

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

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| <b>TRADEMARK:</b>  | AUTOMATE (the "Mark")   |
| <b>SERIAL NO.:</b> | 88095680  |
| <b>CLASS(ES):</b>  | 009   |
| <b>GOODS:</b>      | optical sensor systems for maritime vessels; sensors and detection units for use in controlling operation of nautical navigation apparatus and equipment; nautical navigation systems using artificial intelligence; navigation software for maritime vessels |
| <b>APPLICANT:</b>  | Buffalo Automation Group, Inc.  |

**SECTION 2(E)(1) REFUSAL - MERELY DESCRIPTIVE**

On December 17, 2018, an Office Action was issued refusing registration for Buffalo Automation Group, Inc.'s ("Applicant") application to register the Mark on the grounds that it is allegedly merely descriptive of Applicant's goods under Section 2(e)(1) of the Trademark Act.

In response, Applicant respectfully requests that the refusal be withdrawn for at least the following reason:

**I. The Mark is a Double Entendre**

A "double entendre" is a word or expression capable of more than one interpretation. TMEP Section 1213.05(c). For trademark purposes, a "double entendre" is an expression that has a double connotation or significance as applied to the goods or services. *Id.* The mark that comprises the "double entendre" will not be refused registration as merely descriptive if one of its meanings is not merely descriptive in relation to the goods or services. *Id.*

In *In re Colonial Stores, Inc.*, an Applicant attempted to register SUGAR & SPICE for bakery products. 394 F.2d 549, 549 (C.C.P.A. 1968). The Examining Attorney considered the mark to be merely descriptive of bakery products containing sugar and spice, and refused registration. *Id.* at 550. The Court of Customs and Patent Appeals reversed the decision, finding that SUGAR & SPICE not only suggests ingredients, but also stimulates an association with the nursery rhyme "Sugar and Spice and Everything Nice...", and was therefore reminiscent or suggestive of a non-descriptive idea. *Id.* at 552-53.

In the present application, the Examining Attorney (“Examiner”) has found the Mark to be merely descriptive of the identified goods. The Examiner asserted that “automate” is merely descriptive of the nautical navigation-related goods of the application, stating “automating goods and automation systems are common in the nautical industry for navigation purposes.”

However, the Mark has a second meaning as applied to the identified goods. In a nautical context, “mate” is defined as “an officer of a merchant ship, ranking below the captain” or “an assistant”. Exhibit A. Further, “in the U.S. Navy, mate is used in the designators of certain petty officers and ratings, as machinist's mate, boatswain's mate”. *Id.* Thus, in a nautical context, “mate” stimulates an association with a crewmember of a nautical vessel. Additionally, as applied to goods related to nautical navigation, “mate” may also stimulate an association with the specific crewmembers responsible for navigating the vessel. The AUTO-prefix further suggests that the identified goods act as an “automatic” or “automated” crewmember to navigate the nautical vessel.

Accordingly, the Mark is a double entendre with a second meaning which is not merely descriptive of Applicant’s goods. Applicant therefore respectfully requests withdrawal of the Section 2(e)(1) refusal.

## **REQUEST FOR INFORMATION**

In the Office Action, the Examiner requested several pieces of information regarding the Mark. Please see below for the responses to the requests.

- (1) The requested information is provided in the form of screenshots of Applicant’s website <http://www.buffautomation.com/>.
- (2) See response to query number 1.
- (3)(1) Yes, some of Applicant’s goods provide automatic control.
- (3)(1)(a) Applicant’s goods can provide automatic control of the navigation systems of nautical and maritime vessels using artificial intelligence based on data collected by the identified optical sensor systems.
- (3)(2) Yes, some of Applicant’s goods provide automation.
- (3)(2)(a) Applicant’s goods can provide automation of navigation systems of nautical and maritime vessels using artificial intelligence based on data collected by the optical sensor systems.
- (3)(3) Yes, Applicant provides automation systems.
- (3)(4) No, Applicant does not provide Automatic Identification Systems (AIS) at this time.
- (3)(5) The significance of the term AUTOMATE is that of a double entendre, referring (1) to the automatic control of the navigation systems and (2) to an officer of a nautical vessel (a “mate”).

(3)(6) As far as Applicant is aware, AUTOMATE has no meaning or significance in Applicant's industry, nor is AUTOMATE a term of art in Applicant's industry.