

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

In re Application of	)	
	)	
Sterling Infosystems, Inc.	)	
	)	Dannean Hetzel
Serial No. 88/144,729	)	Trademark Examining Atty.
	)	Law Office 106
Filed: October 5, 2018	)	
	)	
Mark: ELECTRONIC	)	
FINGERPRINT CARD	)	

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**RESPONSE**

This response answers the Office Action issued December 20, 2018 for Application Serial No. 88/144,729 (the “Application”) for the mark “ELECTRONIC FINGERPRINT CARD” (the “Applicant’s Mark”) filed by Sterling Infosystems, Inc. (the “Applicant”).

**AMENDMENT**

Please amend the description of services to read:

Class 42: “Providing internet based data capturing, transferring and reporting biometric data services that enable the exchange of information about an individual’s identity or criminal history or allowing access via secure door; electronic monitoring, capturing, transferring, and reporting of biometric data using computers for receipt of data regarding an individual’s identity or criminal history or allowing access via secure door; providing temporary use of non-downloadable software for capturing, transferring, and reporting biometric data for the purpose of identify verification or criminal history receipt or allowing access via secure door.”

**REMARKS**

The Examiner has searched the Office’s records and found no marks that would bar registration under Section 2(d) of the Trademark Act. However, the Examiner has initially

refused registration of the Application under Section 2(e)(1) of the Trademark Act on the basis that the mark “ELECTRONIC FINGERPRINT CARD” merely describes a feature and function or purpose of Applicant’s Services, as amended.

For the reasons set forth below, Applicant respectfully submits that “ELECTRONIC FINGERPRINT CARD” is not merely descriptive when used in connection with Applicant’s amended services but instead is at least suggestive. Accordingly, Applicant respectfully requests that the Examiner’s initial refusal be withdrawn.

To be “merely descriptive,” a mark must do nothing but describe the goods. *See In re Gyulay*, 3 U.S.P.Q.2d 1009 (Fed. Cir. 1987); 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:19 (hereinafter “MCCARTHY”). In other words, a “merely descriptive” mark “immediately tells something about the goods” at issue. TMEP § 1209.01(a). Determining whether a mark is merely descriptive cannot be made in the abstract, but instead must be made in relation to the goods or services for which registration is sought. TMEP § 1209.01(b); *see also In re Grand Forest Holdings Inc.*, 78 U.S.P.Q.2d 1152, 1153 (T.T.A.B. 2006). Such determination requires consideration of the “possible significance that the mark would have to the average purchaser of the goods or services in the marketplace.” TMEP § 1209.01(b). Any doubt as to the descriptiveness of a term must be resolved in favor of the applicant. *See In re The Rank Organisation Ltd.*, 222 U.S.P.Q. 324, 326 (T.T.A.B. 1984).

Further, the Board consistently recognizes that there is “but a thin line of demarcation between a suggestive term and a merely descriptive designation.” *In re TMS Corp. of the Americas*, 200 U.S.P.Q. 57, 58 (T.T.A.B. 1978). For example, in *In re TMS Corporation of the Americas*, the Board held that the mark “THE MONEY SERVICE” for financial services was registrable because “it suggests a number of things, but yet falls short of describing applicant’s services in any one

degree of particularity.” *Id.* at 59. Even though a mark may suggest a feature of a service, the nature of such services as identified in the registration may not be at all clear without further thought or imagination. *In re WSI Corp.*, 1 U.S.P.Q. 2d. 1570, 1571 (T.T.A.B. 1986); *see also In re Lockheed Martin Corp.*, 2012 WL 5902074 (T.T.A.B. 2012) (finding that the mark “PC ON A STICK” for software and computer storage devices does suggest the “function and purpose of the applicant’s goods, but it does not do so forthwith and with immediacy” and, therefore, the mark is “suggestive rather than merely descriptive”). If the mark creates only a vague impression as to the goods or services offered under the mark, it is indicative that the mark is suggestive rather than descriptive. MCCARTHY § 11:19, at 11-45.

In this case, the Examiner states that Applicant’s Mark “immediately informs consumers that applicant uses electronic fingerprint cards to perform the identified services”. It respectfully submitted that this is not the case. Instead, Applicant’s Mark can suggest a number of things, including a physical card, i.e. a good, and not necessarily Applicant’s Services, as amended. *See In re TMS Corp. of the Americas*, 200 U.S.P.Q. at 58 (providing that such a suggestion “falls short of describing applicant’s services in any one degree of particularity.”). No part of Applicant’s Mark denotes that the services relate to capturing or transferring or reporting biometric data. Instead, the term is suggestive of the services because consumers must make a mental leap to associate the mark (which refers to a physical card) with Applicant’s Services. *See Tanel Corp. v. Reebok International Ltd.*, 16 U.S.P.Q.2d 2034, 2037 (D. Mass. 1990) (finding that the more thought or imagination that is required to link the mark with the goods, the more likely the mark is suggestive). Consumers do not automatically associate the mark to Applicant’s Services and thus Applicant’s Mark is at least suggestive.

While the individual terms “electronic” and “fingerprint card” may separately have some

meaning in relation to the services as listed in the Application, a mark “does not have to be devoid of all meaning in relation to the goods and services to be registrable.” TMEP § 1209.01(a).

Furthermore, the combination of two or more allegedly descriptive elements as a composite mark may convey a commercial impression that is suggestive, rather than descriptive. It is well established that a composite term is more than the sum of its parts. *Estate of P.D. Beckwith, Inc. v.*

*Commissioner of Patents*, 252 U.S. 538, 545-46 (1920) (noting that a composite mark is tested for distinctiveness by looking at it as a whole, rather than dissecting it into its component parts); *see also In re Wells Fargo & Co.*, 231 U.S.P.Q. 116, 119 (T.T.A.B. 1986) (finding the composite mark “EXPRESS SAVINGS” not descriptive of banking services even though the individual terms are descriptive); *In re On Technology Corp.*, 41 U.S.P.Q.2d 1475, 1478 (T.T.A.B. 1986) (finding the composite mark “AUDITTRACK” suggestive of software even though the words “AUDIT” and “TRACK” alone were “undeniably descriptive” of the applicant’s goods because “prospective consumers would have to pause and reflect on the significance of the combined designation”).

Here, the overall commercial impression of the composite term “ELECTRONIC FINGERPRINT CARD” is at least suggestive. Like the mark “EXPRESS SAVINGS” for banking services and “AUDITTRACK” for computer monitoring software, the composite mark “ELECTRONIC FINGERPRINT CARD” does much more than merely describe Applicant’s Services, as amended. As previously stated, the combined wording may be at least suggestive of Applicant’s Services, as amended, but it does not immediately describe the precise nature of Applicant’s Services “in any one degree of particularity.” *In re TMS Corp. of the Americas*, 200 U.S.P.Q. at 58. Rather, Applicant’s Mark requires further imagination or thought as consumers would have to “pause and reflect on the significance of” Applicant’s Mark. *In re On Technology Corp.*, 41 U.S.P.Q.2d at 1477. Thus, when viewed as a whole, the composite mark of

“ELECTRONIC FINGERPRINT CARD” is not merely descriptive, but at most suggestive of Applicant’s amended services because the combination of words creates an overall distinct commercial impression.

### **CONCLUSION**

In view of the foregoing, Applicant respectfully submits that Applicant’s Mark is registrable on the Principal Register because “ELECTRONIC FINGERPRINT CARD” is not merely descriptive of Applicant’s Services, but instead is at least suggestive of its services. Accordingly, Applicant respectfully requests that its Application be allowed to proceed onto publication.