

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Green Hills Software, Inc.

Serial No.: 86/929,196

Peter Dang
Examining Attorney
Law Office 121

Mark: HISTORY

Our Ref.: GHSO 1600038

RESPONSE TO OFFICE ACTION

This is in response to the Office Action mailed on April 16, 2018.

The Examining Attorney refused registration of Applicant's mark on mere descriptiveness grounds. 15 U.S.C. Section 1052(e)(1). In addition, the Examining Attorney requests further information regarding Applicant's goods. Taking the second issue first, Applicant responds to the Examining Attorney's inquiries as follows:

- 1. Whether the wording "HISTORY" has any significance in relation to applicant's goods?**

ANSWER: Only as a trademark.

- 2. If yes to (2), please describe this significance.**

ANSWER: As a trademark

- 3. Please describe the function and purpose of the "HISTORY ANALYSIS TOOL" referenced in the specimen.**

ANSWER: The actual use is as "History analysis tool," which is use of HISTORY used as a brand for a software and microprocessor based systems analysis tool. Otherwise, see answers to Questions 4 and 5.

- 4. Whether applicant's software performs any functions or uses in connection with the history of any data, operating software, microprocessors, or other use or function of the software.**

ANSWER: Applicant's software (The History analysis tool) is a visualization tool for data, events, and function flow for software executing on a microprocessor that has been captured into a log file.

5. Whether applicant's software saves any records of user inputs?

ANSWER: The History analysis tool is able to save a record of any of the data visualized in the tool. This data could include user inputs to the target microprocessor, but typically it involves the internal operation of embedded software for the microprocessor for the objectives it is used—which can be in many different technical fields, such as aerospace, industrial and telecom. Typically, this data is gathered from a log captured during the execution of software on a microprocessor and the tool analyzes it after the fact. Like almost any software the History analysis tool can save records of user input but the ratio of these would be on the order of one to millions or even billions of executions by the software itself during its operation, and actions that typically take place over very short time frames (nanoseconds or even picoseconds). Although the software can save data (again, as any software can) its main utility is the ability to visualize the microprocessor data and how the microprocessor and its embedded software actually function.

6. Whether applicant's software allows users to access any records of previous user inputs?

ANSWER: See answer to question 5.

7. Whether the word "HISTORY" is used to market applicant's goods? If yes, please describe how applicant's goods are marketed using this word.

ANSWER: It is used as a brand to market the goods.

As to the refusal based on mere descriptiveness, the Examining Attorney contends that Applicant's mark HISTORY is merely descriptive of the named goods. In support of the refusal, the Examining Attorney encloses on-line definitions of "History" including one stating; "all recorded events in the past." Others, from the Computer Online Dictionary and from Computerhope.com, define "History" as "a record of user inputs" and, similarly, as a feature in all Internet browsers that saves webpages and images accessed by a user. The Examining Attorney then concludes that HISTORY merely describes the named software goods because Applicant states their function as an: "Integrated Development Environment with History analysis tool" and it appears that Applicant's software "analyzes the 'History' or recorded data

from the past of certain records.” Further attached excerpts from Applicant’s manual for its MULTI product assertedly shows “that applicant’s software features a “HISTORY” function that allows users to view and manage previously uploaded files and data.” Based on this information, the Examining Attorney determined that the mark is merely descriptive.

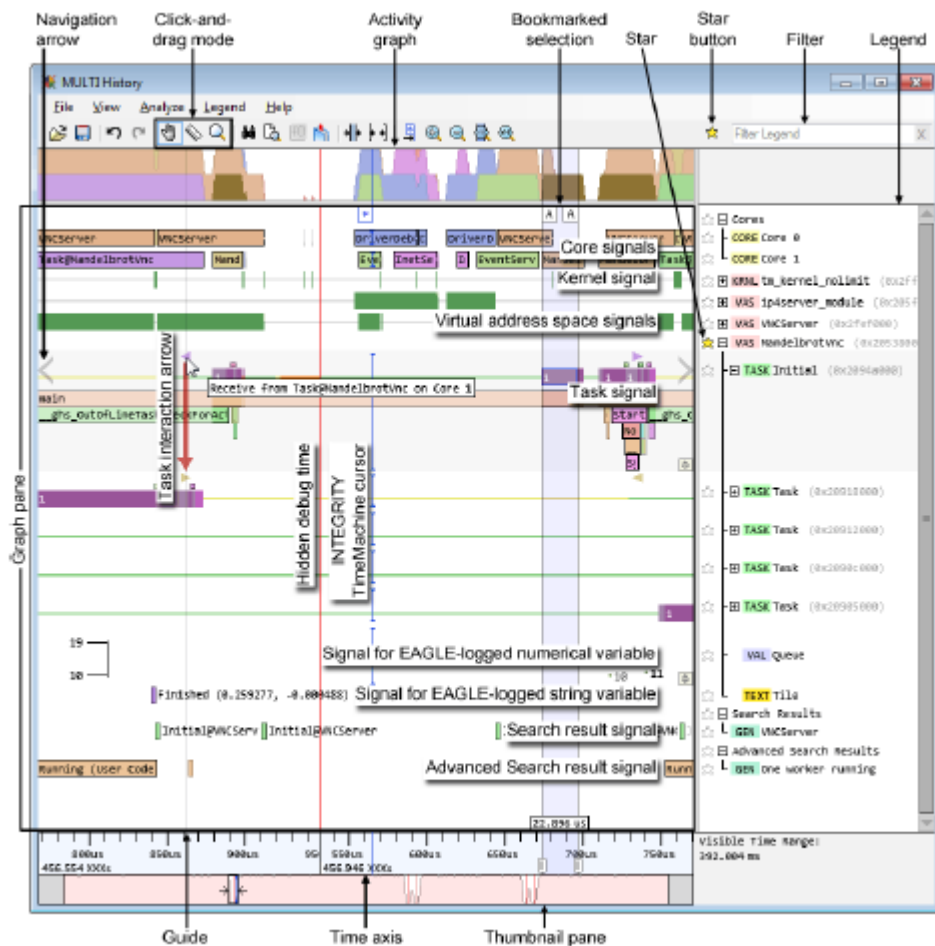
Applicant points out that the rationale provided in support of the refusal is itself highly vague and unclear, and fails to demonstrate that Applicant’s mark “merely describes” any specific feature, function, purpose, use or characteristic of Applicant’s named goods. As such, Applicant respectfully traverses the refusal to register and requests the Examining Attorney reconsider and withdraw the finding of mere descriptiveness.

At the outset, we note that the excerpts the Examining Attorney relies on from the Applicant’s MULTI and IDE manual reference use of its HISTORY mark as a brand in connection with various modules of the Applicant’s software goods, including the HISTORY Browser, which comprises a user interface portal for the software. There are other HISTORY branded features such as the HISTORY Window, which Applicant will discuss further herein. Each of these modules contribute to the overall HISTORY branded software functionalities. These excerpts show proprietary use of Applicant’s mark as a mark and are not evidence of mere descriptiveness.

Insofar as the Examining Attorney also contends that HISTORY merely describes the named goods based on its dictionary definition, Applicant respectfully disagrees. The dictionary definitions of “History” reflect its use for a chronicle of events, mainly human events through time normally measured in years, decades or centuries. The generalized definition of “all recorded events” simply is not germane to Applicant’s software which analyzes operations of embedded software in high-tech Real Time Operating Systems (RTOS) in applications such as

aerospace, industrial systems, automobiles and medical devices. These operations present literally millions of executions and operate on a time scale of nano- and picoseconds. To give an idea of this time span, in the two seconds it takes to read this sentence, two million picoseconds have passed. This time scale is simply beyond the reference point ordinarily referred to by the proffered definition of “history.”

Applicant’s software is used to detect abnormalities in the function of a particular microprocessor, according to an infinitesimally small time span. These abnormalities, or interrupts, are displayed and charted for interpretation. The typical interface showing this is called the HISTORY Window, a sample of which follows:



Applicant submits this is not a record of “all events from the past” as contemplated within the dictionary definitions advanced to support the refusal to register. Nor is it an Internet browser, and it does not reflect a “browsing history” an “Internet history” or a “web history” as contemplated by the definition from the Computer Dictionary and ComputerHope sources.

HISTORY simply does not merely describe the named goods. For a mark to be refused as “merely descriptive” under Section 2(e)(1), the Examining Attorney must show that it *directly and immediately* conveys knowledge of the ingredients, qualities, or characteristics, functions, features or purposes of the goods at issue. *In re Quik-Print Copy Shop Inc.*, 205 U.S.P.Q. 505 (CCPA 1980). If construing the mark *requires imagination, thought, or perception* to reach any conclusions as to the nature of the goods at issue, then the mark is at most suggestive, and inherently registerable. T.M.E.P. §1209.01(a); *In re Shutts*, 217 U.S.P.Q. 363 (T.T.A.B. 1983). HISTORY here does not immediate or directly convey the goods characteristics, features or functions—rather as applied to Applicant’s goods its meaning is abstract and overly generalized, requiring significant thought or perception to reach any tangible conclusion.

In contrast, HISTORY suggests a human chronicle of events in an ordinary time span—i.e., days, months, years, decades, etc., not an analysis tool that finds and analyzes interrupts taking place in picoseconds during operation of embedded microprocessor software. In this regard, “mere” or “merely” means “only”, i.e., to be “merely” descriptive, the mark must do *no more than describe*. *In re Quik-Print*, 205 U.S.P.Q. at 507. Descriptiveness is also determined in relation to the particular goods as identified in the application, not in the abstract. *In re Bright-Crest, Ltd.*, 204 U.S.P.Q. 591 (T.T.A.B. 1979). Even if the mark conveys some relation to the properties of the named goods, if this connection is not direct or immediate, the mark is suggestive and not merely descriptive. *Physicians Formula Cosmetics Inc., v. West Cabot*

Cosmetics, Inc., 8 U.S.P.Q.2d 1136, 1138 (2nd Cir. 1988) (PHYSICIAN'S FORMULA not merely descriptive of hypoallergenic skin care products). Here, considering Applicant's software used to analyze the operation of microprocessors, HISTORY does not *merely* describe, at most it suggests.

The decision in *In re TMS Corporation of the Americas*, 200 U.S.P.Q. 57 (T.T.A.B. 1978) illustrates the proper analysis. In that case, the Trademark Board reversed a refusal to register THE MONEY SERVICE for a financial service (in which funds were transferred between accounts in remote locations) on grounds that the mark was suggestive rather than descriptive. The Board found that the mark had several possible meanings, so that it did not *forthwith* convey a single meaning to the consumer. Since it was vague, the consumer had to use imagination to connect the meaning of the mark to the services. The Board said:

[The mark] suggests a number of things, but yet falls short of describing applicant's services in any one degree of particularity. To effect a readily understood connection between applicant's mark and its services requires the actual or prospective customer to use thought, imagination and perhaps an exercise in extrapolation. In short, what we are saying is that applicant's mark "THE MONEY SERVICE" does not directly or indirectly convey any vital purposes, characteristics or qualities of applicant's services. Thus, the mark is suggestive and not a merely descriptive designation."

200 U.S.P.Q. at 59.

The mark here, HISTORY, also has multiple possible meanings and interpretations, and even the rationale supporting the refusal fails to identify any particular interpretation that describes the goods with any degree of particularity—it instead postulates three different dictionary definitions without choosing any one as specific or applicable. The refusal as such is then based on a hodgepodge of vague assumptions. Therefore, in the words of the Board in THE MONEY SERVICE case, the mark "falls short of describing applicant's [goods and services]" and thus, must be considered suggestive and registerable.

{F2789943.1 }

The fact that HISTORY is also a dictionary term is of no consequence here as it does not merely describe the goods. It must be remembered that even ordinary terms are often deemed suggestive and readily registerable within the context of certain goods. For example, ICE CREAM was deemed registrable for chewing gum, *Borden Inc. v. Topps Chewing Gum, Inc.*, 173 U.S.P.Q. 447 (T.T.A.B. 1972); CRANBERRY is not merely descriptive for latex examination gloves, *Malatex USA Inc., v. Colonial Surgical Supply, Inc.*, 44 U.S.P.Q.2d 1291 (N.D. Cal. 1997); FRUIT SUNDAE was found registrable for yogurt, *Johnston Foods, Inc. v. Carnation Co.*, 159 U.S.P.Q. 624 (T.T.A.B. 1968) and LASER does not merely describe loudspeakers, *In re Rank Organization, Ltd.*, 222 U.S.P.Q. 324 (T.T.A.B. 1984). These cases demonstrate that more than just an indirect association in meaning is required to establish mere descriptiveness.

Lastly, Applicant stresses that the Examining Attorney bears the burden of demonstrating mere descriptiveness by a preponderance of evidence. The record here fails to meet this burden. Even insofar as there are any doubts concerning the descriptive significance of Applicant's mark, these doubts are to be resolved in favor of Applicant and of passing the mark to publication. *In re Conductive Systems Corp.*, 220 U.S.P.Q. 84 (T.T.A.B. 1972).

With the above, Applicant submits that all questions in the Office Action are now answered and respectfully requests that this application be passed for publication.