

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

<p>In re Application of:</p> <p align="center">Abu AB</p> <p>Serial No.: 88/463,050</p> <p>Filed: June 6, 2019</p> <p>Mark: VIRTUAL</p>	<p>Examining Attorney: Naakwama S. Ankrah Law Office 109</p>
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**APPLICANT'S RESPONSE TO OFFICE ACTION
FOR THE MARK VIRTUAL (ASN 88/463,050)**

I. INTRODUCTION

Applicant, Abu AB, ("Applicant") hereby submits this Response to the Office Action issued on September 3, 2019 against Application Serial No. 88/463,050 (the "Application") to register the mark VIRTUAL (the "Mark") for "fishing rods" in Class 28. The Examining Attorney has refused the Application on the basis that the Mark is merely descriptive of the identified "fishing rods" goods. In addition, the Examiner has requested additional information to clarify the nature of Applicant's proposed fishing rods to be sold in connection with the Mark. Based on the facts and arguments set forth below, Applicant respectfully requests that the Examining Attorney withdraw the refusal and approve the Application for publication.

II. ARGUMENTS AGAINST EXAMINER'S MERELY DESCRIPTIVE FINDING

The Examiner has refused registration of Applicant's VIRTUAL Mark on the basis that the Mark merely describes a feature of Pure Fishing's fishing rods. Applicant respectfully submits that its VIRTUAL Mark is not merely descriptive of its "fishing rods"

and that the Mark is sufficiently distinctive that it is capable of protection on Principal Register of the United States Patent and Trademark Office.

A. Inherently Distinctive Marks are Entitled to Registration on the U.S. Principal Register, Whereas Merely Descriptive Marks are Not.

The distinctiveness of a mark cannot be determined in the abstract, but only by reference to the goods or services upon which the mark is used. *See U.S. Search, LLC v. U.S. Search.com Inc.*, 300 F.3d 517, 524 (4th Cir. 2002). Suggestive marks and arbitrary or fanciful marks are each inherently distinctive. *See Star Industries, Inc. v. Bacardi & Co. Ltd.*, 412 F.3d 373, 385 (2d Cir. 2005). Suggestive marks are those that are not directly descriptive, but do suggest a quality or qualities of the product, through the use of “imagination, thought and perception.” *Id.* Toward the other end of the spectrum of distinctiveness, a mark 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 United States of America*, 675 F.3d 1297, 102 (Fed. Cir. 2012) (quoting *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 (Fed. Cir. 2007)). Overall, a distinctiveness inquiry is product-specific, and a “term that merely describes one product may well be distinctive as to another.” *Borinquen Biscuit Corp. v. M.V. Trading Corp.*, 443 F.3d 112, 119 (1st Cir. 2006).

The Lanham Act precludes registration of a term that is merely descriptive of an applicant’s goods—absent a showing of acquired distinctiveness—whereas inherently distinctive suggestive and arbitrary marks are capable of registration on the U.S. Principal Register. 15 U.S.C. § 1052(e)(1).

B. Applicant's VIRTUAL Mark is Not Descriptive.

Applicant's VIRTUAL Mark is not descriptive of a quality, feature, function, or characteristic of Applicant's "fishing rods." In short, there is nothing about the rod that is "virtual." It does not exist online, on a computer game, or electronically in a networked computer environment. It is a real, tangible fishing rod.

The Trademark Trial and Appeal Board ("TTAB") and Federal Courts evaluate evidence of use and the meaning of a term in order to analyze whether a particular mark is descriptive. These common forms of evidence include: (a) dictionary definitions; (b) uses by the proponent and its competitors; and (c) third-party registrations on the Principal Register that did not require proof of secondary meaning or disclaimers of the term at issue. See *In re Nett Designs, Inc.*, 236 F.3d 1339, 1342 (Fed. Cir. 2001). As detailed below, these factors all weigh in favor of a finding that Applicant's VIRTUAL Mark is not merely descriptive, and that the Mark is inherently distinctive for fishing rods to be sold under the VIRTUAL Mark.

a. The Dictionary Definition for "Virtual" Does Not Support a Finding of Descriptiveness

The dictionary definition for the term "virtual" does not support a finding of descriptiveness in this case. In the Office Action, the Examiner noted that the dictionary defines the word "virtual" as: "being on or simulated on a computer or computer network." *Virtual, Merriam-Webster Dictionary*, <https://www.merriam-webster.com/dictionary/virtual> (last visited on Feb. 28, 2020).

As shown in the attached Exhibits A and B with evidence of the proposed use of Applicant's VIRTUAL Mark, Applicant's fishing rods do not simulate any aspect of fishing via a computer network. The fishing rods at issue function to catch actual fish. To the

extent any aspect of the rod is used in connection with Bluetooth technology, this technology does not simulate or replicate any aspect of fishing, or otherwise provide a “virtual” fishing experience. The incorporation of any separate technology is merely to track the location, size and type of fish in a standalone mobile application. In short, there is no aspect of the fishing rod or associated technology that is artificial or simulated via the use of a computer network or any technology-related device.


In sum, a review of the dictionary definition for the word “virtual” does not support a finding of descriptiveness for Applicant’s proposed use of VIRTUAL in connection with fishing rods.

b. Use of the Term “Virtual” by Applicant and Third-Parties

Applicant is unaware of, and the Examiner has failed to put forth, any evidence that suggests Applicant’s competitors in the outdoors industry use “virtual” in connection with fishing rods or related equipment in a descriptive manner. “Extensive use of a mark by third parties might indicate that the mark is merely descriptive of a given class of products.” *Zobmondo Entertainment, LLC v. Falls Media, LLC*, 602 F.3d 1108, 1118 (9th Cir. 2010). Consistent with the dictionary definition for the word, Applicant notes that the term “virtual” is commonly used to describe an artificial simulation or replication of a setting or experience via the use of computer or digital technology, but, as detailed above and in the attached Exhibits A and B, this is not how Applicant intends to use the Mark. In sum, there is no such evidence of common descriptive use of “virtual” with actual fishing rods or related goods by Applicant or competing third parties, and this also weighs against a finding of descriptiveness for Applicant’s Mark.

c. Third-Party Registrations Incorporating “VIRTUAL” for Related Goods

In addition, third party trademark registrations may in some cases support the argument that a designation is not descriptive. See *In re J.M. Originals Inc.*, 6 USPQ2d 1393 (TTAB 1987). The fact that the USPTO registered a number of marks containing the same designation without requiring proof of secondary meaning provides some evidence that the USPTO considers the designation not descriptive.

Importantly, the USPTO has consistently applied a standard of not requiring the disclaimer of “VIRTUAL” in connection with actual fishing and sporting goods in Class 28, and that standard should be applied here. Specifically, Applicant notes that The Nelson Paint Company owns a registration for VIRTUAL BAIT (Reg. No. 2,791,308) (“BAIT” disclaimed) for “animal attractant scents, namely, a scented liquid used to mask human odor and attract animals for hunting” wherein no disclaimer for “VIRTUAL” was required. Similarly, Anton F. Wilson (individual) owns a registration for VIRTUAL POWDER (Reg. No. 3,306,147) for “snow skis” in Class 28 that did not require a disclaimer. In addition, the USPTO has issued a Notice of Allowance for Virtual Scientific Industries, Inc.’s recent application for V VIRTUAL & Design (i.e.,  VIRTUAL) (App. Ser. No. 87/823,842) in Class 28 for sporting goods, such as baseball bats, basketballs, and racquets without requiring the disclaimer of the “VIRTUAL” element.

Just as the USPTO has found that these three respective marks that incorporate the term “VIRTUAL” are sufficiently distinctive for related goods in Class 28, Examiner should similarly find that Applicant’s proposed VIRTUAL Mark is inherently distinctive for “fishing rods.”

C. Applicant's Mark is, At a Minimum, Suggestive.

Applicant's VIRTUAL Mark is not descriptive, but rather, at a minimum, is suggestive of its "fishing rods." Applicant's VIRTUAL Mark does not immediately and particularly convey, without the need for speculation or conjecture, precisely what the fishing rods goods are or do. Several mental steps are required to make that connection. Consumers must: (1) envision the common use of the term "virtual" (i.e., simulated); then, (2) consider how a tangible, real-world fishing rod could utilize technology; then, (3) consider that the fishing rods at issue have the ability to incorporate technology; and then, (4) envision that the fishing rods can utilize a separate mobile application with Bluetooth capabilities to track the location and size of the fish they've caught. This multistep thought process renders Applicant's Mark at least suggestive, and not merely descriptive.

Moreover, it is not fatal that Applicant's mark may be informational in that its goods relate to or have the capabilities to incorporate technology. One may be informed by suggestion as well as by description. *In re Reynolds Metals Company*, 178 USPQ 296, 297 (CCPA 1973). That is to say, "descriptive" and "suggestive" are not mutually exclusive. A suggestive mark like Applicant's can tell consumers something arguably related to the goods without immediately conveying a characteristic or feature of the product with any degree of certainty. *Id.* Here, the information given by Applicant's Mark is very indirect, and, thus, the Mark is at a minimum suggestive and not merely descriptive. If Applicant were selling a "virtual" fishing rod as an in-app purchase that could be used to catch electronic fish in an online game, then "virtual" would be descriptive for that product, but applicant is not selling a virtual fishing rod. In fact, Applicant's fishing rod is very real.

III. APPLICANT'S RESPONSES TO EXAMINER'S REQUESTS FOR ADDITIONAL INFORMATION

As requested, Applicant provides the following responses to the Examiner's specific requests for additional information regarding the goods to be sold under the Mark.

- a. **Examiner's Request: *Fact sheets, instruction manuals, brochures, advertisements and pertinent screenshots of applicant's website as it relates to the goods and/or services in the application, including any materials using the terms in the applied-for mark.***

Applicant hereby submits mockups of the product packaging for its proposed VIRTUAL-branded fishing rods and a screenshot from its website for the products in the attached Exhibit A. In addition, Applicant submits two third-party publications that describe the features of the proposed VIRTUAL-branded rod in the attached Exhibit B.

- b. **Examiner's Request: *Do applicant's goods include Bluetooth technology?***

Applicant confirms that the fishing rods to be sold under the VIRTUAL Mark have a feature that is compatible with Bluetooth technology. Specifically, the VIRTUAL-branded rods incorporate an ANGLR-branded button on the rod that connects with a third-party ANGLR-branded smartphone application. When the "ANGLR" button is pressed, it transmits information to the ANGLR smartphone app to record the location of waypoints or the location of fish caught by users. The time and location of a catch or location a waypoint is the only information that is transmitted to the ANGLR application, and users may review and supplement this information with additional data via the ANGLR mobile application interface. No features on Applicant's VIRTUAL-branded rods allow users to view electronic data via Bluetooth technology, digital screens, or otherwise in a simulated capacity.

In sum, the rods to be sold under Applicant's VIRTUAL Mark function as straight-forward fishing rods. Users do have the option to use the VIRTUAL rods with ANGLR-branded goods and

services that incorporate Bluetooth technology to digitally track the location of fishing on a separate interface.

c. Examiner's Request: *Do applicant's competitors use VIRTUAL to advertise similar goods?*

To the best of Applicant's knowledge, Applicant's competitors in the fishing and general sporting goods fields do not use the term "virtual" to advertise similar goods, including fishing rods, fishing reels, or other outdoors goods.

IV. CONCLUSION

In light of the above, Applicant respectfully requests that the Examiner withdraw the refusal and approve Application Serial No. 88/463,050 for publication in the *Official Gazette*.

Respectfully submitted,

Abu AB

Dated: March 3, 2020

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