

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

May 6, 2019

Joshua S. Toy
Examining Attorney
Law Office 120
United States Patent and Trademark Office

RE: Serial No.: 88/127,627
Mark: **THE INTERNET OF WINE**
Office Action Date: November 5, 2018

APPLICANT'S RESPONSE TO NON-FINAL OFFICE ACTION

Constellation Brands U.S. Operations, Inc. ("Applicant") hereby responds to the November 5, 2018 Office Action ("Office Action") issued by Joshua S. Toy ("Examining Attorney") concerning Application Serial No. 88/127,627 (the "Subject Application") for **THE INTERNET OF WINE** ("Mark") for the following services in International Class 41:

Continuing education services, namely, providing live and on-line continuing professional education seminars in the field of marketing of wine, spirits and beer; Education services, namely, providing on-line information and instruction in the field of manufacture, distribution, sales, consumer marketing and engagement in the wine, spirits and beer industries; Educational services, namely, conducting informal on-line programs in the fields of wine, spirits and beer industries, and printable materials distributed therewith; Educational services, namely, conducting informal programs in the fields of wine, spirits and beer industries, using on-line activities and interactive exhibits, and printable materials distributed therewith; Leadership development training in the field of business in the fields of wine, spirits and beer; Providing continuing business education courses; Providing education in the field of using artificial intelligence, block chain technology, virtual reality, augmented reality in the manufacture, distribution, sales, consumer marketing and engagement in the wine, spirits and beer industries rendered through video conference; Providing information on-line relating to educational opportunities; Providing a web site that features informal instruction on manufacture, distribution, sales, consumer marketing and engagement in the wine, spirits and beer industries; Providing information and news in the field of current events relating to manufacture, distribution, sales, consumer marketing and engagement in the wine, spirits and beer industries ("Applicant's Services").

I. BACKGROUND

The Examining Attorney has initially refused registration of the Mark on the basis that it “merely describes a feature of applicant’s services.” The Examining Attorney also has required an amendment of Applicant’s Services “because it is too broad and could include services in other international classes.” Applicant hereby submits that the Mark is not merely descriptive of Applicant’s Services and is at least suggestive, and does not include services in other international classes, and respectfully requests that the Examining Attorney withdraw the Office Action and approve the Subject Application for publication.

II. MERELY DESCRIPTIVE REFUSAL

Trademark significance is categorized along a continuum, from marks that are highly distinctive to those that are generic for the relevant goods or services. Trademark Manual of Examining Procedure (“TMEP”) § 1209.01. “The degree of distinctiveness – or, on the other hand, descriptiveness – of a designation can be determined only by considering it in relation to the specific goods or services.” *Id.* (citing *Remington Products, Inc. v. N. Am. Philips Corp.*, 892 F.2d 1576, 1580, 13 USPQ2d 1444, 1448 (Fed. Cir. 1990) (noting that a mark must be considered in context, i.e., in connection with the relevant goods/services)); *see also* TMEP § 1209.03(e) (citing *In re RiseSmart Inc.*, 104 USPQ2d 1931, 1933 (TTAB 2012); *In re Chopper Indus.*, 222 USPQ 258, 259 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979); *In re Champion Int’l Corp.*, 183 USPQ 318, 320 (TTAB 1974)). A term is merely descriptive only if it “immediately conveys information concerning a quality or characteristic of the product or service.” *In re MBNA America Bank, N.A.*, 67 USPQ2d 1778 (Fed. Cir. 2003) (emphasis added). The term must convey this information with a “degree of particularity.” *In Re Platinum Tech., Inc.*, 161, 1999 WL 285500 (TTAB May 7, 1999) (reversing descriptiveness refusal of PLATINUM BIND ANALYZER for computer database software). The burden of

proving that an applied-for mark is merely descriptive rests with the Examining Attorney. *In re Box Solutions Corp.*, 79 USPQ2d 1953, at *2 (TTAB 2006) (“The burden is initially on the United States Patent and Trademark Office to make a *prima facie* showing that the mark or word in question is descriptive.”). Any doubts as to whether a mark is merely descriptive must be resolved in favor of Applicant. *In re Aid Laboratories, Inc.*, 221 USPQ 1215, at *1–2 (TTAB 1983).

Here, the Examining Attorney simply states that THE INTERNET OF WINE “merely describes a feature of [A]pplicant’s [S]ervices,” relying on third-party website evidence attached to the Office Action (the “Evidence”). The Examining Attorney asserts that the Evidence demonstrates that the Mark is merely descriptive. Applicant hereby addresses the Evidence in turn:

1. In the Office Action, the Examining Attorney makes reference to FineDiningLovers.com, which allegedly “shows [that] the wording comprising the applied-for mark means ‘a technological system based on sensors monitoring the lifespan, growth and requirements of each individual plant or grape.’” Applicant respectfully points out that no such website evidence was attached to the Office Action, and therefore this citation is irrelevant.

2. Pages 2-5 of the Evidence consist of a printed copy of webpage printout from ptc.com that references “The Internet... of Wine.” The article discusses how a particular third-party vineyard used the “Internet of Things” to incorporate technology in the vineyard to increase crop yields and efficiency, and reduce costs. The Examining Attorney relies on this evidence in support of his assertion that “the wording comprising the applied-for mark is *commonly used* in the marketplace to *describe technological systems used to monitor plant growth in the wine industry*” (emphasis added). First, the Mark is not even referenced in the

article. Second, nothing about the article in and of itself suggests that the Mark is “commonly used” in the marketplace, especially not in the marketplace of Applicant’s actual Services. Third, nothing in Applicant’s Services specifies “technological systems to monitor plant growth in the wine industry.” Instead, Applicant’s services are educational in nature and mention nothing about plant growth or the monitoring of same. Thus, this website evidence is irrelevant.

3. Pages 6-9 of the Evidence consist of a printed copy of a webpage printout from digitalistmag.com that uses “The Internet of wine” as a header in an article about how the Internet of Things is arriving at the wine shelf. The article discusses an offering by a third-party called an “IoT Smart Wine Shelf” that senses when a consumer removes a wine bottle from a shelf then flashes details about the wine’s vintage, flavor, and other characteristics on a display screen. The Examining Attorney relies on this evidence in support of his assertion that “the wording comprising the applied-for mark is *commonly used* in the marketplace to *describe technological systems used to monitor plant growth in the wine industry*” (emphasis added). First, “The Internet of wine” is not used as a trademark and is merely used as a header within the article. Second, nothing about the article in and of itself suggests that the Mark is “commonly used” in the marketplace, especially not in the marketplace of Applicant’s actual Services. Third, nothing in Applicant’s Services specifies “technological systems to monitor plant growth in the wine industry.” Instead, Applicant’s services are educational in nature and mention nothing about plant growth or the monitoring of same. Thus, this website evidence is irrelevant.

4. Pages 10-21 of the Evidence consist of printed copies of two webpage printouts from zdnet.com, one that uses “Internet of Wine” and the other, “Internet of Wines” in the title of each respective article. The Examining Attorney relies on this evidence in support of his assertion that “the wording comprising the applied-for mark is *commonly used* in the

marketplace to *describe technological systems used to monitor plant growth in the wine industry*” (emphasis added). First, “Internet of Wine” and “Internet of Wines” (which is different from the Mark) are used as article titles, and thus not used as trademarks. Second, nothing about the article in and of itself suggests that the Mark is “commonly used” in the marketplace, especially not in the marketplace of Applicant’s actual Services. Third, nothing in Applicant’s Services specifies “technological systems to monitor plant growth in the wine industry.” Instead, Applicant’s services are educational in nature and mention nothing about plant growth or the monitoring of same. Thus, this website evidence is irrelevant.

As demonstrated, nothing in the Evidence of record clearly shows that the Mark is merely descriptive. Instead, Applicant respectfully submits that the Mark is at least suggestive of Applicant’s Services.

III. THE MARK IS AT THE VERY LEAST SUGGESTIVE OF APPLICANT’S SERVICES

Suggestive marks are defined as “those that, when applied to the goods or services at issue, require imagination, thought, or perception to reach a conclusion as to the nature of those goods or services.” TMEP § 1209.01(a). Suggestive marks differ from descriptive marks in that “suggestive marks merely suggest, rather than describe, some quality or ingredient of goods.” *Continental Grain Co. v. Central Soya Co.*, 69 F.3d 555, at *3 (Fed. Cir. 1995). Moreover, the TTAB has previously noted that “[b]ecause the line between merely descriptive and suggestive terms can be quite nebulous, we must resolve any doubt in favor of applicant[s].” *In re Kellogg North America Company*, 2008 WL 2675685, at *13 (TTAB 2008).

The Mark as applied to Applicant’s Services does not give an immediate idea of those services, nor does it describe them with the required degree of particularity. Rather, the Mark requires “[s]ome ‘imagination, thought and perception’ to connect it to Applicant’s Services.” *Diner, Inc. v. Dream Kitchen, Inc.*, No. 95 Civ. 4130, 1995 WL 438627, at *4 (S.D.N.Y. July 24,

1995). At best, the average consumer encountering the Mark will think of “The Internet of Things,” which refers to “a network of everyday devices, appliances, and other objects equipped with computer chips and sensors that can collect and transmit data through the Internet.”¹ The consumer would then need to make at least two mental leaps to connect Applicant’s Services, which are educational in nature, to the Mark THE INTERNET OF WINE, in concluding that Applicant’s Services will provide them with a wealth of knowledge and education about alcoholic beverages such that the consumer himself or herself will be like the Internet itself, that is, a repository of information in the alcoholic beverage market. Accordingly, THE INTERNET OF WINE is suggestive of Applicant’s Services as some imagination is required to connect the term to such services.

IV. ADDITION OF INTERNATIONAL CLASSES AND AMENDMENT OF IDENTIFICATION

The Examining Attorney further asserts that the Applicant’s Services are overly broad and could include services in other international classes. Applicant respectfully disagrees with the Examining Attorney and addresses each proposed class addition in turn:

- Class 35: Education services, namely, providing on-line **educational** information in the field of distribution **in the nature of information about distributorships, information about sales methods, and information about** consumer marketing **all in the fields of** wine, spirits and beer industries

The Class 35 addition is unnecessary as per the Trademark ID Manual, these services are properly classified as Class 41 services:

041-1161	041	Education services, namely, providing on-line {indicate form of educational activity, e.g., classes, seminars, workshops} in the field of {indicate subject matter or field of educational activity}	A	10/01/2009	SERVICES
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- Class 39: Education services, namely, providing on-line **educational** information in the field of **distribution services, namely, delivery of** wine, spirits and beer

¹ See <https://www.dictionary.com/browse/internet-of-things?s=ts>.

The Class 39 addition is unnecessary as per the Trademark ID Manual, these services are properly classified as Class 41 services:

041-1161	041	Education services, namely, providing on-line {indicate form of educational activity, e.g., classes, seminars, workshops} in the field of {indicate subject matter or field of educational activity}	A	10/01/2009	SERVICES
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- Class 40: Education services, namely, providing on-line **educational** information in the field of manufacture and engagement in the wine, spirits and beer industries, **namely, providing educational information about wine-making, distilling of spirits for others, and beer making and brewing services**

The Class 40 addition is unnecessary as per the Trademark ID Manual, these services are properly classified as Class 41 services:

041-1161	041	Education services, namely, providing on-line {indicate form of educational activity, e.g., classes, seminars, workshops} in the field of {indicate subject matter or field of educational activity}	A	10/01/2009	SERVICES
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- Class 41: Continuing education services, namely, providing live and on-line continuing professional education seminars in the field of marketing of wine, spirits and beer; Education services, namely, providing on-line **information and** instruction in the field of manufacture, distribution, sales, consumer marketing and engagement in the wine, spirits and beer industries; Educational services, namely, conducting informal on-line programs in the fields of wine, spirits and beer industries, and printable materials distributed therewith; Educational services, namely, conducting informal programs in the fields of wine, spirits and beer industries, using on-line activities and interactive exhibits, and printable materials distributed therewith; Leadership development training in the field of business in the fields of wine, spirits and beer; Providing continuing business education courses; Providing education in the field of using artificial intelligence, block chain technology, virtual reality, augmented reality in the manufacture, distribution, sales, consumer marketing and engagement in the wine, spirits and beer industries rendered through video conference; Providing information on-line relating to educational opportunities; Providing a web site that features informal instruction on manufacture, distribution, sales, consumer marketing and engagement in the wine, spirits and beer industries; Providing information and news in the field of current events relating to manufacture, distribution, sales, consumer marketing and engagement in the wine, spirits and beer industries

Applicant hereby agrees to amend its Class 41 identification in accordance with the above.

V. CONCLUSION

In light of the foregoing, Applicant requests that the Examining Attorney withdraw the descriptiveness refusal and approve the Subject Application for publication.