

## **RESPONSE TO OFFICE ACTION**

Applicant PacketFabric, LLC hereby responds to the United States Patent and Trademark Office (“USPTO”) Action dated April 26, 2019 (the “Office Action”). In the Office Action, the examining attorney (the “Examiner”) refuses registration of Applicant’s mark PACKETFABRIC (“Applicant’s Mark”), on the basis that Applicant’s Mark is descriptive because the terms “packet” and “fabric” together “merely describes a feature of applicant’s services, namely, applicant’s networks feature a mesh of connections to send units of data.”

Applicant responds by respectfully submitting that, for the reasons set forth below, the mark PACKETFABRIC is not descriptive of the services it sells under the mark, as (a) the term itself has no commonly understood meaning, (b) even if it had a meaning it does not describe Applicant’s services, and (c) as a result there is no instantaneous connection between the mark and the services. Instead, the wording is at the very least suggestive, as it takes *at least some* imagination, thought, and perception on the part of the consumer to realize that the mark PACKETFABRIC refers to services for location-gathering, network solutions, and software. Therefore, Applicant’s Mark should be approved for publication.

## **ARGUMENT**

### ***I. A term is only merely descriptive if a consumer creates an “almost instantaneous” connection between the term and the goods or services.***

“A term is merely descriptive if it immediately conveys knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used.” *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (quoting *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)). As a result, if wording does **not** immediately convey such information, then that wording is **not** merely descriptive. See MCCARTHY ON TRADEMARKS & UNFAIR COMPETITION § 11:67 (4th ed. 2006); see also *Stix Products, Inc. v. United Merchants & Mfg., Inc.*, 295 F. Supp. 479, 488 (S.D.N.Y. 1968) (finding CON-TACT mark not descriptive of self-adhesive decorative plastic where “more than mere observation is required”).

Wording or terms that are determined not to be merely descriptive are often found to be suggestive. A mark or term is suggestive if it “requires imagination, thought, and perception to arrive at the qualities or characteristics of the goods or services.” *In re Franklin Cty. Historical Soc’y*, 104 USPQ2d 1085, 1087 (TTAB 2012); see also TMEP §1209.01(a). Whether a particular term is merely descriptive or instead is suggestive is determined in relation to the goods for which registration is sought and the context in which the term is used, not in the abstract or on the basis of guesswork. See *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *In re Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002). By definition, a term that is suggestive cannot be merely descriptive.

### ***II. The term PACKETFABRIC has no commonly understood meaning.***

A review of dictionaries, internet searches, and technical terms shows that the term PACKETFABRIC (or even PACKET FABRIC with a space) has no commonly understood meaning. The lack of such a meaning for the term supports a finding of it being suggestive, and weighs against a finding of descriptiveness. See *In re Wisconsin Tissue Mills*, 173 USPQ 319,

320 (TTAB 1972) (reversing a refusal to register the mark POLYTISSUE on the grounds of mere descriptiveness, because the POLYTISSUE mark has no “intelligible” meaning and “is somewhat incongruous.”).

**A. No dictionaries provide an entry for PACKETFABRIC or PACKET FABRIC, and the two words used together do not form a coherent meaning.**

While the Examiner attached printouts from a single online dictionary, Linktionary.com, showing the meaning of the words “Packet” and “Fabric” when used by themselves, there were no such printouts for the term “PacketFabric” or “Packet Fabric”. Applicant’s own research has found no dictionary definition for the term “Packet Fabric,” regardless of whether there is a space included, including in technical and computer dictionaries. See Exhibit A. The lack of such a meaning for the term supports a finding of it being suggestive, and weighs against a finding of descriptiveness, because it is unable to inform as to an “characteristic, ingredient, quality, or attribute” of the services. See *In Re Atavio Inc.*, No. 74/055,292, 25 U.S.P.Q.2d 1361 (T.T.A.B. 1992).

Additionally, while each of the individual words that make up the “PacketFabric” mark has a meaning, individual meanings for those words do not make the full term descriptive if the words do not form a coherent and descriptive meaning when used together. See *In re Colonial Stores, Inc.*, 394 F.2d 549, 157 USPQ 382 (CCPA 1968) (finding a composite of allegedly descriptive terms to be registerable and not merely descriptive), and *In re Wisconsin Tissue Mills*, 173 USPQ 319, 320 (TTAB 1972) (holding that even if two individual words have descriptive meanings when used separately, if the words when combined do not have an “intelligible” meaning, the combined mark is not merely descriptive.). Here, Applicant agrees with the Examiner that the word “Packet” in the context of computer services refers to “a unit of data that is transmitted across a packet-switched network.” The word “Fabric” has many meanings, but in the context of computer services its most relevant meaning is “a metaphor to illustrate the idea that if someone were to document computer components and their relationships on paper, the lines would weave back and forth so densely that the diagram would resemble a woven piece of cloth.” See Exhibit B. While the Examiner used a different definition from Linktionary.com, Applicant respectfully asserts that its definition is more accurate. Not only does Linktionary.com state that “This site is no longer being updated. It is now an archive,” but according to the dates on the website it has not been updated since 2001. See Exhibit C. As a result, Applicant’s technical dictionary (TechTarget.com), which is live and updated, is a better reflection of the meaning of computer-related terms.

However, the two words together do not have an understood meaning when used in connection with retail services. Not only do no dictionaries give a meaning for the two words together, but even a combination of the two terms does not create a coherent meaning. A “packet” is a very small piece of data, while a “fabric” is a layout of computer components with the implication that it covers a wide area densely. Obviously, a small piece of information cannot cover a wide area, let alone cover it densely. And computer components are not small pieces of data. As a result, the term “Packet Fabric” has no understood meaning when used in connection with services in the Application, and this weighs against a finding of descriptiveness. *Id.*

**B. The Examiner provided no evidence that PACKETFABRIC or PACKET FABRIC is used descriptively or has a commonly understood meaning.**

The Examiner attached printouts from two websites where the words “packet” and “fabric” are used. However, Applicant respectfully submits that Examiner’s printouts do not

support a finding of descriptiveness, and instead support Applicant's argument that the term PACKETFABRIC is at the very least suggestive.

First, the Examiner attached two webpages from BigSwitch.com, a company that sells products related to "Data center networking and network monitoring." See (<https://www.bigswitch.com/company/mission>). Both webpages relate to a Big Switch product that is marketed under the mark BIG MONITORING FABRIC. But while the pages include the term "packet" as well, the two terms are not used together, and "packet" is only used as part of a larger sentence to describe the functionality of the product. As a result, not only does Big Switch not use the term "Packet Fabric" or a similar term, but the printouts do not provide any evidence that PACKETFABRIC or PACKET FABRIC is used descriptively or has a commonly understood meaning.

Second, the Examiner attached a webpage from PluribusNetworks.com, a company that "delivers industry-leading open networking solutions featuring a unique next-generation software-defined networking (SDN) fabric for modern single-site data centers, multi-site data centers and distributed cloud edge compute environments." See (<https://www.pluribusnetworks.com/company/about-pluribus/>). That webpage relates to a Pluribus technology that is marketed under the mark FABRIC VISIBILITY. But while the page does include the term "packet," the two terms are not used together or even in the same sentence. As a result, not only does Pluribus Networks not use the term "Packet Fabric" or a similar term, but the printout does not provide any evidence that PACKETFABRIC or PACKET FABRIC is used descriptively or has a commonly understood meaning.

As a result, for the same reasons as set forth above, the printouts from online dictionaries, online technical dictionaries, online searches, and webpages from companies in the field support a finding that the PACKETFABRIC wording is at least suggestive as consumers will have to use imagination, perception, and/or thought in order to understand that the PACKETFABRIC wording refers to services for location-gathering, network solutions, and software. Google searches for the term show that there is not one result using PACKETFABRIC or PACKET FABRIC as a descriptive term, and instead every single result uses the term as a mark to refer to Applicant and/or Applicant's services. See Exhibit D.

**III. *Even if PACKETFABRIC or PACKET FABRIC did have a meaning, it would not convey any knowledge of a quality, feature, function, or characteristic of Applicant's services.***

While PACKET FABRIC does not have a commonly understood meaning (other than as a mark to refer to Applicant), even if it did have such a meaning, the wording still would not be merely descriptive because the wording's meaning would not convey any knowledge of a quality, feature, function, or characteristic of Applicant's services. As described above and supported by Applicant's attached evidence, the word "packet" means "a small unit of data," and the word "fabric" is "a metaphor to illustrate . . . computer components [with] relationships . . . so dense[] that the diagram would resemble a woven piece of cloth." Therefore, the meaning of PACKET FABRIC would likely be either "small pieces of data connected in dense relationships" or "miniature packet-sized computer components connected to each other."

But neither definition has a coherent meaning when used in connection with Applicant's services, namely "Providing custom network solutions to businesses," "computer and telecommunications equipment co-location services," "Software as a service (SAAS) services" and "Development of software for secure network operations." By definition, none of those services involve either hypothetical definition of PACKET FABRIC, and therefore the wording,

even if it did have a meaning, does not convey any knowledge of a quality, feature, function, or characteristic of Applicant's services.

**IV. Because it has no commonly understood meaning, let alone a meaning relevant to Applicant's services, the PACKETFABRIC wording does not create an "almost instantaneous" connection between the mark and the goods or services. Instead, consumers have to use their imagination, perception, and/or thought in order to understand that PACKETFABRIC describes network, location, computer, and software services.**

The PACKETFABRIC mark is *at least* suggestive and not merely descriptive of the services set forth in the subject application. The wording does not immediately describe the recited services, and a sufficient degree of imagination is required to determine the significance of the wording and the mark. Given that the dictionaries show that "packet" in the computer context refers to "a unit of data" and that "fabric" in the computer context refers to "computer components [with] relationships . . . so dense[] that the diagram would resemble a woven piece of cloth," Applicant submits that when consumers encounter the PACKETFABRIC wording in connection with the services in the Application, the wording will not immediately convey anything about the function or characteristic of the services, as the services are not restricted to small units of data or dense computer components. Instead, consumers will have to use imagination, perception, and/or thought in order to understand that the PACKETFABRIC wording refers to network, location, computer, and software services.

As a result, the wording is at the very least suggestive and should not be disclaimed. See TMEP § 1209.01(a) ("Suggestive marks are those that, when applied to the goods or services at issue, require imagination, thought, or perception to reach a conclusion as to the nature of those goods or services. Thus, a suggestive term differs from a descriptive term, which immediately tells something about the goods or services."). Any connection to the services in the Application takes the required "imagination, thought, and/or perception" necessary to make the PACKETFABRIC wording in Applicant's Mark suggestive.

**V. All doubts must be resolved in favor of the Applicant.**

The Applicant respectfully asserts that the arguments outlined herein establish that the wording of Applicant's Mark is at least suggestive and not merely descriptive of the services identified in the application. However, to the extent the Examiner has doubts, such doubts as to the descriptiveness of a mark must be resolved in Applicant's favor. See *In re The Stroh Brewery Co.*, 34 U.S.P.Q. 2d 1796 (T.T.A.B. 1994) ("when doubt exists as to whether a term is descriptive as applied to the goods or services for which registration is sought, it is the practice of the Board to resolve doubts in favor of the Applicant and pass the mark to publication."); *In re Salzgitter Flachstahl GmbH*, 2007 WL 1893923, 5 (T.T.A.B. June 27, 2007) ("in descriptiveness cases is that we must resolve any doubts that we may have about whether applicant's mark is merely descriptive in applicant's favor"); and *In re Morton-Norwich Products, Inc.*, 209 USPQ 791, 791 (T.T.A.B. 1981) (the PTO prefers to "resolve doubts in applicant's favor and publish the mark for opposition.").

Applicant respectfully asserts that this should be the case here. Due to the lack of any evidence that the wording PACKETFABRIC has a commonly understood meaning, the lack of any evidence that other companies or consumers use the wording descriptively, and the fact that consumers will need to use thought and imagination in order to understand that PACKETFABRIC refers to network, location, computer, and software services, even in the event that the Examiner believes the wording *could* be descriptive, the Examiner should approve the

application and allow the mark to be published. During publication, if the wording truly is used descriptively, any of the thousands of companies involved with computer-related services across the country could oppose. Applicant is confident, however, that there will be no such opposition, as the computer industry knows "PACKETFABRIC" is not descriptive for computer, software, location, or networking services.

This conclusion is supported even more forcefully here where internet searches show that the industry already uses Applicant's Mark exclusively to refer to Applicant, and never as a descriptive term. See Exhibit D.

## **VI. Conclusion**

For the reasons stated above, Applicant respectfully asserts that the PACKETFABRIC wording is not descriptive of any of the services that are covered by the Application. Instead, consumers would have to use their imagination and perception in order to understand the connection between the wording and the nature of the services. As a result, Applicant believes all outstanding issues with respect to the Application for Applicant's Mark have been resolved and respectfully requests approval of the same for publication.