

Argument

In the Office Action dated September 10, 2019, the Examining Attorney (1) refused registration of the mark under Trademark Act Section 2(e)(1) on the grounds that the mark merely describes Applicant's goods and services and (2) required amendment to the goods pursuant to 37 C.F.R. *See* 37 C.F.R. §2.32(a)(6); TMEP §§1402.03(d), 1402.11(a) and (3) reported that a search of the Office records uncovered no registered or pending marks which would bar registration under Trademark Act § 2(d), 15 U.S.C. §1052(d).

1. Amendment to Goods and Services. As required under the current rules of practice, Applicant has amended its goods to specify that its Class 9 software is downloadable, has clarified the term GIF to specify that these are "files," and has adjusted its description of API software as required:

Downloadable computer software for use in selecting, combining and pairing music, songs, audio and sounds with videos, photos, **GIF files**, graphics, images, animations, multimedia files, visual assets, augmented reality files, virtual reality files, holograms, and digital stickers; **Downloadable application programming interface (API)** software for use by others to develop software that allows users to select, combine and pair music, songs, audio and sounds with videos, photos, **GIF files**, graphics, images, animations, multimedia files, visual assets, augmented reality files, virtual reality files, holograms, and digital stickers; **Downloadable** computer software for use in searching for music, songs, audio, sounds, artists, lyrics, videos, photos, **GIF files**, graphics, images, animations, multimedia files, visual assets, augmented reality files, virtual reality files, holograms, and digital stickers; **Downloadable application programming interface (API)** software for use by others to develop software that allows users to search for music, songs, audio, sounds, artists, lyrics, videos, photos, **GIF files**, graphics, images, animations, multimedia files, visual assets, augmented reality files, virtual reality files, holograms, and digital stickers; **Downloadable** computer software for use in downloading, uploading and sharing videos, photos, **GIF files**, graphics, images, animations, multimedia files, visual assets, augmented reality files, virtual reality files, holograms, and digital stickers featuring music, songs, audio or sounds; **Downloadable application programming interface (API)** software for use by others to develop software that allows users to select, download, upload and share videos, photos, **GIF files**, graphics, images, animations, multimedia files, visual assets, augmented reality files, virtual reality files, holograms, and digital stickers featuring music, songs, audio or sounds; **Downloadable** computer software for use in recommending music, songs, audio and sounds to pair with videos, photos, **GIF files**, graphics, images, animations, multimedia files, visual assets, augmented reality files, virtual reality files, holograms, and digital stickers; **Downloadable application programming interface (API)** software for use by others to develop software that recommends music, songs, audio and sounds to pair with videos, photos, **GIF files**, graphics, images, animations, multimedia files, visual assets, augmented reality files, virtual reality files, holograms, and digital stickers; **Downloadable** computer software for editing, shortening, enhancing, and altering files with effects, words, duration and sounds for music, songs, audio, videos, photos, **GIF files**, graphics, images, animations, multimedia files, visual assets,

augmented reality files, virtual reality files, holograms, and digital stickers; **Downloadable application programming interface (API)** software for use by others to develop software for editing, shortening, enhancing, and altering files with effects, words, duration and sounds for music, songs, audio, videos, photos, **GIF files**, graphics, images, animations, multimedia files, visual assets, augmented reality files, virtual reality files, holograms, and digital stickers; **Downloadable** computer software for use in creating and saving combinations of music, songs and audio, with videos, photos, **GIF files**, graphics, images, animations, multimedia files, visual assets, augmented reality files, virtual reality files, holograms, and digital stickers; **Downloadable application programming interface (API)** software for use by others to develop software for creating and saving combinations of music, songs and audio, with videos, photos, **GIF files**, graphics, images, animations, multimedia files, visual assets, augmented reality files, virtual reality files, holograms, and digital stickers; **Downloadable** computer software for use in categorizing, organizing, sorting and reporting music, songs, audio, videos, photos, **GIF files**, graphics, images, animations, multimedia files, visual assets, augmented reality files, virtual reality files, holograms, and digital stickers; **Downloadable application programming interface (API)** software for use by others to develop software for categorizing, organizing, sorting and reporting music, songs, audio, videos, photos, **GIF files**, graphics, images, animations, multimedia files, visual assets, augmented reality files, virtual reality files, holograms, and digital stickers; **Downloadable** computer software for use in creating and running challenges, contests and puzzles, using music, songs, audio, videos, photos, **GIF files**, graphics, images, animations, multimedia files, visual assets, augmented reality files, virtual reality files, holograms, and digital stickers; **Downloadable application programming interface (API)** software for use by others to develop software for creating and running challenges, contests and puzzles, using music, songs, audio, videos, photos, **GIF files**, graphics, images, animations, multimedia files, visual assets, augmented reality files, virtual reality files, holograms, and digital stickers; **Downloadable** computer software for use in analyzing, collecting and reporting data on user searches, selections, and sharing; **Downloadable application programming interface (API)** software for use by others to analyze, collect and report data on user searches, selections, and sharing; Downloadable ring tones, audio, videos, photos, graphics, images and multimedia **audio and video files** provided via a website and wireless devices.

Applicant has also adjusted its recitation of services to clarify that the GIFs are files, and has adopted the amendments to its website searching and sharing features as suggested by the Examining Attorney:

“Providing temporary use of online non-downloadable software for use in selecting, combining and pairing music, songs, audio and sounds with videos, photos, **GIF files**, graphics, images, animations, multimedia files, visual assets, augmented reality files, virtual reality files, holograms, and digital stickers; Providing temporary use of online non-downloadable software for use in searching for music, songs, audio, sounds, artists, lyrics, videos, photos, **GIF files**, graphics, images, animations, multimedia files, visual assets, augmented reality files, virtual reality files, holograms, and digital stickers;

Providing temporary use of online non-downloadable software for use in downloading, uploading and sharing videos, photos, **GIF files**, graphics, images, animations, multimedia files, visual assets, augmented reality files, virtual reality files, holograms, and digital stickers featuring music, songs, audio or sounds; Providing temporary use of online non-downloadable software for use in recommending music, songs, audio and sounds to pair with videos, photos, **GIF files**, graphics, images, animations, multimedia files, visual assets, augmented reality files, virtual reality files, holograms, and digital stickers; Providing temporary use of online non-downloadable software for editing, shortening, enhancing, and altering files with effects, words, duration and sounds for music, songs, audio, videos, photos, **GIF files**, graphics, images, animations, multimedia files, visual assets, augmented reality files, virtual reality files, holograms, and digital stickers; Providing temporary use of online non-downloadable software for use in creating and saving combinations of music, songs and audio, with videos, photos, **GIF files**, graphics, images, animations, multimedia files, visual assets, augmented reality files, virtual reality files, holograms, and digital stickers; Providing temporary use of online non-downloadable software for use in categorizing, organizing, sorting and reporting music, songs, audio, videos, photos, **GIF files**, graphics, images, animations, multimedia files, visual assets, augmented reality files, virtual reality files, holograms, and digital stickers; Providing temporary use of online non-downloadable software for use in creating and running challenges, contests and puzzles, using music, songs, audio, videos, photos, **GIF files**, graphics, images, animations, multimedia files, visual assets, augmented reality files, virtual reality files, holograms, and digital stickers; Providing temporary use of online non-downloadable software for use in analyzing, collecting and reporting data on user searches, selections, and sharing; Providing a website **featuring a search engine** to allow users to search for music, songs, audio, sounds, artists, lyrics, videos, photos, **GIF files**, graphics, images, animations, multimedia files, visual assets, augmented reality files, virtual reality files, holograms, and digital stickers; Providing a website **featuring technology** to allow users to upload, download and share **electronic files in the nature of** music, songs, audio, videos, photos, **GIF files**, graphics, images, animations, multimedia files, visual assets, augmented reality files, virtual reality files, holograms, and digital stickers; Providing and updating a searchable database of licensed and meta-tagged audio, music, or songs.

2. Refusal of Registration Under Trademark Act Section 2(e). The Examining Attorney has refused registration of Applicant's mark, SONGCLIP, on the grounds that the mark merely describes a feature and/or purpose of Applicant's goods and/or services under Trademark Act Section 2(e)(1). In support of the refusal, the Examining Attorney has: (a) provided references to Applicant's website, (b) supplied dictionary definitions for the individual words "song" and "clip," (c) argued that "the term 'SONG' appears in its plural form in applicant's identification of goods and services, and (d) concluded that "applicant's mark SONGCLIP is merely descriptive where applicant's goods and/or services feature a section of[sic] piece of music sung or composed for singing."

As explained herein, Applicant believes its SONGCLIP mark is not merely descriptive for the many robust and varied functions of its software and services which include API development software, its search and recommendation software and services, its sorting, sharing, and special effects software and services, among others. In addition, the multiple possible interpretations of CLIP, in relation to Applicant's mark, means that the mark does not convey an immediate, single idea of an ingredient, quality, characteristic, feature, function, purpose or use of the Applicant's software and services that would meet the test for a merely descriptive mark. Instead, the word CLIP has multiple possible interpretations that requires consumers to stop and consider the mark, the software, or services, and the many possibilities. This mental step and pause for consideration, is indicative of a suggestive mark, not a descriptive one. For these reasons, Applicant believes the mark is registrable on the Principal Register.

Preliminary Observations. It is worth noting at the outset that the Office Action does not reference any dictionary definitions for songclip, and the only references to this term are Applicant's own uses on its website. In the absence of any evidence of a definition of songclip, the Examining Attorney has split the mark into two elements, searched for definitions of the words "song" and "clip," and concluded that, because some of the goods and services in the application contain the word "songs," the mark as a whole is thus descriptive for all of the goods and services.

This conclusion is unwarranted, and the dissection of the mark is inappropriate. The analysis of whether a mark is merely descriptive requires viewing the mark in its entirety and attempting to assess the impression likely to be conveyed to the purchasing public when they are confronted with the mark as a whole. *In re Keebler Co.* (1973, Cust & Pat App) 479 F.2d 1405, 178 USPQ 155. *Equine Technology Inc. v. Equitechnology, Inc.* 68 F.3d 542, 544 (1st Cir. 1995). In addition, when viewed in its entirety, the SONGCLIP mark not only presents a unique term to consumers, but it also requires them to pause, and consider what the CLIP portion of the mark may mean, in relation to the Applicant's software and services.

Multiple Meanings of "Clip" Are Hallmarks of Distinctiveness, not Mere Descriptiveness.

To establish that a mark is *merely* descriptive, the Examining Attorney must show that relevant consumers would *directly* and *immediately* perceive Applicant's mark as describing a significant feature, function, or characteristic of the applied-for goods. The Trademark Manual of Examining Procedure provides that "a designation does not have to be devoid of all meaning in relation to the goods and services to be registrable." On the contrary, when relevant consumers must use "imagination, thought or perception to reach a conclusion as to the nature of those goods or services" a mark is suggestive, and therefore registrable. A mark is considered merely descriptive only if it "*immediately* tells something about the goods or services." TMEP §1209.01(a) (emphasis added).

The SONGCLIP mark is not merely descriptive for Applicant's goods and services because customers must make some mental investment to sift through the many

definitions for, and interpretations of, the word “clip,” as demonstrated by the evidence in the Office Action and as described below. These multiple meanings support the conclusion that the mark is distinctive and not merely descriptive.

In the Office Action, the Examining Attorney has supplied multiple dictionary definitions of the word “clip,” – twenty-four pages of definitions. This means that consumers must consider and sift through a very large number of possible meanings of the word CLIP in order to understand the nature and purpose of the Applicant’s goods and services. An “immediate” understanding of the word CLIP, as required to meet the test for a descriptive mark does not seem likely. For example, some of the definitions listed in the twenty-four pages in the Office Action are:

Clip verb (1)

1. Encompass
2. a. to hold in a tight grip: clutch
- b. to clasp, fasten, or secure with a clip

Clip noun (1)

1. Any of various devices that grip, clasp or hook
2. A device to hold cartridges for charging the magazines of some rifles...
3. Something (such as a piece of jewelry) that is worn as an ornament or fastener...

Clip verb (2)

1. a. To cut or cut off...
2. a. Curtail, diminish...
- b. To abbreviate in speech or writing
3. Hit, punch...
4. To illegally block...
5. To take money from unfairly...
- ...
2. To travel or pass rapidly...
3. To clip an opposing player in football

Clip noun (2)

1. a. Clips plural, Scottish: shears
- b. a 2-bladed instrument for cutting especially the nails
2. something that is clipped such as
- a. : the product of a single shearing (as of sheep)
- b. : a crop of wool of a sheep, a flock, or a region
- c. : a section of filmed, videotaped or recorded material
- d. : a clipping especially from a newspaper
3. An act of clipping
4. a sharp blow
5. RATE sense
- //continues at a brisk *clip*
6. a single instance or occasion

//trained 1000 workers at a *clip*...

See the full list of definitions attached to the Office Action, attached hereto as Exhibit A.

The multiplicity of meanings of the combined words “SONG” and “CLIP” demonstrates that, when considered as a whole, the mark is ambiguous and cannot be considered merely descriptive of the Applicant’s goods and services. As the United States Court of Appeals for the Federal Circuit explained in *In re Hutchinson Technology Incorporated*, 852 F.2d 552, 555 (Fed. Cir. 1988); 7 U.S.P.Q.2D (BNA) 1490, 1492, 1493, a term that has multiple meanings does not convey the sort of *immediate* understanding of the goods necessary to classify a mark as merely descriptive. Marks that cause customers to pause and consider meaning are not marks that meet the test of “mere descriptiveness” and are, instead, considered suggestive.

The Board regularly applies this principle in reversing refusals of registration. For example, in *In re Diet Tabs, Inc.*, 231 U.S.P.Q. 587 (T.T.A.B. 1986), the Board reversed the refusal of registration of DIET-TABS, because the mark could be interpreted to mean *either* “diet tablets” or “dietary tablets,” each of which has a different significance in relation to “vitamin supplement tablets.” In light of the multiple meanings of CLIP that could possibly be attached to Applicant’s software and services, Board would likely apply the same reasoning to the SONGCLIP mark in this case.

To the extent the Examining Attorney finds Applicant’s mark to be within a “gray area” between obviously descriptive marks, on the one hand, and suggestive marks, on the other, any doubts must be resolved in Applicant’s favor. *In re Conductive Systems, Inc.*, 220 U.S.P.Q. 84, 86 (TTAB 1983) (where combination of two merely descriptive terms creates a mark that might be either descriptive or suggestive, doubts are to be resolved in favor of applicants; refusal reversed); *In re Pennwalt Corp.*, 173 U.S.P.Q. 317, 319 (TTAB 1972) (doubts to be resolved in favor of publication; refusal reversed).

Accordingly, Applicant requests that the Examining Attorney withdraw the refusal of registration and approve the application for publication.