

## UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 76/561118

APPLICANT: Schechte, Bernard

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MARK: THE PASTE

CORRESPONDENT'S REFERENCE/DOCKET NO: 660030-8011

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Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
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Serial Number 76/561118

The examiner accepts and acknowledges the disclaimer of PASTE submitted in that the identification of goods now indicates that some of the goods are in paste form.

Applicant is requesting reconsideration of a final Section 2(e)(1) refusal dated December 15, 2004.

After careful consideration of the law and facts of the case, the examining attorney must deny the request for reconsideration and adhere to the final action as written since no new facts or reasons have been presented that are significant and compelling with regard to the point at issue.

Accordingly, applicant's request for reconsideration is *denied*. The time for appeal runs from the date the final action was mailed. 37 C.F.R. Section 2.64(b); TMEP Section 715.03(c).

As previously indicated, a mark is merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. 1052(e)(1), if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the relevant goods. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); In re Bed & Breakfast Registry, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986); In re MetPath Inc., 223 USPQ 88 (TTAB 1984); In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979); TMEP section 1209.01(b). The applicant's goods specifically include "pastes" used to treat gingivitis, periodontitis and halitosis. The terms THE PASTE only convey this feature of the goods and are, therefore, merely descriptive. Please again note that the article THE modifying the highly descriptive or generic term PASTE, and the stylization shown in the proposed mark merely emphasizing the highly descriptive or generic term PASTE, cannot obviate the stated refusal. See again the relevant definition of PASTE below in this regard:

**paste** (pâst) *noun*

1. A smooth viscous mixture, as of flour and water or of starch and water, that is used as an adhesive for joining light materials, such as paper and cloth.
2. A soft, smooth, thick mixture, as: **a.** A smooth dough of water, flour, and butter or other shortening, used in making pastry. **b.** A food that has been pounded until it is reduced to a smooth, creamy mass: *anchovy paste*. **c.** A sweet, doughy candy or confection: *rolled apricot paste*.
3. The moist clay or clay mixture used in making porcelain or pottery. Also called *pâte*.
4. **a.** A hard, brilliant, lead-containing glass used in making artificial gems. **b.** A gem made of this glass. In this sense, also

called *strass*.

It takes no thought or leap of the imagination on the part of the consumer to determine the meaning of the proposed mark, THE PASTE, when viewed *in relation to* oral hygiene products in paste form. The examining attorney must always consider whether a mark is merely descriptive *in relation to* the identified goods, not in the abstract. *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ2d 15 (C.C.P.A. 1978); *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985); *In re American Greetings Corp.*, 226 USPQ 365 (TTAB 1985). TMEP §1209.01(b). As can be seen from the above definition, the term PASTE is a common English language term which is highly descriptive or generic *in relation to* oral hygiene pastes. Moreover, see again evidence from the Automated X-Search System already of record in this regard indicating that oral hygiene pastes exist in trade. For example, see U.S. Registration Number 2769528 already of record for “dental prophylaxis paste”. Moreover, see again evidence already of record from the world wide web referring to oral paste and oral dental paste in trade. See additional world wide web evidence now attached in this regard. And, as indicated above, the mere addition of the article “the” to the highly descriptive or generic term PASTE in stylized form cannot obviate the stated refusal. See the relevant definition of THE below:

## the1

the (*thē* before a vowel; *thə* before a consonant) *def.art.*

1. a. Used before singular or plural nouns and noun phrases that denote particular, specified persons or things: *the baby; the dress I wore*. b. Used before a noun, and generally stressed, to emphasize one of a group or type as the most outstanding or prominent: *considered Lake Shore Drive to be the neighborhood to live in these days*. c. Used to indicate uniqueness: *the Prince of Wales; the moon*. d. Used before nouns that designate natural phenomena or points of the compass: *the weather; a wind from the south*. e. Used as the equivalent of a possessive adjective before names of some parts of the body: *grab him by the neck; an infection of the hand*. f. Used before a noun specifying a field of endeavor: *the law; the film industry; the stage*. g. Used before a proper name, as of a monument or ship: *the Alamo; the Titanic*. h. Used before the plural form of a numeral denoting a specific decade of a century or of a life span: *rural life in the Thirties*.
2. Used before a singular noun indicating that the noun is generic: *The wolf is an endangered species*.
3. a. Used before an adjective extending it to signify a class and giving it the function of a noun: *the rich; the dead; the homeless*. b. Used before an absolute adjective: *the best we can offer*.
4. Used before a present participle, signifying the action in the abstract: *the weaving of rugs*.
5. Used before a noun with the force of *per*: *cherries at \$1.50 the box*.


[Middle English, from Old English *the*, alteration (influenced by *thæt*, neuter demonstrative pron., *thæs*, genitive demonstrative pron., etc.), of *se*, masculine demonstrative pron.][1]

The *final* requirement for an acceptable identification of goods is also maintained and continued. In this regard, the applicant may adopt the following: “oral hygiene products for medical use, namely, mouthwashes, antimicrobials and disinfectants in the nature of oral rinses and pastes, antiseptics, and oral solutions used to treat gingivitis, periodontitis, or halitosis” in International Class 5. TMEP section 804. Please note that, while an application may be amended to clarify or limit the identification, additions to the identification are not permitted. 37 C.F.R. §2.71(a); TMEP §1402.06. Therefore, the applicant may not amend to include any goods that are not within the scope of goods set forth in the present identification.

/Zhaleh Delaney/  
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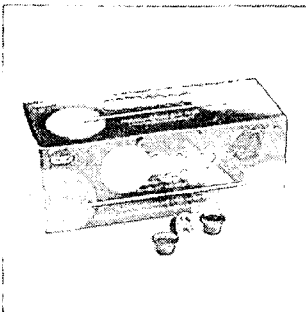
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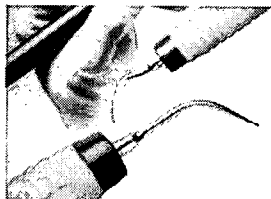
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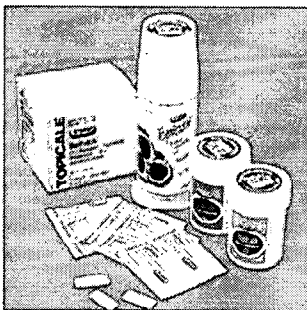
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