

Applicant respectfully submits the following remarks in response to the Office action and requests that the trademark examining attorney allow the subject application to proceed toward registration.

The trademark examining attorney has raised a potential descriptiveness refusal under Section 2(e)1 and has requested additional information about Applicant's product and a clarification of the identification of goods/services. The potential refusal and request for information about and clarification of Applicant's goods/services go hand in hand, as "[t]he determination of whether a mark is merely descriptive must be made in relation to the goods and services for which registration is sought, not in the abstract." TMEP § 1209.01(b), citing *In re Chamber of Commerce*, 675 F.3d at 1300 and *In re Bayer*, 488 F.3d at 964. "This requires consideration of the context in which the mark is used or intended to be used in connection with those goods/services, and the possible significance that the mark would have to the average purchaser of the goods or services in the marketplace." *Id.* Applicant acknowledges that given the relatively broad and unclear description of goods/services set out in the initial application, the trademark examining attorney's concerns were understandable. And Applicant respectfully submits that after clarifying the goods/services as set out herein, there are no longer questions or concerns about the nature of Applicant's goods/services nor whether Applicant's mark is merely descriptive in connection with them.

In particular, Applicant's solution to be identified and distinguished with the applied-for mark is certain software for quality assurance of perishable foods items as they travel through the supply chain. There are no instruction manuals or advertising materials to provide, as the solution is still under development, and there are no competing products to point at, as Applicant's solution is new technology. The solution is to monitor products via Applicant's technology by gathering and processing information at multiple points throughout the supply chain, e.g., from farm to retail store, to ensure perishable food items remain at the highest quality.

In view of the clarification of Applicant's solution as set out herein, the applied-for mark is not merely descriptive because it does not immediately convey knowledge of the ingredients, qualities or characteristics of the goods and services at issue. See *In re Quik-Print Copy Shops, Inc.* 616 F.2d 523 (C.C.P.A.1980). To be merely descriptive, a mark must give some reasonably accurate identification of the essence of the goods covered by the mark. If the information conveyed by the mark is indirect or vague, the mark is considered suggestive rather than

descriptive. *See* S. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 11:19 (4<sup>th</sup> ed. 2010); *The Money Store v. Harris Corp. Finance, Inc.*, 216 USPQ 11, 18 (7th Cir. 1982). Because Applicant's mark does not directly describe an ingredient, quality or characteristic of Applicant's product (as clarified herein), the potential descriptiveness refusal outlined in the Office action is no longer applicable and should be withdrawn. Applicant notes that when a term could plausibly describe a variety of other products or services beyond those of the applicant, it is an indication that the term is not descriptive because it is not narrowly tailored to its associated product such that it calls that product immediately to mind. *See, e.g., Cross Commerce Media, Inc. v. Collective, Inc.*, 841 F.3d 155, 163 (2d Cir. 2016) (COLLECTIVE was held not descriptive for business software to facilitate marketing, the Court noting that the mark "evokes an array of goods, which means that consumers must make an additional mental effort to identify the associated product in particular.").

Accordingly, Applicant respectfully requests the trademark examining attorney to allow the subject application to proceed to publication.