

**UNITED STATES DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE**

|                                  |   |                            |
|----------------------------------|---|----------------------------|
| In Re the Trademark Application: | ) |                            |
|                                  | ) |                            |
| Serial No.: 88/098,781           | ) |                            |
|                                  | ) | Trademark Law Office: 107  |
| Applicant: Replica, Inc.         | ) | Attorney: Nelson B. Snyder |
|                                  | ) |                            |
| Trademark: REPLICA               | ) |                            |
|                                  | ) |                            |
| Filing Date: August 30, 2018     | ) |                            |
|                                  | ) |                            |
| Class: 42                        | ) |                            |
|                                  | ) |                            |
| Mailing Date: December 20, 2018  | ) |                            |
|                                  | ) |                            |

---

**RESPONSE TO OFFICE ACTION**

Applicant Replica, Inc. (“Applicant” or “Replica”), by and through its counsel, hereby responds to each of the issues raised by the Examining Attorney in the non-final Office Action issued on December 20, 2018, in connection with the above-captioned application (the “Application”) for the REPLICA mark (“Applicant’s Mark”).

Applicant has applied to register Applicant’s Mark for services in Class 42 as follows:

Software as a service (SAAS) services, namely, software for use by public agencies, land developers and communities for urban planning, infrastructure development, and policy making; software for accessing, using, and sharing information in the field of urban analytics including mobility and land use patterns; software as a service (SAAS) services, namely, hosting software for use by others for modeling urban mobility patterns and changes in urban mobility patterns for purposes of urban and regional planning and development, zoning analysis and planning, urban transportation infrastructure planning and development, and local and regional regulation; software as a service featuring software providing graphs, maps, data, text and images displaying metrics related to movement patterns in an urban area; software as a service to enable the creating, comparing, commenting, and sharing of urban metrics

## **I. Merely Descriptive Refusal and Request for Additional Information**

The Examiner has preliminarily refused registration under Section 2(e)(1) on the basis that the mark merely describes a purpose, function, and/or use of applicant's goods. Applicant respectfully disagrees that Applicant's Mark is merely descriptive for the reasons set forth below.

### **A. Background: Applicant's Business and REPLICA Offering**

Applicant is in the business of designing and developing innovative offerings to improve urban cities and infrastructure through technology. Applicant's goal is to make urban space more affordable, efficient and sustainable and to improve the quality of life of urban-dwellers. Among its product and service offerings, Applicant has developed an urban planning tool offered under the REPLICA mark. Applicant's offering is a sophisticated, multifaceted data modeling and analytics software tool. It is built on data collected from different sources concerning the movement of people in an urban environment. Through the REPLICA software, urban planners are able to track, model, and analyze that data in a variety of formats to extract various information about the mode, route, timing and volume of movement among locations throughout the day or other time period. For example, the REPLICA software could collect and track all movement on a particular street, and provide insights such as the key mode of transportation (e.g. cyclists), congestion times (e.g. after school), and dominant purpose (e.g. commuting). Applicant's software gives public agencies, land developers and communities the access to broadly relevant data, which allows them to make better transportation and land use decisions in designing and developing urban environments. (See Ex. 1, <https://www.sidewalklabs.com/blog/introducing-replica-a-next-generation-urban-planning-tool/>).

Applicant's software uses mobile phone location capability to gather de-identified data about the number of people on roadways and other routes, the type of transportation used, and the purpose of the travel. With this data, Applicant's software can be used to generate travel behavior

models, *i.e.* a set of rules that represent how individuals make choices on where, when, why and how to travel within an urban locale. Applicant's software also integrates into its analysis aggregated demographic information, called a "synthetic population," and which is an incomplete but statistically representative sample of the actual population in the relevant locale. Applying the models to the synthetic populations, Applicant's software generates modeling and analysis output in the form of data tables, graphs, charts, maps and other content related to travel movements within the locale. Importantly, the output is not a copy of any real-world travel movements. (See Ex. 1).

In addition, Applicant's offering may be used to prototype, test hypotheses and explore prospective changes and outcome before real-world implementation, as well as to compare competing models to one another to assess effectiveness and efficiency. Thus, planners can create hypothetical models of urban plans based on the planner's ideas and proposals. Using the data generated by Applicant's software, these models can be compared against each other to identify relative strengths in efficiency and other metrics.

The REPLICA tool provides a variety of reports, including charts, data tables, graphs and maps, and allows users to manipulate the output such as by filtering for particular days, locations, and other criteria. As explained by Applicant:

Mobile location data, paired with machine learning techniques, provide the opportunity to train and deploy models much, much faster and inform policy conversations. As the pace of transportation change accelerates, the lag time between observing a behavior and having it inform planning decisions via modeling tools can make policymakers less nimble and less effective. Right now, planners must wait years to simulate the efficacy of, say, expanding a bike-share system. Our goal is to reduce this "latency" towards zero: observing, learning, and deploying can happen together. (See Ex. 1).

Thus, the REPLICA offering is not an ‘exact reproduction’ of anything; indeed, it is not even an inexact copy of a real world activity or object. Instead, REPLICA is an urban planning software tool used to create an entirely new product, a data model that did not exist and is unique.

## **B. Merely Descriptive Refusal**

The Examiner has refused registration on the grounds that Applicant’s Mark “merely describes a purpose, function, and/or use of Applicant’s goods. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); *see* TMEP §§1209.01(b), 1209.03 *et seq.* Applicant respectfully submits that Applicant’s Mark is not merely descriptive of its proposed software offering.

### **1. Applicable Principles of Law**

The determination of whether a mark is merely descriptive—*i.e.*, whether the mark immediately conveys to consumers nothing more than “an ingredient, quality, characteristic, function, feature, purpose or use of an applicant’s goods or services”—must be made in relation to the goods or services for which registration is sought, in the context in which the mark is used, and the possible significance that the mark would have, because of that context, to the average purchaser in the marketplace. *See* TMEP § 1209.01(b); *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251 (Fed. Cir. 2012); *see also J.S. Paluch Co. v. Irwin*, 215 U.S.P.Q. 533, 536 (T.T.A.B. 1982); *In re Omaha Nat’l Corp.*, 2 U.S.P.Q.2d 1859, 1861 (Fed. Cir. 1987).

Notably, “a designation does not have to be devoid of all meaning in relation to the goods or services to be registrable.” *See* TMEP § 1209.01(a). The Board has made clear that in order for a mark to be considered merely descriptive, the mark must describe the goods or services with “*particularity.*” *See In re Bright-Crest Ltd.*, 204 U.S.P.Q. 591, 593 (T.T.A.B. 1979) (emphasis added); *see also Airco, Inc. v. Air Prods. & Chems., Inc.*, 196 U.S.P.Q. 832, 835 (T.T.A.B. 1977) (AIR-CARE held registrable for applicant’s preventive maintenance services directed to a scheduled maintenance program for hospital and medical anesthesia and inhalation therapy

equipment); *In re Silva Mind Control Int'l, Inc.*, 173 U.S.P.Q. 564 (T.T.A.B. 1972) (MIND CONTROL held registrable for lectures and lecture-type educational programs of a scientific and philosophical character designed for achieving mental acuity and other powers). If a mark conveys indirect, vague, or ambiguous information about a good or service, then the mark is being used in a suggestive, rather than descriptive, fashion. See T.M.E.P. Section 1209.02(a) and (b) (citing J. McCarthy, McCarthy on Trademarks and Unfair Competition Section 11:19 (4<sup>th</sup> ed. 1998)). A mark is suggestive if it requires some imagination, thought and perception to reach a conclusion as to the specific nature of the goods. *In re Nett Designs, Inc.*, 57 U.S.P.Q. 1564, 1566 (Fed. Cir. 2001).

## **2. The Mark Does Not Describe Applicant's Goods and Services With Particularity**

Applicant's Mark does not describe Applicant's offering with particularity. The Examiner concluded that "...the mark wording identifies a feature or use of the identified 'software', namely to provide a 'copy' for use is 'urban planning, infrastructure development,' (sic). The Examiner relies upon a dictionary definition for "replica" as "an exact reproduction (as of a painting) executed by the original artists" and "a copy exact in all details."

As described above, Applicant's data analytics tool is not a copy of anything, nor does it reproduce a copy of anything. Rather, it is a multifaceted software offering that utilizes artificial intelligence, statistical analysis and sophisticated data collection capabilities to generate user-specified datasets about urban travel but does not, in any sense, produce "an exact reproduction" or "a copy exact in all details" of those urban travel movements. Instead, Applicant's software uses sampling techniques and statistical analysis, which suggests the likely real world activity in some cases and hypothesizes the potential activity in others.

Moreover, a user of Applicant's offering would not be able glean from use of the mark REPLICIA to ascertain the broad and multifaceted data analytic offerings generated by Applicant's tool, including the capability of creating entirely hypothetical models for planning purposes and comparing those models against one another to reveal best cases. . *See* 2 McCarthy on Trademarks and Unfair Competition § 11:19 [hereinafter McCarthy] ("If information about the product or service given by the designation is indirect or vague, requiring imagination and thought to get information about the product or service, then this indicates that the term is being used in a "suggestive," not descriptive, manner."); *Cross Commerce Media, Inc. v. Collective, Inc.*, 841 F.3d 155, 163, (2d Cir. 2016) ("The meaning of a suggestive mark typically evokes an array of goods, which means that consumers must make an additional mental effort to identify the associated product in particular."). Moreover, Applicant's sophisticated users would not assume that Applicant's offering merely provides an exact copy of traffic or other existing conditions; instead, these users would anticipate that Applicant's innovative artificial-intelligence based offering is a more complex analytical tool offering a variety of information relevant to the urban planning process.

Accordingly, the general and broad commercial impression of Applicant's Mark does not equate to a term that is merely describing the underlying offering. *See In re TMS Corp. of the Americas*, 200 U.S.P.Q. 57, 59 (T.T.A.B. 1978) (THE MONEY STORE held registrable for financial services wherein funds are transferred to and from a savings account from locations remote from the associated financial institution).

Moreover, as noted above, registrability does not require that a designation have no meaning in relation to the goods/services. *See* TMEP § 1209.01(a). "The question is whether the mark considered in its entirety possesses a merely descriptive significance as applied to the goods

in question, i.e., whether it conveys a readily understood meaning to the average purchaser of such goods.” See *In re Bright-Crest, Ltd.* at 593. Here, that is not the case for the reasons stated above. Therefore, when considered in relation to Applicant’s products, Applicant’s Mark is suggestive.

In support of the refusal, the Examiner points to the use of the verb “replicate” on Applicant’s website. However, “replicate” when used as a verb in the context of scientific undertakings typically describes a process rather than an outcome. In other words, one may attempt to replicate certain conditions but obtain results that vary as among various replication attempts. Furthermore, in scientific modeling, replicating refers to establishing common base parameters. Indeed, “replicate” is frequently used in the context of conducting multiple experiments using the same conditions to compare outcomes. Similarly, “replicate” used as a verb in other contexts has this same connotation of an effort to repeat or copy or imitate but which does not encompass or convey achieving an exact copy:

*transitive verb*  
DUPLICATE, REPEAT  
-replicate a statistical experiment  
-replicated his mentor's writing style

<https://www.merriam-webster.com/dictionary/replicate>

As such, REPLICA applied to Applicant’s offering does not describe the offering but only suggests or gives a hint at the broad utility of the offering. See *In re Ralston Purina Co.*, 191 U.S.P.Q. 237, 238 (T.T.A.B. 1976) (RALSTON SUPER SLUSH suggestive when used on a “slush type soft drink” because it merely “connote[s] a vague desirable character or quality”); *In re Wells Fargo & Company*, 213 U.S.P.Q. 116 (T.T.A.B. 1986) (“finding EXPRESS SAVINGS not descriptive for banking services because mental gymnastics necessary to understand the nature of the services.”).

**C. Any Doubt Should Be Resolved in Favor of Applicant**

Lastly but importantly, the Board has held that any doubts as to whether a mark is merely descriptive or suggestive must be resolved in favor of the Applicant. *See In re The Rank Organization Ltd.*, 222 U.S.P.Q. 324, 326 (T.T.A.B. 1984). The distinction between merely descriptive marks and suggestive marks is “nebulous” at best. *See Truckstops Corp. of America v. C-Poultry Co., Ltd.*, 223 U.S.P.Q. 143, 144 (M.D. Tenn. 1983). Any doubts as to whether a mark is merely descriptive or suggestive must be resolved in favor of Applicant, and “any person who believes that he would be damaged by the registration will have an opportunity . . . to oppose the registration.” *In re Merrill Lynch, Pierce, Fenner, and Smith Inc.*, 4 U.S.P.Q. 2d 1141, 1144 (Fed. Cir. 1987) (citations omitted); *see also In re The Rank Organisation*, 222 U.S.P.Q. at 326 (resolving any doubt in favor of applicant).

Thus, if there is any doubt in the Examining Attorney’s mind as to whether the mark is descriptive or suggestive of Applicant’s goods, this doubt must be resolved in favor of registering Applicant’s Mark.

## **II. Conclusion**

Applicant has responded to all of the issues raised by the Examining Attorney in his Office Action of December 20, 2018. Accordingly, Applicant submits that the instant application is now in condition for a prompt publication and such favorable action is therefore requested.

Respectfully submitted,

COOLEY LLP

/Janet L. Cullum/

Janet L. Cullum  
1299 Pennsylvania Ave., NW, Suite 700  
Washington, D.C. 20004

*Counsel for Applicant, Replica, Inc.*

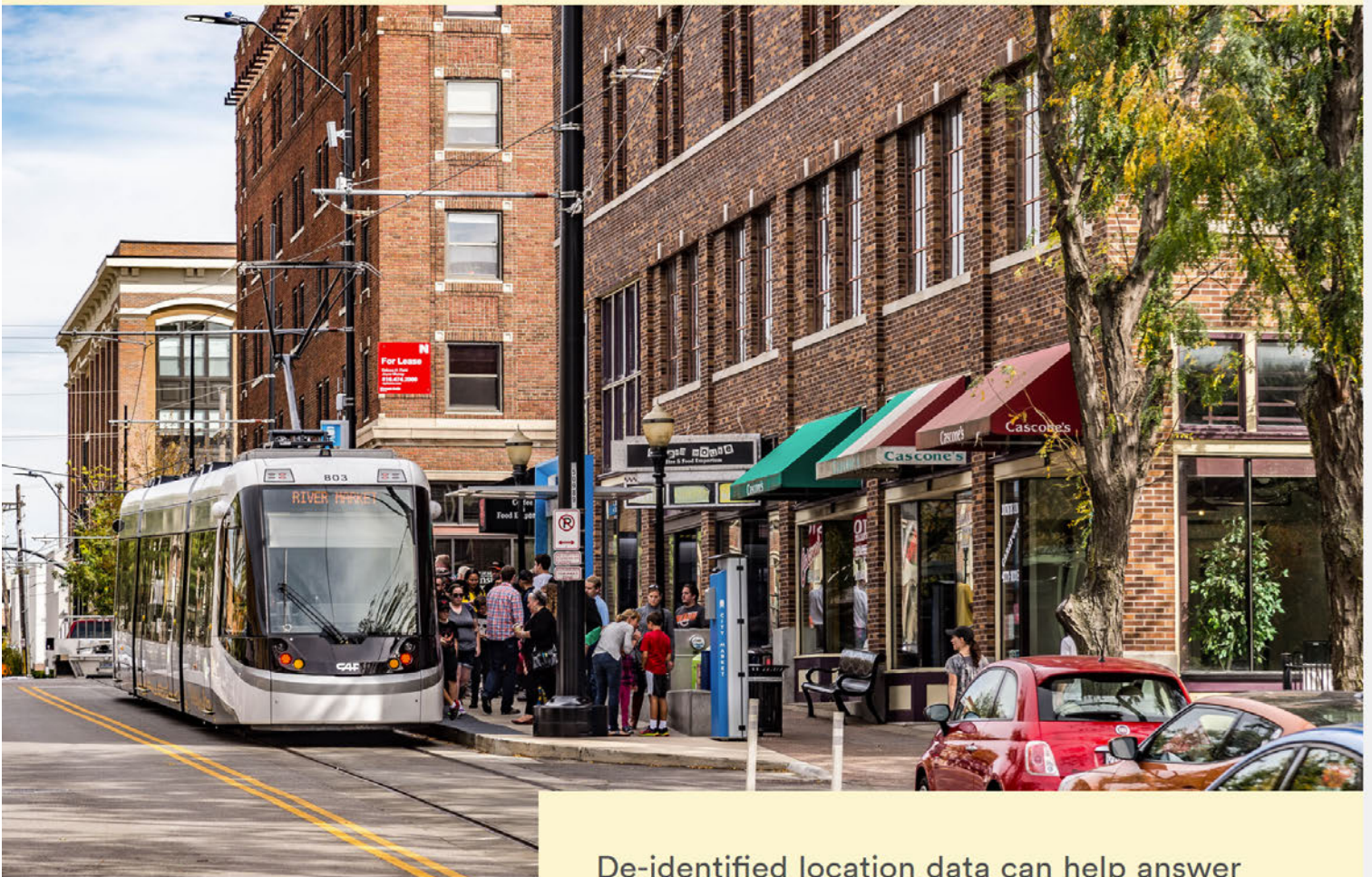
Date: June 20, 2019



# **EXHIBIT 1**

# Introducing Replica, a next-generation urban planning tool

URBAN DATA MODEL LAB URBAN DATA URBAN PLANNING



The more details urban planners have about what's happening on the street, the more questions they can answer.

(Jim Maurer / Flickr)

De-identified location data can help answer key transportation questions—from a regional level all the way down to a city block.



Who uses the street, in what way, and why? These are common questions that planning agencies consider every day when trying to build better cities. The answers can help them see how well transit is connecting workers to jobs, explore the traffic

Share

impact of a new toll lane, or identify the need for bike lanes and wider sidewalks.

But standard planning tools can't always answer these questions with complete or current details. Too often, planners must rely on costly household surveys conducted years ago or trip counters focused on a single transportation mode. Some agencies have complex modeling software, but that's often limited by older data and an overly technical interface.

The result is an incomplete sense of city movement patterns and, consequently, a lower confidence in critical transportation and land use decisions.

There's a key to unlocking better planning tools—right inside the smartphone you might be using to read this article. Our phones have a **powerful location awareness** that's transforming many aspects of urban life: helping us get directions, avoid a traffic jam, find a restaurant, or hail a ride. But this type of location data hasn't widely been used in the service of planning more equitable and adaptable cities.

We believe this powerful data source can help do just that. Meet Replica: a user-friendly modeling tool that uses de-identified mobile location data to give planning agencies a comprehensive portrait of how, when, and why people travel in urban areas.

Replica provides a full set of baseline travel measures that are very difficult to gather and maintain today, including the total number of people on a highway or local street network, what mode they're using (car, transit, bike, or foot), and their trip purpose (commuting to work, going shopping, heading to school, etc). By updating these measures every three months, Replica also provides the ongoing ability to detect changes in these measures over time—helping planners answer questions about land use and transportation from a regional level all the way down to a city block.

Most importantly, Replica does all that with personal privacy built into its foundation.

## A Virtual World With Real Qualities

There are many apps and companies that collect data about your location history and travel patterns via your smartphone. The problem is this data often contains personal information. Replica starts with data that has already been de-identified, meaning we never handle the original, identifiable information. We are not interested in the movement of individuals; we are interested in the collective movement of a particular place.

Replica uses this de-identified data from about 5 percent of the population to learn about travel patterns and create a travel behavior model—basically, a set of rules to represent who's moving where, when, why, and how. But models aren't perfect. So we gut check these rules using on-the-ground data (such as manual traffic counts or transit boardings) to make sure Replica is consistent with real-world movement patterns.

We then match these models with what planners often call a "synthetic" population. That's a very technical term, but the basic idea is that planners can use incomplete samples of census demographic data to create a broad new data set that is statistically



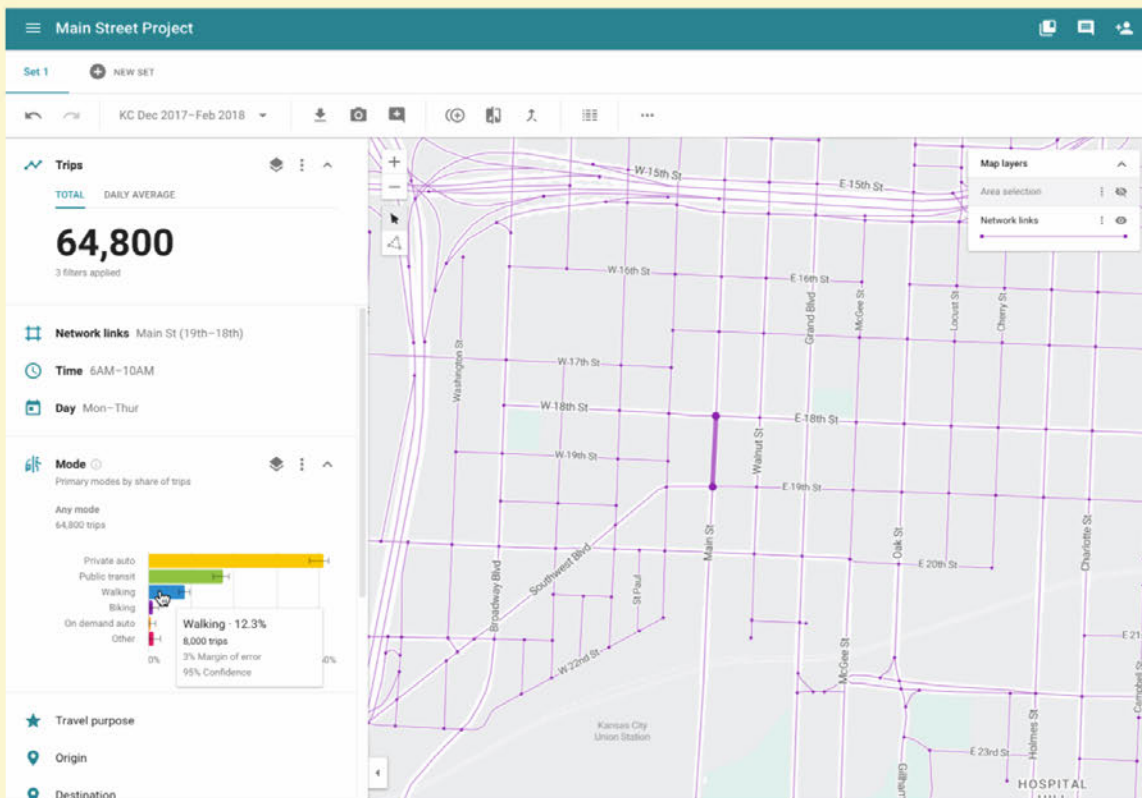
representative of the full population. The statistical process also removes any ability to identify a particular individual in the data. (We [open-sourced this work](#) last year and encourage others to examine our assumptions or build on top of them.)

When you combine travel behavior models with a representative population, you can confidently replicate trip patterns across a city or metro area.

In Replica, workers go to work and families go out to dinner. Roads are congested at rush hour, downtown sidewalks are busy at lunchtime, and bike paths are full after school. People travel in taxis, on foot, and in carpools. These movements are faithful to real-world activities but not traceable to actual people or specific trips. Planners can use this virtual world to help them make decisions about, and the study the impacts of, transportation or land use—without compromising individual privacy.

## From “What Now” to “What If”

Let’s go back to the initial questions—who uses the street, in what way, and why—and consider them through the lens of a city planning agency that wants to make streets safer and friendlier to cyclists. Here’s a look at a Replica dashboard focused on a section of Main Street in Kansas City:



The ability to understand in real-time who’s using the street and why (above, a Replica analysis of Main Street in Kansas City) can help guide urban planners.

*Understanding current conditions.* The analysis above shows that nearly 14 percent of all trips in this corridor are made by cyclists and pedestrians, and while most of these people are commuting to work, a notable share are shopping. These baseline counts of trip mode and travel purpose are historically very difficult to gather, but they can help focus planning decisions around empirical evidence. For example, knowing that cyclists

and pedestrians are shopping in this area might help demonstrate to local shop-owners that business won't suffer if street-parking spaces are replaced with a bike lane.

*Analyzing changes over time.* Currently, there are still few cyclists in this area. But urbanists know that if a model (or, for that matter, a survey) tells you there aren't many cyclists using a given street, that doesn't mean people don't want to bike there—they just might not feel safe enough. The ability to measure changes in usage patterns before and after implementing a bike lane could help planners demonstrate just how many more bike trips a new lane encouraged people to take, making it easier for local officials to support similar interventions elsewhere.

*Guiding planning decisions.* Over time, we plan to update Replica with the ability to explore prospective service changes and interventions—modeling the impact of Scenario A against Scenario B. We believe this capability can help local officials make the most of limited funding and physical space. It can also help them **engage the public around planning decisions** in a clearer way. As we've written before, transparent models can become the basis for community workshops around things like inclusive street design, helping planners explain the impact that various options might have on different populations.

We are currently building Replica to support the development of plans for **Sidewalk Toronto**. One of that project's core objectives is to give communities new tools to adapt much more quickly than cities can today, and we believe Replica can not only help us explore new ideas but to communicate their potential impact to a wider public. As part of this process, we'll be sharing Replica with local Toronto researchers and public agencies to gather feedback and make it more useful to them.

Later this year, Replica will make its U.S. debut in the Kansas City and Chicago regions, with other areas to follow.

We know models don't provide simple solutions to planning problems. They're tools—albeit ones we believe can be more accurate and useful than existing tools. Planning decisions still must reflect the priorities and values of the local community. And many factors beyond modeling outcomes go into urban planning decisions.

But as one Kansas City planner told us during the development of Replica: “The more detail you give me, the more questions I can answer.” By giving planning agencies information that's more accurate, current, and representative than what's typically available, we can help them respond more quickly to their community's needs today—and prepare for the future.

Nick Bowden is Product Lead for Model Lab.

# Further Reading

CIVIC ENGAGEMENT

### Collab: A new digital tool for community participation


Sidewalk Labs and Digital Public Square teamed up on a new prototype to help people shape their communities.



TRANSPORTATION

### Four principles for the future of city streets

Cities can leverage design and technology to re-think our streets for pedestrians, bikes, and transit.



PUBLIC REALM

### How can we bring transparency to urban tech? These icons are a first step.

Our "Digital Transparency in the Public Realm" project brought people around the world together to co-create a visual language to demystify the tech in cities.

Drag

### An Update on Data Governance for Sidewalk Toronto

We believe Quayside can set a new model for responsible data use in cities —anchored by an independent Civic Data Trust.



BLOG POST

### The m micro

A Sidewalk Labs Toronto project. Pedro ab... public sp... comforta...

## Newsletter

Follow what we're thinking, doing, and reading about the future of cities.

Email Address  [Subscribe](#)

Social

[Twitter](#) [Facebook](#) [Medium](#) [YouTube](#)

Podcast

[Apple](#) [Google](#) [Spotify](#) [Stitcher](#)

© 2019 Sidewalk Labs | [Privacy Policy](#)

## Contact

General Inquiries  
[hello@sidewalklabs.com](mailto:hello@sidewalklabs.com)

Press & Speaking Inquiries  
[press@sidewalklabs.com](mailto:press@sidewalklabs.com)

Business & Investment Inquiries  
[partnerships@sidewalklabs.com](mailto:partnerships@sidewalklabs.com)

10 Hudson Yards, 26th Floor  
New York, NY 10001

[Google Maps](#)

Careers at Sidewalk Labs  
[Explore our open positions here](#)

Site  
[Home Toronto Blog Team](#)