriptiveness); TBMP §1208.03; TMEP §710.01(b)."

of the term “deep conceal” provided by the Office in the Office Action show the term “deep conceal” being used in the context of holsters and guns, but not clothing. There is no evidence in the record showing that DEEP CONCEAL WEAR – when considered as a whole – is descriptive of clothing, namely pants, jackets and vests containing a pocket for carrying a handgun. “The commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail.” *Estate of P.D. Beckwith, Inc. v. Comm’r of Patents*, 252 U.S. 538, 545-46, 64 L.Ed. 705, 40 S.Ct. 414 (1920). The rationale for the rule is that the commercial impression of the mark will make on an ordinary consumer is created by the mark as a whole, not by its component parts. When taken as a whole, DEEP CONCEAL WEAR is not merely descriptive of Applicant’s goods.

C. Any doubt should be resolved in Applicant’s favor

“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 Intelligent Medical Systems Inc.*, 5 U.S.P.Q.2d 1674, 1676 (TTAB 1987); *In re Aid Laboratories, Inc.*, 221 U.S.P.Q. 1215, 1216 (TTAB 1983); *In re Gourmet Bakers, Inc.*, 173 U.S.P.Q. 565 (TTAB 1972). *See also In re Grand Metropolitan Foodservice, Inc.*, 30 U.S.P.Q.2d 1974 (TTAB 1994) (“We also recognize, of course, that there is often a thin line of demarcation between a suggestive term and a merely descriptive term, and that the determination of the category into which a particular word falls is frequently a difficult determination, involving some subjective judgment. Also, any doubt with respect to the issue of descriptiveness should be resolved in applicant’s behalf.”).

Applicant respectfully submits that all issues raised in the Office Action have been fully addressed and satisfied and that the Application should be allowed.