

UNITED STATES DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Applicant: Amirsys, Inc.) Trademark Law Office 101
Mark: WIZARD) Examining Attorney: Jacqueline A. Lavine
Serial No.: 85472127)
Filed: November 17, 2011)

Applicant Amirsys, Inc. (“Applicant”) respectfully submits this response to the office action dated April 25, 2012. The office action refused registration of Applicant’s WIZARD mark (the “Mark”) on the basis that the Mark “merely describes the purpose and function of applicant’s goods.” Applicant respectfully requests that the refusal to register the Mark be withdrawn.

The office action contends that the Mark is merely descriptive and that registration must be denied under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), because the term “wizard” is “descriptive of a utility within software that helps the application perform a particular task,” and “the applicant’s online software appears to include a wizard as it relies on user inputs in order to perform its function.” The Section 2(e)(1) refusal is incorrect for three reasons.

First, the fact that software “relies on user inputs in order to perform its function” does not make it a software “wizard” in the descriptive sense. None of the definitions quoted by the office action contains or supports such a broad definition of the term “wizard.” Indeed, if that were the definition, *all* application software would be a “wizard,” whether or not it contained a “utility within software that helps the application perform a particular task.” For example, a word processing application “relies on user inputs in order to perform its function,” but no one considers the word processing application itself as a “wizard.” The term “wizard” only applies to a particular utility within the word processing application. For example, as quoted in the office action, “a ‘letter wizard’ within a word processing application would lead you through the steps of producing different types of correspondence.” Thus, reliance on user input does not make software a “wizard.”

Second, Applicant’s online software “is not, nor does it contain, a ‘wizard’ in the descriptive sense of a software utility that helps the application perform a particular task or set of tasks. Specifically, Applicant’s software provides no assistance of any kind to help the user setup or configure his or her software or hardware settings, does not act as a guide for creating new documents, and does not provide any user interface to lead a user through a series of questions or tasks. Quite the contrary, Applicant’s software provides the user with an unconstrained variety of non-linear options to interact with the software application to access content.” (Declaration of Chuck Clark, submitted herewith, ¶ 2.) The Mark therefore is not descriptive of Applicant’s goods or services. The Mark as used in connection with Applicant’s online software instead connotes something “magical,” as in the more common definition of “wizard” as a magician. The fact that the Mark has more than one possible meaning or connotation makes the mark suggestive, and therefore

registrable, because it requires some thought or perception to determine which of the meanings is intended. *See* TMEP § 1209.01(a). A Section 2(e)(1) refusal is therefore inappropriate.¹

Third, if reasonable people could differ as to the descriptiveness or suggestiveness of the mark, the proper practice is to resolve the question in the applicant's favor and publish the mark for opposition. *See In re Conductive Systems, Inc.*, 220 U.S.P.Q. 84 (TTAB 1983); *In re The Gracious Lady Serv., Inc.*, 175 U.S.P.Q. 380, 382 (TTAB 1972). In other words, in ex parte examination of a trademark application, any doubt as to whether the mark is merely descriptive or suggestive should be resolved in favor of the mark's publication. *Goodyear Tire & Rubber Co. v. Continental General Tire Inc.*, 70 U.S.P.Q.2d 1067, 1070 (TTAB 2003). In this instance, the Mark is not descriptive but is at a minimum suggestive because it connotes something magical. Even if there were any doubt about that assertion, the proper course would be to publish the Mark for opposition. *See id.*

For these reasons, Applicant respectfully requests that the Section 2(e)(1) refusal to register the Mark be withdrawn and that the application be approved for publication.

¹Even if the Mark were merely descriptive as to Applicant's software (which it isn't), a complete denial of the application would not be appropriate in any event. That is because Applicant has sought registration of the Mark not only with respect to software and online software IC 9 and IC 42 but also in IC 35 for online retail store services, IC 38 for electronic transmission of data, text, images, audio and video, and IC 41 for electronic publishing services.