

OFFICE ACTION RESPONSE

In an Official Action dated March 18, 2019, the examining attorney refused registration of Applicant's Mark, **RISK.NET (word mark)**, the subject of U.S. Ser. No. 88/238,276 ("Mark"). First, the Office Action contends that the Mark is "merely descriptive" of Applicant's services, which are financial risk management services. Second, the Office Action advises that the Mark appears to be generic – and thus, cannot be registered under any circumstances. Finally, the Office Action requests information about the services/wording that appears in the mark.

This Response addresses each of these issues.

I. The Mark Is Descriptive

Applicant does not dispute that the Mark may be considered "merely descriptive" for Applicant's services, namely, "Financial Risk Management services for producers, consumers and market participants engaged in energy and commodity transactions by providing a web-based platform to support clients in daily risk evaluation and management of risk exposures for all levels and functions of an enterprise including purchasing, marketing, invoices, contracts and operational efficiency." Thus, Applicant has amended the Application to allege use of the Mark, and now hereby amends the Application to seek registration of the Mark on the Supplemental Register.

II. The Mark Is Not Generic

Applicant respectfully disagrees that the Mark is any way generic. A mark is only generic if it is the common name of a class or category of goods or services, which is determined by asking whether the relevant consumers would primarily understand the term to refer to the genus of goods or services at issue. This involves answering two questions: (1) what is the genus of goods or services at issue? and (2) do relevant consumers understand the term primarily to refer to that genus? *H. Marvin Ginn Corp. v. Int'l Assn. of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 258, 530 (Fed. Cir. 1986).

In contrast, marks are "merely descriptive," if they describe "an ingredient, quality, characteristic, function, feature, purpose, or use of the specified goods or services." *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986) (holding that the mark BED & BREAKFAST REGISTRY is merely descriptive of lodging reservation services). This distinction is critical, because merely descriptive marks can be registered on the Supplemental Register, or upon the Principal Register upon a showing of secondary meaning, whereas generic "marks" cannot be registered under any circumstances.

To support a genericness refusal, the USPTO bears a heavy burden of producing "clear evidence" of generic usage. *See In re Chronix Biomedical, Inc.*, Ser. No. 86/612,457, 2018 WL 3740515, at *9 (T.T.A.B. Jul. 10, 2018) (Kuczema, J., dissenting) ("It is incumbent upon the examining attorney to make a substantial showing . . . which must be based on clear evidence of generic use . . ."). While in the instant case, the genericness refusal is only advisory, the USPTO would face an uphill battle in establishing that the Mark is generic for the identified services.

A. Analysis

Here, the genus of services is defined by Applicant's identification, which is:

Financial Risk Management services for producers, consumers and market participants engaged in energy and commodity transactions by providing a web-based platform to support clients in daily risk evaluation and management of risk exposures for all levels and functions of an enterprise including purchasing, marketing, invoices, contracts and operational efficiency

The identification also defines the relevant consumers: "producers, consumers, and market participants engaged in energy and commodity transactions."

Thus, the critical question is: *Do producers/consumers/market participants engaged in energy and commodity transactions primarily understand the term RISK.NET to refer to financial risk management services provided through a web-based platform, to support clients in daily risk evaluation and management of risk exposures for all levels and functions of an enterprise including purchasing, marketing, invoices, contracts, and operational efficiency?*

Applicant respectfully contends that the answer to this question is "no." Applicant respectfully reserves all further argument(s) for if/when the USPTO issues a formal refusal.

III. Information About Services

In further response to the Office Action, Applicant states that lacks "fact sheets, instruction manuals, advertisements and pertinent screenshots of applicant's website as it relates to the services in the application, including any materials using the terms in the applied-for mark." Applicant respectfully objects to the request for this information about Applicant's competitors. Applicant elects to provide a more detailed description of its identified services, which are financial risk management services provided through a novel secure risk management platform, to allow consumers in the energy and commodities trading industry to evaluate and manage risk exposures across various levels of an organization, including purchasing, marketing, invoices, contracting, trade positions management, operational efficiency, and financial risk management. Specific functions include access to one discrete data set, updated daily; access to clear and transparent risk data, which accurately depicts cash flow, risk, and exposure; proprietary tools to evaluate and manage risk exposures across all levels of the organization; additional proprietary tools for viewing and analyzing internal data coupled with audited market information; and access to industry recognized reporting analysis, which flows directly into public financials.

Additionally, Applicant answers to the following specific questions raised by the Office Action:

1. Do Applicant's competitors use "RISK" to advertise similar services?

To the best of Applicant's knowledge, competitors use the term "risk" for its dictionary-definition meaning. *See* American Heritage dictionary definition attached to Office Action.

2. Does Applicant have a website registered to the domain “RISK.NET”?

No.

3. Who is the typical consumer of Applicant’s services?

Businesses and their employees in the field of energy and commodities trading.

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In view of the above, Applicant respectfully submits that all outstanding issues are addressed hereby, and that the Application (as amended) should be approved for publication in the *Official Gazette*.