

Attorney Docket No.: 051788-501USTM  
Mark: INFINITY LABS  
Application Serial No.: 87657822

### **REMARKS**

This is a Response to the Final Office Action issued July 17, 2018. The Examining Attorney has maintained the disclaimer requirement for the term “LABS” for the entirety of the mark, INFINITY LABS. However, Applicant respectfully disagrees that a disclaimer is needed for all goods and services set forth in the Application.

Applicant has already entered in its June 29, 2018 Response to Office Action a disclaimer of the term “LABS” for a limited number of services. The Examining Attorney maintains the requirement for Applicant to enter a disclaimer for the remaining services in the Application; however, Applicant respectfully asserts that the remaining services in the application do not require a similar disclaimer as the term “LABS” is not descriptive of these services under U.S. trademark law.

As the Examining Attorney is likely aware, it is well settled that a mark or term is merely descriptive only if the term immediately, without speculation or conjecture, conveys knowledge of a significant quality, characteristic, function, feature or purpose of the goods with which it is used. *In re Gyulay*, 3 USPQ2d 1009 (Fed. Cir. 1987) (emphasis added.) “If one must exercise mature thought or follow a multi-stage reasoning process in order to determine what product or service characteristics the term indicates, the term is suggestive rather than merely descriptive.” *In re Tennis in the Round, Inc.*, 199 USPQ 496, 497 (TTAB 1978); *In re Shutts*, 217 USPQ 363, 364-65 (TTAB 1983); *In re Universal Water Systems, Inc.*, 209 USPQ 165, 166 (TTAB 1980). Here, it is readily apparent that the term “LABS” does not immediately “without speculation or

conjecture” convey information about the remaining services in the application, which are listed below. Our comments on each Class of services follow.

Class 36: Incubation services, namely, providing financing to freelancers, start-ups, existing businesses and non-profits; Think tank services in the nature of consultation services in the field of digital finance

It is readily apparent that services related to providing financing and consultation services related to finance have little to no relation to “laboratories” or “labs.” With respect to the specific registrations submitted as evidence, the registrations are for business and consulting services that have nothing to do with Applicant’s finance related services. Applicant of course cannot speak to why the applicants of the cited registrations chose to enter the respective disclaimers; but Applicant herein is not held to the same standard under the TMEP as each application must be decided on its own merits. The definition of “Labs” cited by the Examining Attorney, “a place equipped for experimental study in a science or for testing and analysis” (the “Cited Definition”) itself proves that the term is not descriptive for the above financing and consulting services in the field of finance—at bare minimum these services make not reference to a “place” as the Cited Definition sets forth. No multi-step reasoning process is even necessary to connect “LABS” to the Class 36 financing services as it simply unequivocally and conspicuously not descriptive.

Class 40: Think tank services in the nature of consultation services in the field of additive manufacturing

Similar to the Class 36 services above, the Class 40 services make no reference--either obvious or implied--to a “place” for experimentation as defined by the Cited Definition.

As evidence in support of the disclaimer, the Examining Attorney cites a mere three registrations which utilize a disclaimer in connection of think tank services. As the Examining Attorney is aware, “third-party registrations are not conclusive on the question of descriptiveness. Each case must stand on

its own merits.” TMEP 1209.03(a); *In re theDot Commc’ns Network LLC*, 101 USPQ2d 1062, 1067 (TTAB 2011). And even if third-party registrations were sufficient evidence to conclude descriptiveness, certainly evidence in the form of three registrations would not be sufficient to conclude descriptiveness.

Further, “think tank” is defined by Merriam-Webster (the same source to which the Examining Attorney has relied upon for definitions in this case) as “an institute, corporation, or group organized to study a particular subject (such as a policy issue or a scientific problem) and provide information, ideas, and advice.” **See Exhibit A**. Nowhere does this definition imply use of a “lab.” And even if it does, the consumer would need to go through a multi-stage reasoning process to gather any information about the services from the term “LABS” in the mark. Indeed, “LABS” is a well-known abbreviation for “laboratory” as shown in the Merriam-Webster definition evidence cited by the Examining Attorney, and a laboratory is understood to have an association with science and experimentation. For a consumer viewing the term “LABS” to come to a conclusion that it references “think tank services” would require a connection of a “place” for scientific experimentation to an “institute, corporation, or group” who might study (not necessarily “experiment”) a particular problem, which may or may not have a relation to science. It’s a tenuous connection at best, and certainly does not immediately convey information about the services as required by U.S. trademark law.

Class 41: Education services, namely, providing on-line classes, seminars, meet-ups, and workshops in the fields of retail, software design, technology research and development, and customer service; Education services, namely, one-on-one mentoring in the field of retail technology

Here again, at the outset, simply because other third-parties have agreed to disclaim “LABS” for education related services does not imply that Applicant is required to do the same. Indeed, the particular education services at issue here do not have a connection to the Cited Definition. There is no implication of a “place” for experimentation—these are not education services in the nature of traditional scientific subject matter such as biology or chemistry which would have an implied laboratory component as part of the services. With respect to the specific

education services in this application that are related to retail technology, the term “LABS” is at most suggestive. A consumer must engage in a multi-stage reasoning process to glean any information about the education services related to retail technology from a simple viewing of the term “LABS.” First a consumer would interpret the term “LABS” under the common knowledge definition of “labs”/ “laboratory” with respect to scientific experimentation, then the consumer would need to understand what “retail technology” actually is, and then understand where the traditional definition of “labs” comes into play with respect education services related to “retail technology.” The connection is simply not readily apparent, and the term “LABS” would be at most “suggestive” but certainly not descriptive.

Class 42: Providing temporary use of on-line non-downloadable software development tools; Collaborative computer programming for others in the nature of hackathons; Think tank services, namely, providing new ideas and concepts for web-based applications for others; Think tank services in the nature of technical consultation services in the field of smart cities technologies and digital governments technologies, industrial Internet of Things, enterprise mobility technologies, pervasive computing, machine intelligence, cognitive computing, digital optics technologies, mixed reality, block chain, biometric identity systems, hyperimaging, artificial vision, cyber defense, digital forensics, neuromorphic chips, neural analytics, quantum computing, and cryptography; Platform as a service (PAAS) services, namely, hosting software for use by others for use in research, design, and utilization of block chain software, robotic process automation, social networks, machine learning, Internet of Things, augmented reality, and advanced analytics; Computer services, namely, hosting on-line web facilities for others for organizing and conducting online meetings, gatherings, and interactive discussions

Finally, with respect to the above Class 42 services, there is simply no obvious connection between “LABS” and the software services listed above. The Examining Attorney appears to base the disclaimer requirement for the above services on third-party registrations that also reference software. But of course, a simple similar reference to software services cannot conclude that Applicant is required to enter a disclaimer for a term unrelated to its services. For instance, “*Providing temporary use of on-line non-downloadable software development tools*”

simply has no connection to the term “LABS.” As discussed above, the Cited Definition discusses a “lab” as a place for experimentation. There is just no connection that can be made to use of online non-downloadable software. Similarly, “*Platform as a service (PAAS) services*” and “*Computer services, namely, hosting on-line web facilities*” have no connection to “LABS.” Perhaps the services being offered—which of course are products offered via services—were *developed* in a lab; but that is the closest connection one could make, and would have no descriptive character of the actual services being offered, which are finished “products.”

Additionally, with respect to the *think tank services*; as discussed above, the definition of “think tank” services to connote an institution or organization that studies a subject. Subjects can be studied outside of a laboratory—in a conference room, in an office, in a cafeteria, at a dining room table. Any connection to think tank services that would be gleaned from “LABS” would have to be part of a multi-stage reasoning process that 1) first understanding the meaning of “LABS,” then 2) understands the meaning of think tank services (which is not necessarily common knowledge to all consumers), and finally 3) understand that studying of a subject by the think tank *could* be completed in a “LAB.”

Finally, it is settled that the burden is on the United States Patent and Trademark Office to make a prima facie showing that the mark or word in question is descriptive from the vantage of purchasers of applicant’s goods and services and, where doubt exists as to whether a term is descriptive, such doubt must be resolved in favor of the applicant. *In re Merrill Lynch, Pierce, Fenner and Smith, Inc.*, 828 F.2d 1567 (Fed. Cir. 1987); *In re The Gracious Lady Service, Inc.*, 175 USPQ 380 (TTAB 1972). Here, for all of the reasons discussed above, it is clear that there is significant doubt as to whether the term “LABS” is merely descriptive of Applicant’s services

under Trademark Act Section 2(e)(1), as required for a finding of prima facie case of merely descriptiveness. This doubt must be resolved in Applicant's favor.

Because Applicant has responded to all issues raised by the Examining Attorney, Applicant respectfully requests the application be approved for publication. Should the Examining Attorney have any questions, he is invited to contact Applicant's counsel at (202) 585-8210.

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