

## TEXT OF ARGUMENT

### Response to Office Action dated October 16, 2019 re: App. Serial No. 88527335 for WORKBOOK

#### ***Section 2(e)(1) Refusal – Merely Descriptive***

The Examining Attorney bases her refusal of registration of the Applicant's mark on the following syllogism: (1) the term "workbook" merely describes Applicant's goods/services; (2) Applicant's mark WORKBOOK would be understood by relevant consumers to have the same meaning as a "workbook containing spreadsheets" and, therefore, (3) Applicant's mark immediately conveys the nature of Applicant's goods/services and is merely descriptive of them. With all due respect to the Examining Attorney, as explained in further detail below, there are flaws in this analysis, and the multiple layers of reasoning required to carry the argument from beginning to end are characteristic of a suggestive, not a descriptive, mark.

It is worth emphasizing at the outset that the Examining Attorney has presented no evidence that the Applicant's mark is used to describe Applicant's goods and services. In determining whether a word has a descriptive or suggestive significance as applied to merchandise, it is proper to take notice of the extent to which it has been used by others on such merchandise. Where others in the industry do not use the term as a descriptive reference to "***computer software for project management, accounting and financial management, customer relationship management, resource management, and preparing financial and managerial reports***", this is evidence that the term is neither a natural nor obvious way to describe the goods. *Firestone Tire & Rubber Co. v. Goodyear Tire & Rubber Co.*, 186 U.S.P.Q. 557 (T.T.A.B. 1975), *aff'd*, 189 U.S.P.Q. 348 (C.C.P.A. 1976).

None of the articles selected from the Examining Attorney's research use either the Applicant's mark, or the two-word phrase WORK BOOK to refer to or to describe goods and services ***comparable to the Applicant's***. Accordingly, this research demonstrates that Applicant's mark is "neither a natural nor obvious way" to describe Applicant's goods and services.

The determination of whether a mark is merely descriptive must be made not in the abstract but, rather, in relation to the goods and services for which registration is sought. A careful analysis of both Applicant's goods/services and the evidence showing use of "workbook" undermines the first prong of the Examining Attorney's analysis: the term "workbook" does not merely describe Applicant's goods.

The phrase "workbook" is an ambiguous moniker that cannot provide real information about the functions, features or characteristics of specific software products. Instead, the phrase appears to have been coined to distinguish products that operate as a feature of computer software from an earlier generation of products referring to a computer document that contains multiple associated spreadsheets (as defined by *Merriam-Webster Dictionary* and also included as part of the Examining Attorney's official letter). The term "workbook" cannot inform customers whether the data is a streamlined agency management software for the purpose of project management accounting and financial management, customer relationship management, resource management, and preparing financial and managerial reports".

Furthermore, the phrase never *was* technically correct: a computer document that contains multiple associated spreadsheets does not have the ability in and of itself to perform complex functions for project, financial and resource management, such as synchronizing users' information and schedules, providing a multi-language interface, integrating with other software systems, providing training and user support, to name only a few; feats that no simple computer document containing multiple associated spreadsheets could perform.

Thus, even if the Examining Attorney were correct that the Applicant's mark would instantly be interpreted by relevant consumers to mean a "workbook", that phrase itself is not sufficiently direct or informative to meet the Office's test for a mark to be deemed merely descriptive. To be deemed merely descriptive, a mark must directly provide the consumer with *reasonably accurate knowledge of the characteristics of the product or service* in connection with which it is used. If the information about the product or service is *indirect or vague*, then the mark is considered suggestive, not descriptive. See J. McCarthy, McCarthy on Trademarks and Unfair Competition § 11.19, at 11-26 (4<sup>th</sup> ed. 1998); Trademark Manual of Examining Procedure § 1209.01(a) ("a suggestive term differs from a descriptive term, which immediately tells something about the goods or services").

As the Examining Attorney is aware, a mark consisting of two or more descriptive words may be suggestive or fanciful and therefore registrable. *E.g., In re Colonial Stores, Inc.*, 394 F.2d 549, 552-53, 157 U.S.P.Q., 382, 385 (C.C.P.A. 1968) (SUGAR & SPICE as a whole not merely descriptive for bakery products); *W.G. Reardon Laboratories, Inc., v B. & B. Exterminators, Inc.*, 71 F.2d 515, 517, 22 U.S.P.Q. 22, 24 (4<sup>th</sup> Cir. 1934) (MOUSE SEED as a whole not descriptive for poisonous pellets used to kill mice). In fact, "a mark that connotes two meanings – one possible descriptive, and the other suggestive of some other association – can be called suggestive, as the mark is not 'merely' descriptive." See J. McCarthy on Trademarks and Unfair Competition § 11.19, at 11-28 (4<sup>th</sup> ed. 2001). *E.g., Blisscraft of Hollywood v. United Plastics Co.*, 294 F.2d 694, 131 U.S.P.Q. 55, 60 (2<sup>nd</sup> Cir. 1961) (POLY PITCHER not merely descriptive because it connotes both a polyethylene pitcher and is suggestive of MOLLY PITCHER of Revolutionary time).

In summary, Applicant's mark does not *immediately* convey information about the nature of the goods. WORKBOOK is in fact *suggestive* of the Applicant's goods/services because "imagination, thought, or perception is required to reach a conclusion on the nature of the goods or services." *In re Quik-Print Shops, Inc.*, 616 F.2d 523, 525, 205 U.S.P.Q. 505, 507 (C.C.P.A. 1980). Accordingly, the refusal to register the mark based on §2(e)(1) of the Trademark Act should be withdrawn.

### ***Advisory – Possibly Generic.***

The Applicant respectfully disagrees the applied-for mark may be generic for the reasons set forth above.

### ***Request for Information***

The Examining Attorney has requested information, which is provided below:

- (1) 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. Merely stating that information about the goods and/or services is available on applicant's website is insufficient to make the information of record.;

RESPONSE: Please see the Exhibits attached hereto and made a part hereof by reference.

- (2) If these materials are unavailable, applicant should submit similar documentation for goods and services of the same type, explaining how its own product or services will differ. If the goods and/or services feature new technology and information regarding competing goods and/or services is not available, applicant must provide a detailed factual description of the goods and/or services. Factual information about the goods must make clear how they operate, salient features, and prospective customers and channels of trade. For services, the factual information must make clear what the services are and how they are rendered, salient features, and prospective customers and channels of trade. Conclusory statements will not satisfy this requirement.; and

RESPONSE: Not applicable, as material requested in Question #1 was available and provided as requested as Exhibits to this Response.

(3) Applicant must respond to the following questions:

- a. Do applicant's goods contain or applicant services include online/virtual worksheets, spreadsheets, or workbooks?

RESPONSE: Yes, these are included within the computer software for project management, accounting and financial management, customer relationship management, resource management, and preparing financial and managerial reports.

- b. Do applicant's competitors use online workbooks to advertise similar goods or services?

RESPONSE: To Applicant's knowledge, its competitors do not use the term workbook to advertise computer software for project management, accounting and financial management, customer relationship management, resource management, and preparing financial and managerial reports.