

Re: Application Serial No.: 88/208,016
Applicant's Mark: MICRO
Filing Date: November 28, 2018
Applicant: Social Glass, Inc.
Office Action Mailing Date: Sept. 20, 2019
Examining Attorney: Daniel F. Capshaw

RESPONSE TO OFFICE ACTION

The Applicant Social Glass, Inc. ("Applicant") hereby responds to the Office Action mailed on September 20, 2019, in which the Examining Attorney maintains the refusals made in the March 4, 2019 Office Action.

I. Recitation of Services

Applicant has amended its recitation of services to address the Examining Attorney's concerns. Specifically, it amends them to read as follows:

Class 35: On-line retail store services for use by governments for purchasing and procuring a wide variety of goods and services; On-line wholesale and retail store services for use by governments for purchasing and procuring a wide variety of goods and services; Online retail services through direct solicitation by distributors directed to end-users for use by governments for purchasing and procuring a wide variety of goods and services; Online retail services through direct solicitation by salespersons directed to end-users for use by governments for purchasing and procuring a wide variety of goods and services; Computerized on-line retail store services in the field of government or public procurement for purchasing and procuring a wide variety of goods and services; **Providing an on-line computer database in the field of business information and business contacts; Providing an on-line computer database in the field of locating products, describing products, rating products, pricing products and comparing prices of products; Providing an on-line searchable database featuring business information and business contacts; Providing business information, namely, commercial corporate and statistical information provided on-line from a computer database or the Internet**

II. Section 2(e)(1) Merely Descriptive Refusal

The Examining Attorney has refused registration of Applicant's mark MICRO (the "Applicant's Mark") on the grounds that the Mark is descriptive. For the following reasons, Applicant respectfully disagrees that the mark MICRO is descriptive and submits that, in fact, MICRO is suggestive of the underlying services.

Descriptive terms are those which *immediately* and *directly* convey to the consumer the ingredients, qualities or characteristics of the product or service. See Educational Development Corp. v. The Economy Company, 195 U.S.P.Q. 482 (10th Cir. 1977); Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 189 U.S.P.Q. 759, 765 (2d Cir. 1976). A mark must convey the information with a degree of particularity. Plus Products v. Medical Modalities Assocs., 211 U.S.P.Q. 1199, 1204-05 (TTAB 1981). If a multistage reasoning process is required to determine the characteristics of the product or service, then the mark is suggestive. See In re Abcor Development Corp., 588 F.2d 811, 200 U.S.P.Q. 218 (CCPA 1978). It is well established that the burden is on the Examining Attorney to prove descriptiveness. See, e.g., In re Merrill, Lynch, Pierce, Fenner & Smith, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). Doubts are to be resolved in favor of the Applicant. See, e.g., In re Rank Organization, Ltd., 222 U.S.P.Q. 324, 326 (TTAB 1984).

An Examining Attorney should only refuse registration where it can be shown that the mark has a well understood and recognized meaning that is descriptive of the goods and services. See In re Gould Paper Corp., 834 F.2d 1017, 5 U.S.P.Q.2d 1110, 1018 (Fed. Cir. 1987); In re Orleans Wines, Ltd., 196 U.S.P.Q. 516, 517 (T.T.A.B. 1977). In the present case, the mark MICRO, for the applied-for services, does not have such a meaning and therefore should not be refused registration.

Even if the MICRO mark did have some meaning for the applied-for services, which Applicant contends it does not, a mark does not have to be devoid of all meaning in relation to the goods and services to be registrable. See TMEP § 1209.01(a). As background, Applicant is a global e-commerce marketplace that uses artificial intelligence to simplify purchases. The Examining Attorney has attached pages from Applicant’s website showing that the retail services offering by Applicant can include government “micro purchases.” However, simply because an applicant’s services can include a particular function does not mean the mark, overall, is not registrable. The principal register is replete with marks for retail services and marketplaces that may relate to an applicant’s services in some indirect way but have none the less been registered, including:

Mark	IDs
SMALL PARTS (Reg. No. 3872232)	Class 35: online retail stores featuring hardware, tools and other parts and fittings used for research and development in the manufacturing industry
GIANT (Reg. No 1406293)	Class 35: retail supermarket services
SHOP TINY (Reg. No. 5192339)	Class 35: on-line retail store services featuring a wide variety of consumer goods of others, among other things
LITTLE LOTS (Reg No. 3339840)	Class 35: retail store services and online retail store services featuring general merchandise and salvage merchandise
BIG (Reg. No. 3191120)	Class 35: retail store services featuring alcoholic beverages and accessories used in the storage and consumption of alcoholic beverages

Allowing these marks to register while rejecting the present application is an inconsistent application of the law and does not lead to clarity among applicants. The examples shown above have as much, if not more, “meaning” in connection with their respective retail services as Applicant’s mark has in connection with its applied-for service. If these marks can register, so can Applicant’s mark.

Evidence of the public's understanding of a term can be obtained from dictionary definitions. See TMEP § 1209.01(a). Here, the Examining Attorney has not attached any dictionary evidence that the public understands the term MICRO to refer to Applicant's services. In fact, the Merriam-Webster.com entry for "MICRO" lists multiple meanings, none of which come close to suggesting Applicant's on-line retail services. The top results for MICRO are "very small" and "involving minute quantities or variations." The Examining Attorney has denied the Applicant registration, yet there is simply nothing in Applicant's claims which suggest that the services rendered by Applicant involve anything small. In fact, Applicant's recitations make clear that Applicant's services include "purchasing and procuring a **wide variety** of goods and services," indicating that Applicant's services offer broad options for buying and selling, and are not specific of, or limited to, the "micro purchases" that the Examining Attorney cites.

Even if a consumer were to consider "MICRO" in the context cited by the Examining Attorney, given that there are many micro-type purchases, e.g., penny stocks, dollar-store purchases, a consumer would not understand initially which MICRO-purchase was being presented. Furthermore, even if the definition offered by the Examining Attorney is a well-understood meaning, which Applicant believes not to be the case, the Trademark Office has not met its burden to show that Applicant's mark is merely descriptive of its services. Applicant's applied-for services are broader than simply any type of purchases and include "Providing an on-line **computer database in the field of business information** and business contacts; Providing an on-line **computer database in the field of locating products**, Providing an on-line **searchable database featuring business information and business contacts**; Providing business information, namely, **commercial corporate and statistical information** provided on-line from a

computer database or the Internet.” The Examining Attorney has not addressed these other claims that do not imply a purchase.

Because the mark MICRO is suggestive rather than merely descriptive, Applicant respectfully requests that the refusal be withdrawn.

III. Conclusion

For the foregoing reasons, Applicant respectfully submits that the Application should proceed to publication.

WILSON SONSINI GOODRICH & ROSATI
Professional Corporation

Susanna P. Lichter