

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

May 13, 2019

Collier L. Johnson II  
Examining Attorney  
Law Office 123  
United States Patent and Trademark Office

RE: Serial No.: 88/100,440  
Mark: **DASHBOARD**  
Office Action Date: December 20, 2018

---

**APPLICANT'S RESPONSE TO NON-FINAL OFFICE ACTION**

Optum, Inc. ("Applicant") hereby responds to the December 20, 2018 Office Action ("Office Action") issued by Collier L. Johnson II ("Examining Attorney") concerning Application Serial No. 88/100,440 (the "Subject Application") for **DASHBOARD** ("Mark") for the following services in International Class 41:

Educational services, namely, online and in-person courses, webinars, seminars, workshops in the fields of diversity, cultural sensitivity, and cultural humility; providing information in the fields of diversity, cultural sensitivity, and cultural humility training ("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." Applicant hereby submits that the Mark is not merely descriptive of Applicant's Services and is at least suggestive, 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 DASHBOARD “merely describes a feature of [A]pplicant’s [S]ervices,” relying on dictionary evidence for the definition of “dashboard” and 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. Page 2 of the Evidence is a webpage printout from the American Heritage Dictionary featuring three definitions of the term “dashboard.” For some reason, the Examining Attorney focuses only on the following definition: “a user interface on a computer display that presents constantly updated information...” On such basis, the Examining Attorney asserts that the Mark “merely describes a feature of [A]pplicant’s [S]ervices, namely that [A]pplicant’s online courses, webinars and seminars have a user interface that displays up-to-date information and data in a way that resembles the dashboard of a vehicle.”

First, nowhere in Applicant’s Services is a user interface mentioned. Likewise, nowhere in Applicant’s Services does it indicate that the information and educational services Applicant provides is constantly updated. The Examining Attorney’s conclusions are the result of a multi-step thinking process, in and of itself confirming the suggestive nature of the Mark as applied to the Applicant’s Services. Indeed, it takes at least one mental leap to connect Applicant’s “Educational services, namely, online and in-person courses, webinars, seminars, workshops in the fields of diversity, cultural sensitivity, and cultural humility” to the idea that they are accessible on a computer or other electronic device, and yet another step to understand that these services are presented in a certain visual formulation. By illustration, then, the Mark is at the very least suggestive of this portion of Applicant’s Services. Second, Applicant’s “providing information in the fields of diversity, cultural sensitivity, and cultural humility training” includes no reference to a “display” on any kind of electronic device. The Examining Attorney’s argument, therefore, makes little sense as applied to these services.

2. Pages 3-4 of the Evidence consist of a printed copy of a webpage printout from [www.idashboards.com](http://www.idashboards.com) that discusses education software called iDashboards used by school districts to input, combine and view school district data and create “dashboards” that then allow users to print custom spreadsheets and other reports. The Examining Attorney asserts that this evidences use of DASHBOARD in “a descriptive manner in reference to similar services.”

The iDashboards use is unrelated and distinct from Applicant’s Services. Nowhere in Applicant’s Services is anything about custom reports or data analytics and reporting referenced. Applicant’s Services are substantively educational and informational in nature. Just because a third-party uses a term in one way in connection unrelated goods and services does not automatically make the term descriptive for its own, distinct service offering. Therefore, this evidence is irrelevant.

3. Page 5 of the Evidence consists of a printed copy of a portion of a webpage printout from [www.edweek.org](http://www.edweek.org) entitled “Data Dashboards a High Priority in National Education.” The article discusses “learning, or data, dashboards” that allow users to input data from student assessments, educator observations, and other data points to create student progress reports. Like the iDashboards evidence referenced above, this use is also unrelated and distinct from Applicant’s Services. Nowhere in Applicant’s Services is anything about custom reports on student assessments or educator observations referenced. Applicant’s Services are substantively educational and informational in nature. Just because a third-party uses a term in one way in connection unrelated goods and services does not automatically make the term descriptive for its own, distinct service offering. Therefore, this 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). Here, the Examining Attorney inappropriately assumes that "dashboard" immediately conveys that Applicant's Services are provided online or via electronic means and look a certain way without basis. Accordingly, DASHBOARD is suggestive of Applicant's Services as some imagination is required to connect the term to such services.

### **IV. CONCLUSION**

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