

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Trax Technology Solutions Pte. Ltd.	Docket No.:	38859.6001/1
Mark:	TRAX		
Serial No.:	88/167,081	Examining Attorney:	Howard Smiga
Filed:	October 24, 2018	Law Office:	102

APPLICANT’S RESPONSE TO OFFICE ACTION

I. INTRODUCTION.

In the Office Action dated March 15, 2019, the Examining Attorney refused Applicant’s application for a federal trademark registration for the mark TRAX on the Principal Register on the grounds that the mark is merely descriptive of Applicant’s services.

Applicant respectfully disagrees with the Examining Attorney’s finding that its mark is merely descriptive. As described more fully below, Applicant respectfully submits that the applied-for mark is a suggestive mark capable of being registered on the Principal Register.

II. APPLICANT HAS PREVIOUSLY REGISTERED ITS TRAX MARK IN CLASS 35 ON THE PRINCIPAL REGISTER.

As an initial matter, Applicant notes that it is the owner of U.S. Registration No. 5,430,525 for the mark TRAX & design in Class 35 on the Principal Register. Applicant’s registration does not contain a disclaimer of any wording, nor was Applicant’s Mark registered based on a claim of acquired distinctiveness. Accordingly, the USPTO has previously determined that Applicant’s use of the TRAX mark in connection with Class 35 is not merely descriptive and capable of being registered on the Principal Register. Applicant respectfully requests that the Examining Attorney follow the past guidance of the USPTO and approve its application for publication.

III. APPLICANT’S MARK IS NOT MERELY DESCRIPTIVE OF ITS SERVICES.

Applicant’s Mark does not merely describe a feature or characteristic of Applicant’s services. On the contrary, Applicant’s Mark is a suggestive mark that requires consumers to pause and make a leap of imagination before reaching a determination as to the nature of Applicant’s services. Courts have commonly held that this stop-and-pause moment is the key component of a suggestive mark. *See Abercrombie & Fitch Co. v. Hunting World, Inc.*, 1976 537 F.2d 4 (2nd Cir. 1974) (“a term is suggestive if it requires imagination, thought and perception to reach a conclusion as to the nature of goods.”). As detailed more fully below, Applicant’s Mark requires such thought and perception in order for a consumer to understand the nature of the services provided under the mark. Applicant’s Mark does not automatically convey

the concept or idea of market research, market analysis, business consulting and data processing services.

A. A Mark Should be Refused Registration on the Principal Register Based on 15 U.S.C. §1052(e)(1) Only When the Examining Attorney Establishes That the Mark is Merely Descriptive.

A trademark cannot be registered on the Principal Register if it consists of a mark that is “merely descriptive” of the applicant’s goods or services. 15 U.S.C. § 1053(e)(1) (emphasis added). It is well recognized that a mark is merely descriptive only if it directly conveys information concerning the function, characteristics, purpose or use of the goods or services. *Towers v. Advent Software, Inc.* 913 F. 2d 942, 16 U.S.P.Q.2d 1039, 1040 (Fed. Cir. 1990). The Trademark Trial and Appeal Board (“TTAB”) has stated the test for mere descriptiveness as follows:

It is well established that a term is considered to be merely descriptive of goods or services, within the measure of Section 2 (e)(1) of the Trademark Act, if it immediately describes an ingredient, quality, characteristic or feature thereof or if it directly conveys information regarding the nature, function, purpose or use of the goods or services.

In re Pennzoil Products. Co., 20 U.S.P.Q.2d 1753, 1755 (T.T.A.B. 1991).

Thus, the focus of the merely descriptive test is not whether the mark can, in some manner, be considered descriptive, but rather whether the mark immediately and directly conveys the function or characteristics of the goods provided under the mark. By using such terms as “immediately” and “directly” the Trademark Trial and Appeal Board has set a high threshold under which a mark can be categorized as merely descriptive. The Examining Attorney has not provided sufficient evidence to show that Applicant’s Mark crosses this threshold. Because Applicant’s Mark on its face does not immediately convey to potential consumers the essence of Applicant’s services, it cannot be merely descriptive.

B. Applicant Uses its Mark in a Suggestive Manner in Relation to Its Services.

A mark is suggestive if, when applied to the goods or services at issue, some “imagination, thought, or perception” is required in order “to reach a conclusion as to the nature of those goods or services.” Trademark Manual of Examining Procedure (“TMEP”) § 1209.01(a). There is a fine line that differentiates a mark that “immediately describes” from a mark that requires a “modicum” of imagination and thought. *See Plyboo America, Inc. v. Smith & Fong Co.*, 51 U.S.P.Q.2d 1633, 1640 (T.T.A.B. 1999). Moreover, a term may possess elements of suggestiveness and descriptiveness at the same time. *In re Nett Designs, Inc.*, 57 U.S.P.Q. 2d 1564, 1566 (Fed. Cir. 2001).

Applicant's Mark consists of a unique, coined term. Applicant's Mark, for example, is not found in any standard English dictionaries, and has no known definition or English meaning. *See* Ex. A. When viewing Applicant's Mark, consumers will necessarily need to stop and think in order to ascertain its meaning, given that it consists of a unique, made-up word. Even then, it is not clear the consumer would be able to ascertain the meaning. The scope and nature of Applicant's services is not evident by Applicant's Mark alone – rather the mark may slightly suggest to the consumer some sort of connotation around monitoring or observing. Indeed, it takes a leap of imagination to make the connection that Applicant's Mark is related to marketing research or marketing data analysis services. The requirement for consumers to exercise such imaginative thinking in order to understand the nature of Applicant's services indicates that the mark is not merely descriptive.

C. Applicant's Mark Will Not be Immediately Perceived as a Slight Misspelling of the Word "Tracks."

The Examining Attorney bases the current refusal of Applicant's Mark on the premise that Applicant's Mark will be perceived by consumers as the equivalent of the word "Tracks." Applicant notes, however, that the Examining Attorney has not provided *any* evidence to support this contention. On the contrary, consumers are unlikely to perceive Applicant's Mark as the equivalent of the word "Tracks" given the dramatic differences in appearance and pronunciation between the two words.

The phonetic equivalent doctrine applies only to *slight* misspellings of words. *See* TMEP 1209.03(j) ("A slight misspelling of a word will not turn a descriptive or generic word into a non-descriptive mark."). Applicant's Mark, TRAX, is not a slight misspelling of the word "Tracks," but rather is a coined term. Applicant's Mark consists of an entirely different suffix than the word "Tracks"; it lacks the letters "C", "K" and "S" and ends in the letter "X." In this way, Applicant's Mark is not likely to be immediately perceived as a slight misspelling of the word "Tracks."

The Examining Attorney even states that Applicant's Mark, TRAX, is "*a novel* spelling of the word TRACKS." (emphasis added). The different, unique nature and spelling of Applicant's Mark thus clearly makes it far from just a slight misspelling of the word "Tracks" that will be obvious to consumers. Accordingly, consumers are unlikely to perceive the words as being equivalent to each other.

D. The Word "Tracks" Does Not Have A Clear Meaning.

The Examining Attorney proffers that "Tracks" means "to observe" or "follow" or "track." However, the term "Tracks" actually has multiple recognized meanings, none of which are sufficiently reflected in the definition provided by the Examining Attorney. To wit, "Track" means "a rough path or road, typically one beaten by use rather than constructed", "a mark or line of marks left by a person, animal, or vehicle in passing", a "continuous line of rails on a

railway,” or “a recording of one song or piece of music.” *See* Exhibit B. These multiple definitions establish that the word “Tracks” does not have a single, known meaning such that consumers viewing Applicant’s Mark will have any immediate idea of the services offered.

Moreover, even assuming *arguendo* that the definitions provided by the Examining Attorney are correct, the Examining Attorney has not provided any evidence to support the fact that the word “Tracks” merely describes or even suggests marketing research and analysis services. The Examining Attorney states that the word “Tracks” is used to “describe the collection and analysis of data, including consumer and market behavior.” However, the evidence provided by the Examining Attorney does not show use of the term “Tracks” in this way. The examples included only use the phrase “data tracking” in connection with such services. Applicant’s Mark, TRAX, is clearly distinguishable and not equivalent to the phrase “data tracking” or “tracking.” Consequently, the Examining Attorney’s evidence does not demonstrate that the word “Tracks”—which is the word the Examining Attorney has incorrectly identified as the equivalent of Applicant’s Mark—is actually used to identify a feature or component of market research in the industry. As such, the Examining Attorney’s evidence is not sufficient to support a finding that Applicant’s Mark is merely descriptive.

E. If the Examining Attorney Has Any Doubts as to Whether Applicant’s Mark Can be Registered on the Principle Register, Such Doubts Are to be Resolved in Applicant’s Favor.

If there is any doubt as to whether Applicant’s mark should be registered, such doubts should be resolved in Applicant’s favor and the mark should be published for opposition. *See In re Fat Boys Water Sports*, 118 USPQ2d 1511, 1513 (TTAB 2016).

Applicant therefore submits that should the Examining Attorney have any doubts as to whether Applicant’s Mark is merely descriptive, the Examining Attorney should resolve such doubts in Applicant’s favor and allow the mark to proceed to registration.

IV. CONCLUSION.

In view of the arguments above, Applicant requests that the Examining Attorney remove the objection and allow Applicant’s trademark application to proceed to publication in the Official Gazette.