

**Applicant:** Datafoxtrot, LLC d/b/a BuildingFootprintUSA

**Serial No.:** 88342206

**Examining Attorney:** Carl A. Korschak, Esq.

**Law Office:** 126

### **RESPONSE TO OFFICE ACTION**

This paper is being filed in response to the Office Action dated May 30, 2019, relative to Applicant's trademark application for the word mark "Building Footprint USA." Applicant respectfully requests that the refusal to register be withdrawn, and submits that the application should proceed to publication in view of the following remarks.

**A. Applicant's mark, "Building Footprint USA," is not primarily geographically descriptive.**

The ordinary meaning of words "Building Footprint USA," when considered and defined from the perspective of an ordinary consumer, forms a composite mark that is at least suggestive of the goods and services sought for registration. Thus, the mark should not be refused for being primarily geographically descriptive. As set forth in the Office Action, this ground for refusal may be overcome by demonstrating at least one of the following: the "primary significance" of the mark not being a "generally known geographic place or location," the goods and/or services not originating in the geographic place identified in the mark, or purchasers not being likely to make a goods-place or services-place association as a result of the mark. TMEP § 1210.01(a).

Applicant's mark is in condition for registration because the alleged geographic term "USA" is not the primary significance of the mark. The term "USA" appears after the primary term of the mark (i.e., "Building Footprint") and thus purchasers are unlikely to make a goods-place or services-place association from the mark's content. Applicant is seeking to register the composite word "Building Footprint USA," in which the secondary term "USA" appends the primary focus of the mark, i.e., the term "building footprint." Although the Office Action characterizes "USA" as being the mark's primary significance, with "Building Footprint" allegedly being "additional wording," such a conclusion is not supported by substantial evidence. The Office Action cites evidence tending to indicate that the primary significance of the wording "USA" itself is that of a geographic location. Office Action at page 3. However, none of the cited evidence demonstrates or is alleged to demonstrate that the term "USA" should be considered the "primary significance" of the mark or should supersede the rest of the mark's terminology. Instead of providing such evidence, the Office Action alleges that the remainder of the mark, i.e., "building footprint," is descriptive and thus does not "significantly alter or diminish the mark's geographical descriptiveness." Office Action at page 3, *citing* TMEP § 1210.02(c)(ii). Such an interpretation requires the remainder of the mark to include "*generic or highly descriptive wording*" in conjunction with the geographic word or term, and the cited evidence does not support such an interpretation. TMEP § 1210.02(c)(ii) (emphasis added).

The composite term "Building Footprint USA," and not merely the term "USA" in isolation, constitutes the mark's primary significance. Further, the Office Action lacks substantial evidence of "Building Footprint USA" being "generic or highly descriptive." The mark should be entitled to registration because this term is at least suggestive of Applicant's goods and services, or at least is not "generic or highly descriptive" of Applicant's goods and

services. Regarding descriptive terms, a mark is merely descriptive as considered in relation to the identified goods and services, and not in the abstract. *In re Abcor Dev. Corp.*, 588 F.2d 811, 814, 200 USPQ 215, 218 (C.C.P.A. 1978); TMEP § 1209.01(b). Where a mark is made up of several arguably descriptive words, descriptive refusal is improper where the mark creates a new and different commercial impression or the mark creates an incongruous meaning as used in connection with the goods and services. TMEP § 1209.03(d).

Here, the text “Building Footprint USA” gives rise to a new commercial impression because the term “building footprint,” whether considered alone or in combination with the term “USA,” does not describe several of the goods and services being sought for registration. The Examining attorney asserts that the compound term “building footprint,” considered as a whole, commonly refers to “the surface space occupied by a structure or building,” and further alleges that “spatially referenced structure polygons” specifically includes building footprints. Office Action at page 3. The Examiner’s allegation that a “building footprint” is primarily descriptive of such polygons, whether provided in a database or via a service as noted in the Application, lacks substantial evidentiary support. For example, the supporting evidence defines “building footprint” as referring to the “ground surface area above which a building... is located.” Office Action at page 39. Although Applicant’s specification includes similar data as a subset of the relevant goods and services, Applicant’s goods and services under the mark include many other types of “spatially referenced structure polygons” and other data outside this definition. As provided in the Application, Applicant’s relevant goods and services are listed as:

*Downloadable electronic data files featuring spatially referenced structure polygons and associated attribute data; downloadable databases in the field of spatially referenced structure polygons and associated attribute data (International Class 9); Electronic storage of databases including spatially referenced structure polygons and associated attribute data; data warehousing;*

*Data conversion of electronic information* (International Class 42). (Emphasis added.)

As demonstrated in Applicant's previously-submitted specimens, "associated attribute data" includes data for "addresses," shapes," or "building height." Applicant's Specimen 2. The covered services also include linking "building footprints to georeferenced locations," "connect[ing] building footprints to *other attribute information* such as real property or building information," geocoding, and other services beyond the scope of building footprints themselves.

When Applicant's goods and services are considered in combination with the definition set out above, the mark clearly creates a new and different commercial impression. Specifically, a prospective purchaser of the services covered under the mark would not be aware, without further information, that the mark's owner offers data such as address and height to expand the utility of raw data, or the services of contextualizing various forms of building data by combining such data with attribute information, georeferenced locations, geocoding, etc. Thus, even assuming for the sake of argument that an ordinary consumer would define the term "building footprint" as proposed in the supporting evidence, none of available evidence denotes this term as being descriptive, much less primarily descriptive, of the related products and services being offered via the mark. A mark is not descriptive if it requires a multi-stage reasoning process to show a connection between the mark and services, from the standpoint of the prospective consumer of the services. *In re Mayer-Beaton Corp.*, 223 USPQ 1347 (TTAB 1984). Here, Applicant's goods are not building footprints in and of themselves, nor are Applicant's services directed toward calculating or providing building footprints in and of themselves. Thus, an average consumer must undergo steps requiring some level of imagination or creativity to connect the term "building footprint" in the mark to any of the various additional

goods and services being offered. The term “building footprint” is thus not highly descriptive of Applicant’s goods and services, and should not be disregarded when assessing the “primary significance” of the mark. “[I]f the most prominent meaning or significance of the mark [i.e., “building footprint” or “Building Footprint USA” as a whole] is not geographic, or if the mark creates a separate readily understood meaning that is not geographic, registration must not be refused.” TMEP § 1210.02(b)i(i). Considering the mark “Building Footprint USA” as a whole, the term, “USA” is not the primary significance of the mark and thus the mark as a whole does not primarily describe a “generally known geographic place or location.” *See id.*

**B. Applicant’s specimen properly shows use in commerce in connection with the indicated services in International Class 42.**

Registration is also refused in part due to an allegation that the applicant’s accompanying specimens allegedly fail “to show the applied-for mark in use in commerce” with respect to the identified goods in International Class 9. Office Action at page 5. This refusal is an error because Applicant seeks registration for the identified goods in International Class 9 based on Intent to Use under Section 1(b) of the Lanham Act, and not based on Current Use in commerce under Section 1(a). The Office Action does not allege Applicant’s specimens to be insufficient with regard to International Class 42, but mistakenly characterizes Applicant’s filing basis for International Class 42 as being Intent to Use under Section 1(b). Office Action at page 5. Applicant maintains that the accompanying specimens are sufficient to demonstrate use of the mark in connection with the identified services under Section 1(a).

**C. Response to request for written statement regarding goods and services.**

The Office Action requests that Applicant provide a written response to three questions regarding the identified goods and services. Regarding the first question, whether the identified goods are “sold, manufactured, produced, or packaged and shipped from the USA,” the identified goods are sold within the United States (“US”) and outside the US, and are provided to customers within the US and outside the US. Regarding the second question, whether the identified services are “rendered at least in part in the US,” Applicant’s services are rendered within the US for some customers and outside the US for other customers. Regarding the third question, “Will applicant’s services be rendered at least in part in the US,” Applicant’s services will be rendered within the US for some customers and outside the US for other customers. According to the example of goods in the form of raw data or services in the form of periodic updates to raw data, customers within and outside the US may access remote data centers that are located within the US and/or outside the US.

**D. Conclusion.**

For the foregoing reasons, Applicant respectfully requests that the refusals to register be withdrawn, and that this application be allowed to proceed to publication. The present Response is intended to address all issues outlined by the Examining Attorney. If there is an issue that can be resolved by an Examining Attorney's Amendment, the Examining Attorney is invited to contact Applicant's undersigned attorney.

/Matthew J. Kinnier/ \_\_\_\_\_  
(Signature)

Matthew J. Kinnier, Attorney of Record  
(Print or Type Name and Position)

November 26, 2017 \_\_\_\_\_  
(Date)