

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	87297154
LAW OFFICE ASSIGNED	LAW OFFICE 120
MARK SECTION	
MARK	https://tmng-al.uspto.gov/resting2/api/img/87297154/large
LITERAL ELEMENT	AQUAPRASE
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font style, size or color.

ARGUMENT(S)

Applicant respectfully requests reconsideration of the Examining Attorney’s Final refusal to register Applicant’s mark SN 87297154 **AQUAPRASE** for “Gems; Jewelry” in International Class 14 under Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1) on the grounds that the applied-for mark merely describes a feature or characteristic of Applicant’s goods. Applicant contests the Examining Attorney’s Section 2(e)(1) refusal and presents further arguments herein in support of registration of its mark.

History, Marketplace, Industry Use and Generic Advisory

In 2015, thanks to a keen eye and dogged determination co-Applicant and veteran gem explorer Yianni Melas discovered a brand new blue-green gem in Africa. Over the years people had stumbled on this stone out in the bush and everyone seemed to have different thoughts on what it was -- some thought Opal, others thought Chrysoprase and some thought Chrysocolla. No one had really seen any worth in it, but Melas took a pebble with him and was determined to find out where it came from and what it was. Seeking to get a final, conclusive word on what he held, Melas sent a sample to the Gemological Institute of America (GIA). Eventually, he received a phone call that said he had found “something incredible.” It was not a chrysoprase or a chrysocolla. It was a chalcedony that has never been discovered before. Applicant submitted into evidence as Exhibit A of its response filed October 12, 2017 the GIA Identification Reports dated May 17, 2017, June 1, 2017, and June 5, 2017, that identify the “species” or type of mineral discovered by Applicant as “chalcedony”.

Understanding the uniqueness of the find, Applicant funded and was one of the directors of the mine that was established to extract this raw chalcedony stone (see Exhibit A), and distribution and marketing of the stones was tightly controlled by Applicant – the exact location of the mine still remains a closely held secret. Moreover, and more importantly, as part of the efforts to market the find and ensure that consumers could be confident that the blue-green chalcedony they were purchasing was guaranteed to be natural and untreated, as has been advised in Applicant’s earlier Response, after discovery of the stone Applicant coined the mark **AQUAPRASE**, because it was suggestive of the variety of blue colors found in the stone while giving a nod to the waters of the Aegean Sea and its lush green vegetation surrounding Greece, Melas’ homeland. Applicant also secured trademark registrations for the **AQUAPRASE** mark in the EU and India (see Exhibits B and C) which is further confirmed in a letter from the gem testing laboratory GJEPC India (see Exhibit D). Moreover, all gemological labs belong to a lab group that streamlines all the names and laws for the good of the industry. Because of the existing trademarks in Europe and India, no lab anywhere in the world would be allowed to use the term **AQUAPRASE** without permission from Applicant.

Because of Applicant’s control of the mine and the rough stones that come out of it, any “**AQUAPRASE**” that is currently in the

marketplace necessarily comes from Applicant – otherwise it is merely generic blue-green chalcedony not originating from Applicant and is infringing on Applicant’s rights by suggesting a false designation of source of the stones. The Examiner notes that there are two major reasons for not protecting descriptive marks: (1) to prevent the owner of a descriptive mark from inhibiting competition in the marketplace and (2) to avoid the possibility of costly infringement suits brought by the trademark or service mark owner. Applicant contends that given its explanations about the source of its goods, reasoning for coming up with a brand name for its particular version of the goods, and its existing registrations of the mark in the EU and India, this is a clear evidence that the mark is exclusive to Applicant and should be allowed to be protected as a trademark in the United States, as well. Applicant is not seeking to prevent others from marketing an “aqua chalcedony” as many of the Exhibits the Examiner has attached refer to, or “blue-green chalcedony,” but its *particular* version of a blue-green chalcedony mined, distributed, and marketed by Applicant as **AQUAPRASE**. This is the literal definition of a “source”.

Furthermore, the International Colored Gemstone Association, the not-for profit trade association representing the international natural colored gemstone industry, explains in a letter submitted herewith as Exhibit E that “the gem trade calls gem materials by their mineralogical and gemological scientific names.... Individuals who market this material may call it what they believe will help sell the gem. Hence the term “Aquaprase” by Yianni Melas is one such name.”

Applicant is also submitting herewith as Exhibit F an email received from Mr. Nathan Renfrow of GIA confirming that the material known as “aquaprase” in the gem trade should be gemologically classified as “blue-green chalcedony”. Established in 1931, GIA is the world’s foremost authority on diamonds, colored stones, and pearls. A public benefit, nonprofit institute, GIA is the leading source of knowledge, standards, and education in gems and jewelry. GIA’s mission is to ensure the public trust in gems and jewelry by upholding the highest standards of integrity, academics, science, and professionalism through education, research, laboratory services, and instrument development. (See Exhibit G)

Applicant also points out that in order for a gemstone to be given a standard name or birthstone month it has to be first legalized by the World Jewelry Confederation (CIBJO), and that the name “aquaprase” is not listed in the CIBJO Blue Books (see Exhibit H).

Applicant is also providing information from the Jewelers Vigilance Committee (JVC) Central Bank of Descriptive and Generic Terms. As is explained at the top of the webpage, this list was created at the request of the USPTO to help educate trademark Examiners on what terms are considered descriptive and generic and should not be approved for trademark protection for gems and jewelry without a disclaimer. The term **AQUAPRASE** does not reside on this list (see Exhibit I). The list does, however, contain “chrysoprase”, which refutes the Examiner’s argument that “[a]s with chrysoprase, “aquaprase” is likely to be perceived by consumers of gemstones and jewelry containing gemstones as another common name for chalcedony that merely indicates the blueish green color range of the underlying stone” (see Exhibit J). The JVC list also contains the term “chalcedony” (see Exhibit J).

Based on all the information, arguments and evidence submitted herein and contrary to the Examiner’s assertions, it is clear that **AQUAPRASE** is not a common term for gemstones and competitors do not need to use this term to describe a type of chalcedony gemstone and jewelry using such gems. Because of the existing international trademark registrations they already cannot do so without permission from Applicant. Additionally, those who represent the jewelry industry in general have been clear that **AQUAPRASE** is a mark that designates *Applicant’s* goods and cannot be “generic,” because the generic name for the gemstone is “blue-green chalcedony.”

The Examining Attorney bears the burden of showing that a term is merely descriptive of the relevant goods, and Applicant respectfully argues that in this case this burden has clearly not been met. Accordingly, Applicant requests that the Section 2(d) refusal and generic advisory in relation to the mark being a common term for the underlying gemstones be withdrawn.

Combined Terms are Not Merely Descriptive

Applicant also maintains that its mark **AQUAPRASE** is not merely the combination of two descriptive terms commonly used to describe and/or identify the gemstone chalcedony, and jewelry using such stones. As Applicant notes above, argued in its earlier response, and as well as is evidenced in the Examiner’s Attachment 1 to the current action, the word “aqua” has multiple meanings, i.e. water, an aqueous solution, a light bluish green to a light greenish blue. The definition provided of “prase” (OA at page 16/162) states it is a light green or light grayish-green variety of translucent chalcedony, but the Examiner’s evidence from mindat.org (OA at page 41/162) states in relation to the

term “prase” that “Originally, the varietal name “prase” was applied to a dull leek-green colored quartzite (a rock, not a mineral); but over the years it has been applied to other materials, particularly a green colored jasper of a similar color.... Basically, the term no longer has any scientific rigor – it has become a general term; it can’t even truly be called a varietal name any longer – since it covers more than one material”. Applicant also notes that the term ‘prase’ is not listed as a descriptive or generic term in the JVC directory (see Exhibit K).

It is a general and well-established principle that “a mark comprising a combination of merely descriptive components is registrable if the combination of terms creates a unitary mark with a unique, nondescriptive meaning....” T.M.E.P. §1209.03(d)(October 2015 ed.). The Ninth Circuit, in *California Cooler, Inc. v. Loretto Winery, Ltd.*, 227 U.S.P.Q. 808, 774 F.2d 1451 (9th Cir. 1985), recognized that “words which could not individually become a trademark may become one when taken together.... It is the likely reaction of customers to the total mark that is at issue.... Thus, the composite may become a distinguishable mark even though its individual components individually cannot.” Id. at 1455.

Ultimately, the dissection of a mark, or portion of a mark, into its component parts, as the Examining Attorney does with the terms “AQUA” and “PRASE”, stands against the clear weight of case law and the Trademark Office’s own rules of examination. See *Coca-Cola Co. v. Seven-Up Co.*, 497 F.2d 1351 (C.C.P.A.1974)(“We have said, so often as not to require citation of authority, that marks must be viewed as the public sees them, i.e., in their entireties.”) It is therefore well-settled that the validity of a mark is not judged by an examination of its individual parts, but rather by ultimately viewing the trademark as a whole. See *California Cooler, Inc.*, 774 F. 2d at 1455. In the present case, the Examining Attorney has improperly dissected Applicant’s mark **AQUAPRASE** into its component parts and ignores the fact that the terms individually have multiple meanings, and thus connotations. The parts, when taken as a whole as they must be, does create a unique, unitary phrase that is suggestive, not merely descriptive. There is no such thing as “aquaprase,” other than Applicant’s coined, unitary and suggestive mark for gemstones and jewelry which has no specific meaning other than to hint to Applicant’s consumers that its goods may in someway relate to water (are the stones found there? Do they contain water?) or does “aqua” relate instead to the coloring? And does “prase” refer to a type of stone, and if so, which one? Or does this also or instead relate to the coloring? Or is it a phonetic equivalent of the word “praise”? All of these are viable and possible options for interpretation of the meaning of the term as it relates to gemstones and jewelry. As esteemed trademark commentator J. Thomas McCarthy states, “[I]f the mental leap between the word and the product’s attributes is not almost instantaneous, this strongly indicates suggestiveness, not direct descriptiveness.” McCarthy on Trademarks and Unfair Competition, Vol. 2, § 11:67, p. 11-12. In this case, it takes imagination and thought on the part of the consumer to determine the meaning of Applicant’s mark as a whole in relation to the goods. Because it conveys no immediate, singular explanation of the goods, as a mark **AQUAPRASE** is suggestive, not merely descriptive, and is entitled to registration on the Principal Register.

The Trademark Trial and Appeal Board has noted on a number of prior occasions that there is a thin line of demarcation between a suggestive and a merely descriptive designation. To the extent that any of the Examining Attorney’s arguments and evidence 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. See e.g., *In re Atavio*, 25 USPQ2d 1361 (TTAB 1992); *In re Morton-Norwich Products, Inc.*, 209 USPQ 791 (TTAB 1981); and *In re Gourmet Bakers, Inc.*, 173 USPQ 565 (TTAB 1972).

In view of the arguments and evidence presented herein and incorporated by reference from previous responses, the subject mark cannot realistically be considered “merely” descriptive and Applicant respectfully requests that the Section 2(e) refusal be withdrawn and its mark be approved for prompt passage to publication.

In the Alternative, Supplemental Registration Requested

Although Applicant believes its mark is entitled to registration on the Principal Register, strongly stands by its arguments above and in its prior response in favor of registration on the Principal Register, and respectfully requests the same, in the alternative, Applicant requests registration on the Supplemental Register.

EVIDENCE SECTION

EVIDENCE FILE NAME(S)

.JPG FILE(S)

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DESCRIPTION OF EVIDENCE FILE	information referenced within the body of Applicant's argument
SIGNATURE SECTION	
RESPONSE SIGNATURE	/RLD/
SIGNATORY'S NAME	Renée L. Duff
SIGNATORY'S POSITION	Attorney of record, NY bar member
SIGNATORY'S PHONE NUMBER	914-262-9223
DATE SIGNED	05/03/2018
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Thu May 03 22:23:58 EDT 2018
TEAS STAMP	USPTO/RFR-XX.XXX.XXX.XX-2 0180503222358655235-87297 154-510df140c537dea329af3 723157fe6955a9ed90a4fa3aa 688e93a4dadfa3047-N/A-N/A -20180503221537591172

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To the Commissioner for Trademarks:

Application serial no. **87297154** AQUAPRASE(Standard Characters, see <https://tmng-al.uspto.gov/resting2/api/img/87297154/large>) has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

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