Response

This Response answers the Office Action issued on July 17, 2019 for Application Serial No. 88/415,179 (the "Application") for the mark "CLOUD LOGISTICS" (the "Mark") filed by E2OPEN, LLC (the "Applicant"). Please see the following remarks in further consideration of this Application.

Amendments

Please amend the Class 042 services as follows: Providing online non-downloadable software **for use in database and shipment management** in the field of transportation systems management.

Remarks

I. CLOUD LOGISTICS Does Not Merely Describe Applicant's Services

The Examiner has initially refused registration of the Application under Section 2(e)(1) of the Trademark Act on the basis that "CLOUD LOGISTICS" is merely descriptive of a characteristic of Applicant's services. Specifically, the Examiner states that Applicant's Mark is merely descriptive because 1) applicant provides online services and 2) applicant's services are in the nature of making arrangements within an organization. For the reasons below, Applicant respectively submits that "CLOUD LOGISTICS" is not merely descriptive of Applicant's services and is at most suggestive thereof.

As the Examiner states, a mark is only considered "merely descriptive" if it describes an ingredient, quality, function, feature, purpose, or use of the specified goods and/or services. TMEP § 1209.01(b). The determination of whether a mark is merely descriptive must be made in relation to the goods or services for which registration is sought, not in the abstract. TMEP §

1209(a); *In re Chamber of Commerce*, 675 F.3d at 1300, 102 USPQ2d at 1219. For a mark to be categorized as "descriptive," it must give consumers a reasonably accurate or adequately distinct knowledge as to the services or type of product offered. *Blisscraft of Hollywood v. United Plastics Co.*, 131 U.S.P.Q. 55, 60 (2d Cir. 1961), cited in J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS, § 11:19, at 11-47 (03/2018) (hereinafter "MCCARTHY"). Here, when considering Applicant's Mark in relation to the applied-for services, the mark does not provide this adequately distinct knowledge about those services without a "mental leap" and therefore it is not "merely" descriptive.

While Applicant agrees with the Examiner that "cloud" could be descriptive of "online services", and that logistics could, depending on the context, refer to "making arrangements" – a consumer encountering Applicant's Mark would need to have more information before them in order to determine what services the composite mark CLOUD LOGISTICS was being used in connection with. The fact that the two words in Applicant's Mark have underlying meaning is not determinative as the mark "does not have to be devoid of all meaning in relation to the goods and services to be registerable." TMEP §1209.01(a). The term "merely" is to be taken in its ordinary meaning of "*only*." In other words, when considered with the particular goods or services, the mark *must do nothing but describe those goods or ser*vices. *See In re Colonial Stores, Inc*., 157 USPQ 382, 384-385 (C.C.P.A. 1968) (finding that the composite mark SUGAR & SPICE is not merely descriptive of baked goods, but suggestive and noting that "the mark clearly does not tell the potential purchaser only what the goods are, their function, their characteristics or their use, or, of prime concern here, their ingredients". Thus, even though the

bakery products at issue such as cakes and cookies necessarily contained both sugar and spice, the C.C.P.A. still found the mark to be suggestive and not descriptive).

The Second Circuit has found that while a "descriptive" term *directly describes* a particular product or service, a "suggestive" term could *plausibly describe* a variety of other products or services. MCCARTHY §11:19 at 11-46 (03/2018) *citing Playtex Products, Inc. v. Georgia Pacific Corp.,* 390 F.3d 156, 164 (2d. Cir. 2004) (emphasis added).

While Applicant is aware that the determination of descriptiveness is not made in the abstract, "CLOUD LOGISTICS" would at the very least could "plausibly describe" other goods or services. Based off the Examiner's attached evidence, "CLOUD" has multiple meanings, and when used in combination with "LOGISTICS" it is not immediately clear which meaning is applicable. As an example, the Examiner's attached evidence shows that the primary dictionary definition of "CLOUD" refers to the condensed water vapor in the sky, i.e. non-computer related "clouds". Further, "LOGISTICS" means the management or transport of goods. Consumers are well aware that such management or transportation frequently occurs via airplane, which fly in the "clouds". Thus, based on the most common dictionary definition of each term, a consumer who encountered "CLOUD LOGISTICS" could quite easily believe that the mark was referring to a company that offered services having to do with the management and coordination of goods that were transported by airplane or a company that helped move goods via airplane and therefore the mark has a non-descriptive meaning in relation to the services.

Beyond this example, even if a consumer does in fact associate "CLOUD" with "cloud computing" the mark is still not descriptive of Applicant's services as listed in the application. As previously stated, when considered with the particular goods or services [in the application],

the mark must do nothing but describe those goods or services. *See In re Colonial Stores, Inc*., 157 USPQ 382, 384-385 (C.C.P.A. 1968). Here, Applicant's services are:

> "Order fulfillment services for connecting product suppliers to a retailer's purchase order via ground, sea and air carriers, monitoring and tracking of package shipments to ensure on-time delivery for business purposes; transportation management solutions, namely, business management consultation regarding calculating the cost of shipments by adding the freight terms plus any shipment accessorials for payment to the shipment carrier for each shipment, and business management consultation regarding the receipt of electronic invoices from the shipment carriers and matching the invoices against the carrier contract for payment authorization; order fulfillment services for directing product suppliers to ship partial purchase orders based on a retailer's rules and then providing status updates on the order's manufacturing process; Supply chain management services for tracking shipments from product suppliers into warehouses and from warehouses to customers or company stores; transportation networking services, namely, providing on-line monitoring and tracking of package shipments for product suppliers, carriers, shippers, customers, and stores to ensure on-time delivery for business purposes, and providing commercial package shipment information updates online concerning the monitoring of commercial package shipments for business purposes, in the field of business, commerce and industry for product suppliers, carriers, shippers, customers, and stores" and "Providing online non-downloadable software for use in database and shipment management in the field of transportation systems management"

A consumer who encountered the Mark would not immediately know that the mark was used in connection with Applicant's highly specialized services included things such as order fulfillment services, transportation management services and supply chain management services, among others. To this point, none of the attached evidence by the Examiner, nor any of the attached evidence in the Letter of Protest shows the Mark being used in the same manner as Applicant or Applicant's listed services. For example, the evidence submitted with the Letter of Protest is particularly weak and at most reinforces Applicant's argument that CLOUD LOGISTICS could be descriptive of "online services related to logistics" but is not merely descriptive of the applied for services. To this point, Applicant has considered and responded to the evidence submitted in the Letter of Protest as follows:

Evidence from Letter of Protest	**Applicant's Remarks**
Evidence from Oracle showing usage of the term "logistics cloud"	This evidence does not show the use of Applicant's mark, CLOUD LOGISTICS.
Textbook containing the name "Cloud Logistics"	There is no evidence that the book has anything to do with Applicant's services, as the description does not mention any of Applicant's applied for services. Further, the book originates outside of the United States, has only been downloaded a little over 3,000 times, and there is no evidence that these downloads came from users in the United States. This evidence is not probative of the fact

	that consumers use "CLOUD LOGISTICS" in a descriptive manner to refer to any of Applicant's services.
Various research articles on "cloud logistics"	These articles originate outside of the United States, and have been viewed by a minimal amount of consumers since 2012. For example, the article on China's network economy has only been viewed 524 times since 2012, and it is unclear whether those views even originated within the United States. As such, the articles are not probative of how CLOUD LOGISTICS is used in the United States, particularly amongst the relevant consuming public. Instead, the Google search evidence discussed below is much more applicable and probative than this obscure literature.
DHL, Neuro Red, Freight Gate, and Giga Cloud's use of "Cloud Logistics" and "Giga Cloud Logistics"	The evidence on the attached websites merely show that these companies are using "Cloud Logistics" to refer to its standard logistics software being stored in the cloud, i.e. "Logistics as a Service". This evidence does not show that CLOUD LOGISTICS is merely descriptive of the numerous specialized services offered under Applicant's Mark, as discussed above. Once again, Applicant submits that the Google search evidence is much more probative than these examples.

LinkedIn Page, Websites, and Wallstreet Journal Article mentioning CLOUD LOGISTICS by E2Open LLC	These examples refer to Applicant's company and reference the Applied-for-Mark. If anything, this evidence shows that CLOUD LOGISTICS functions as a source indicator and is not descriptive of Applicant's services.

The above arguments are further evidenced by the fact that "CLOUD LOGISTICS" is an arbitrary term for which there is no dictionary definition (See Exhibit A). It is notable that while the Examiner's evidence attaches individual dictionary meanings for each term, there is no recognized definition for the combination of the two terms. As stated by the Supreme Court, "The commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail. For this reason, it should be considered in its entirety." *Estate of P.D. Beckwith, Inc. v. Commissioner of Patents*, 252 U.S. 538, 545-46 (1920). While Applicant acknowledges that a composite term not being in the dictionary is not conclusive on the issue of descriptiveness, the lack of a recognized definition in this case is indicative of the fact that a consumer would need to make a "mental leap" to determine the meaning of the two terms, the combination of which they had likely never encountered before. "Although the appearance of a term in a dictionary can never be conclusive that the term is merely descriptive, see, J. Gilson, Trademark Protection and Practice, § 2.02 [2] at note 28 (1984 ed.), dictionaries are unquestionably relevant evidence on this issue." *R.J Reynolds Co. v. Brown Corp*., 226 U.S.P.Q. 169 at *2 (T.T.A.B. May 17, 1985).

Further to this point, even if a consumer had previously encountered the wording "CLOUD LOGISTICS", they were likely to do so in the context of Applicant's services. Google

evidence shows that "CLOUD LOGISTICS" is primarily recognized a source indicator of Applicant's services rather than any type of descriptive term. "Ouellette has suggested that search engine results, such as those of Google, can be an accurate proxy for the meaning and distinctiveness of words. This is because Google's search algorithm that determines listings is based on the frequency with which users click on the top search results and is generally able "to predict what online content consumers associate with a search term." MCCARTHY § 11:20 (5th ed.). Here, as shown in the attached Exhibit B, in contrast to the obscure evidence submitted with the Letter of Protest, a consumer who searched for CLOUD LOGISTICS would be met with Google Search results that **exclusively** referenced Applicant on the first page. Additionally, this page clearly shows "CLOUD LOGISTICS" being described as a "company". It is well documented that most consumers do not stray beyond the first page of Google search results. (*See* Exhibit C, "75% of users never click past the first page of search results"). Thus, these search results are highly indicative of the fact that CLOUD LOGISTICS is not used in a descriptive sense but rather functions as a trademark indicating the source of Applicant's services.

In view of all the foregoing, Applicant respectfully submits that "CLOUD LOGISTICS" is an inherently distinctive and suggestive mark that will automatically function as a trademark indicating a single source. If the Examiner has doubt as to whether the mark is merely descriptive or suggestive based on Applicant's above arguments and evidence, the Trademark Board takes the position that such doubt is to be resolved in favor of the applicant. *In re Grand Forest Holdings Inc.*, 78 U.S.P.Q.2d 1152, 1156 (TTAB 2006*); In re Conductive Systems, Inc.*, 220 U.S.P.Q. 84, 86 (TTAB 1983); *In re Merril Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d

1567, 1571 (Fed. Cir. 1987). Therefore, Applicant respectfully requests that the Examiner reconsider the refusal to register and allow the Application to proceed on to publication.

II. In The Alternative, Applicant Submits That the Mark Has Acquired Distinctiveness Under Section 2(f).

Without conceding that CLOUD LOGISTICS is descriptive, in the alternative, Applicant contends that the Mark may be registered on the Principal Register based on acquired distinctiveness, as Applicant has used CLOUD LOGISTICS since 2011, and there is clear evidence that the term is both used, and perceived, as a trademark.

Under Section 2(f), the Trademark Office may accept as prima facie evidence that a mark has become distinctive, proof of substantially exclusive and continuous use of the mark in commerce for the five years before the date on which the claim of distinctiveness is made. Applicant has exceeded this threshold showing, by submitting herewith clear evidence of distinctiveness, as discussed below.

Applicant has used CLOUD LOGISTICS on a continuous and substantially exclusive basis since at least as early as 2011. As a result of this extensive use, advertising, and promotion, the Mark has become exclusively associated and recognized with the services offered by Applicant. To this point, Applicant has attached a variety of evidence hereto as Exhibit D which is probative of this acquired distinctiveness, including, as discussed above, a Google search of CLOUD LOGISTICS that shows results exclusively referring to Applicant on the first page.

In light of this evidence, Applicant submits that its long and substantially exclusive use constitutes prima facie evidence that CLOUD LOGISTICS has become distinctive as used in

connection with Applicant's services, and is therefore in condition for publication on the Principal Register. TMEP § 1212.01; *See also In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 1571 (Fed. Cir. 1987) (any doubts with respect to the sufficiency of an acquired distinctiveness showing should be resolved in favor of the applicant).

Conclusion

CLOUD LOGISTICS is used and perceived as a suggestive, source indicating trademark. Alternatively, the CLOUD LOGISTICS trademark has acquired distinctiveness. Accordingly, Applicant respectfully requests that the Application be passed to publication.