

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.: 88304391 :
Mark: PHILTER :
Applicant: Mountain Fog, Inc. :
Application Date: February 16, 2019 :

REQUEST FOR RECONSIDERATION

Applicant, Mountain Fog, Inc. (“Applicant”), through undersigned counsel, submits the following Request for Reconsideration in response to the Office Action issued on September 6, 2019:

Applicant seeks to register PHILTER in Class 042 for use in connection with “[s]oftware as a service (SAAS) services featuring software for analyzing, reporting, and removing protected health information from natural language text.” On April 29, 2019, the Examining Attorney issued an Office Action refusing to register the mark pursuant to Section 2(e)(1) on the basis that it is merely descriptive of Applicant’s software services. Applicant responded to the Office Action on August 30, 2019, and the Examining Attorney issued an Office Action on September 6, 2019 making the Section 2(e)(1) refusal final. Applicant now requests that the Examining Attorney reconsider the final refusal and approve Applicant’s mark for registration on the Supplemental Register.

As part of this Request for Reconsideration, Applicant requests that its application be amended to seek registration of PHILTER on the Supplemental Register. An amendment to the application seeking registration on the Supplemental Register is a procedurally acceptable response to a final refusal issued on the basis of Section 2(e)(1). TMEP 816.04. “An amendment to the Supplemental Register after refusal presents a new issue requiring consideration by the

examining attorney, unless the amendment is irrelevant to the outstanding refusal. If the examining attorney determines that the proposed mark is incapable of identifying and distinguishing the applicant's goods or services, the examining attorney must issue a nonfinal refusal of registration on the Supplemental Register..." Id. Even if PHILTER is merely descriptive of Applicant's services, as the Examining Attorney asserts, the mark is nevertheless capable of identifying and distinguishing Applicant's services (see 15 U.S.C. §1091) and should be approved for registration on the Supplemental Register.

Notably, the Examining Attorney did not assert in the prior Office Actions that PHILTER is generic, and there is no basis for such a conclusion. A mark is a generic if it refers generally to the class or category of goods or services that the mark is used on or in connection with. In re Dial-A-Mattress Operating Corp., 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001) (citing H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc., 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986)). The test for genericness is whether the relevant public would understand the term as referring to a class or category of goods or services. In re American Fertility Society, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999). See also, TMEP 1209.03(v) (citing Royal Crown Co. v. Coca-Cola Co., 892 F.3d 1358, 127 USPQ2d 1041, 1046 (Fed. Cir. 2018)). "The examining attorney has the burden of proving that a term is generic by clear evidence." TMEP 1209.01(c)(i) (citing In re Nordic Naturals, Inc., 755 F.3d 1340, 1344, 111 USPQ2d 1495, 1498 (Fed. Cir. 2014)). To satisfy that burden, "the examining attorney must show that the relevant public would understand the mark as a whole to have generic significance." Id. (citing In re 1800Mattress.com IP LLC, 586 F.3d 1359, 1363, 92 USPQ2d 1682, 1684 (Fed. Cir. 2009)). "Doubt on the issue of genericness is resolved in favor of the applicant." In re DNI Holdings Ltd., 77 USPQ2d 1435, 1437 (TTAB 2005).

Applicant's services are in the class or category of software services, and the term PHILTER plainly does not refer to software services as a class or category. The relevant public could not possibly discern from the term PHILTER alone what class or category of goods or services Applicant offers in connection with that mark. Even if PHILTER could be viewed as descriptive of filtering as a function or purpose of Applicant's software services (as the Examining Attorney asserts in the prior Office Actions), the term PHILTER does not indicate the class or category of services (*i.e.* software services) in which Applicant offers those services.

Moreover, there is no inherent connection between filtering and software services, and thus filtering is not a key aspect of software services. In other words, even if the relevant public could assume from the term PHILTER that Applicant's services involve filtering, they could not determine that Applicant provides software services as the means of accomplishing such filtering. It is just as likely that Applicant could be offering coffee filters, oil filters, air filters or any other number of goods and services that perform the function of filtering.

Finally, PHILTER cannot be viewed as generic because Applicant's unique spelling of PHILTER helps the term to function as a trademark. Applicant's spelling of PHILTER is not a mere misspelling of "filter," but rather is an intentional effort to incorporate the letters PHI into the mark. The letters PHI are a reference to Protected Health Information, which is the type of information analyzed and processed by Applicant's software services. See Applicant's August 30, 2019 Response to Office Action at Exhibit 1. Just as with the term PHILTER, the letters PHI (which are likely to be recognized by the relevant public as referring to Protected Health Information) do not refer to the class or category of services that Applicant offers. Applicant is not offering Protected Health Information itself, but rather offers a software service that analyzes and processes Protected Health Information. Even if the relevant public assumes from Applicant's

use of the letter PHI that the Applicant's services involve Protected Health Information in some way, nothing in those letters (or in the term PHILTER as a whole) indicates that Applicant is providing a software service.

For all of the reasons set forth above (along with those set forth in Applicant's August 30, 2019 Response to Office Action, which are incorporated herein), Applicant respectfully requests that the Examining Attorney approve Applicant's application for registration on the Supplemental Register because the mark is capable of identifying and distinguishing Applicant's services.

Respectfully submitted,

TUCKER ARENSBERG, P.C.

Dated: February 26, 2020

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