

RESPONSE TO OFFICE ACTION

To Commissioner for Trademarks:

Mark: CRYPTOKIT

Serial No.: 88781935

RESPONSE TO OFFICE ACTION

In response to the Office Action, please consider the follow arguments supporting acceptance of the statement of use and registration of the applied-for mark:

BACKGROUND

Applicant's pending application for CRYPTOKIT covers the following goods and services

- Class 9: downloadable computer software used in developing other software; downloadable application development software (Applicant's Goods).

The Examiner issued an Office Action on March 24, 2020, refusing registration on the basis of Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1), for descriptiveness, stating that: "Registration is refused because the applied-for mark merely describes a feature of applicant's development software."

Applicant respectfully disagrees with the Examiner's conclusions and requests that the Examiner reconsider the refusal. Applicant submits that the term CRYPTOKIT is suggestive and not merely descriptive.

STANDARD OF REVIEW

A mark is considered merely descriptive if it **immediately** conveys knowledge of a quality, feature, function, or characteristic of an applicant's goods or services. *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 963-64, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007).

Suggestive marks, on the other hand, are those that require imagination, thought, or perception to reach a conclusion as to the nature of the applied-for goods or services. TMEP 1201.09(a). See *In re George Weston Ltd.*, 228 USPQ 57 (TTAB 1985) (SPEEDI BAKE for frozen dough found to fall within the category of suggestive marks because it only vaguely suggests a desirable characteristic of frozen dough, namely, that it quickly and easily may be baked into bread); *In re The Noble Co.*, 225 USPQ 749 (TTAB 1985) (NOBURST for liquid antifreeze and rust inhibitor for hot-water-heating systems found to suggest a desired result of using the product rather than immediately informing the purchasing public of a characteristic, feature, function, or attribute); *In re Pennwalt Corp.*, 173 USPQ 317 (TTAB 1972) (DRI-FOOT held suggestive of anti-perspirant deodorant for feet in part because, in the singular, it is not the usual or normal manner in which the purpose of an anti-perspirant and deodorant for the feet would be described). Thus, a mark that suggests a number of things, but falls short of describing the goods and services with any "degree of particularity," is not merely descriptive. See *In re TMS Corporation of Americas*, 200 USPQ 57, 59 (TTAB 1978) (holding THE MONEY SERVICE not merely descriptive of financial services).

The Examining Attorney has the burden of proving that Applicant's mark is merely descriptive of the services. TMEP § 1209.02.

ARGUMENTS

CRYPTOKIT Is Suggestive, and Not Merely Descriptive for the identified Services Under TMEP 1209

Applicant submits that the Examiner has not met its burden of proving that the CRYPTOKIT mark as a whole is merely descriptive. Rather, Applicant's mark CRYPTOKIT is suggestive of Applicant's goods and services because the meaning of the term is indefinite and imprecise, requiring consumers to use imagination to connect the mark with the nature of the Applicant's applied-for goods.

First, "CRYPTO" is not only, or even primarily, used as a common abbreviation for "cryptology" as implied by the Examiner. Rather CRYPTO is most prominently defined in its noun form as a person who secretly belongs to a particular sect or ideology, and is also as an abbreviation for cryptocurrency or finally as an abbreviation for cryptography. In its adjectival form, "crypto" means "secret or hidden" (See **Exhibit 1**: <https://www.dictionary.com/browse/crypto?s=t>). Three of those definitions do not *merely* describe or even suggest the Applicant's software development goods, and so already CRYPTOKIT cannot be said to be immediately descriptive of the applied-for goods because consumers will mostly likely think of one of those other definitions when they see the mark.

Second, even if a consumer somehow *immediately* sorts through those four possible definitions and lands on "cryptology", it still requires a mental leap to reach the association with the encryption/decryption features of the software because the primary function of the applied-for software is to build software, not to encrypt it, and thus the requirement of particularity is not met. Indeed, Apple's CRYPTOKIT software is for the purpose of creating other software and gives developers software tools and coding for integrating functions into their own software *besides* encryption and decryption, such as authentication and functionality for key creation. Thus, encryption/decryption is not a feature, or the only function, of the software. Therefore, even if it were accurate to say that CRYPTO would immediately be seen as an abbreviation for encryption/decryption (which Applicant contests), CRYPTO still would not be descriptive for the software as a whole because the features of the software go beyond encryption/decryption alone; and neither immediacy nor particularity is present in this case.

Third, the term "KIT" has multiple meanings, and only one of them is an abbreviation for the phrase "software development kit." Indeed, the well-reputed Merriam-Webster dictionary lists 5 meanings for the term "kit," none of which are related to software development kits. (See **Exhibit 2**: [https://www.merriam-webster.com/dictionary/kit#:~:text=\(Entry%20of%20\),or%20implements%20a%20carpenter's%20kit](https://www.merriam-webster.com/dictionary/kit#:~:text=(Entry%20of%20),or%20implements%20a%20carpenter's%20kit)). As shown by the Examiner's own evidence, "Software development kits" are abbreviated "SDK," and software developers are used to them being abbreviated as such. Thus, relevant consumers would have to think about what "kit" means in this context, because the usual term for software development software is a completely different term. Indeed, the use of the term "kit" as combined with CRYPTOKIT is unique to Apple and adds a suggestive and not *merely* descriptive element to the mark, bringing it closer to the fanciful end of the trademark spectrum, and therefore more distinctive. See **Exhibit 3** showing third party use of SDK and not KIT alone for software development kits, including:

- <https://www.ionos.com/digitalguide/websites/web-developent/software-development-kit/>
- <https://www.microsoft.com/en-US/Download/confirmation.aspx?id=31950>
- <https://www.skyhook.com/blog/what-is-an-sdk-and-an-api>

Based on the foregoing, Applicant submits that CRYPTOKIT is indefinite and imprecise, requiring consumers to use imagination to connect the mark with the nature of the Applicant's applied-for goods, making it a suggestive and unitary term that is not merely descriptive, but instead is an inherently distinctive mark associated with Apple's use.

This is the position of the USPTO, as Applicant also submits that the USPTO has accepted over 25 other *KIT formative marks owned by Apple alone on the Principal Register without a 2f claim. For example, Applicant has registered CLOCKKIT (Reg. No. 6008117), MUSICKIT (Reg. No. 5369497), CLASSKIT (Reg. No. 6053970), CAREKIT (Reg. No. 5355754), and REPLAYKIT (Reg. No. 6008115) for similar software applications – all without a descriptiveness refusal. **See Exhibit 4.** Accordingly, there is no reason to find KIT merely descriptive in this context.

Improper Division of Combined Terms Under TMEP 1209.03(d)

Additionally, Applicant submits that CRYPTOKIT is a unitary and singular mark that has a new and unique commercial impression. Where the combination of terms creates a unitary mark with a unique, nondescriptive meaning, or if the composite has a bizarre or incongruous meaning as applied to the goods, the overall term should be inherently registrable. See *In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (C.C.P.A. 1968) (SUGAR & SPICE held not merely descriptive of bakery products); *In re Shutts*, 217 USPQ 363 (TTAB 1983) (SNO-RAKE held not merely descriptive of a snow removal hand tool).

There are a number of words that start with the prefix "CRYPTO-" meaning "hidden" (See **Exhibit 5:** <https://www.thefreedictionary.com/words-that-start-with-crypto>). Because CRYPTO is such a common prefix, consumers are likely to perceive the combination of the two terms as a unique word. Consumers are familiar with words like cryptocurrency, cryptogram, and cryptonym. CRYPTOKIT therefore sounds and looks just like another ordinary English word, when in fact it is a unique compression of a common prefix (CRYPTO) and a unique second term - KIT. In this way, the mark is similar to SNO-RAKE. Even if the two terms CRYPTO and KIT were merely descriptive (which applicant contests), the two combined create a new and unique commercial impression. Thus, Apple's combination and transmutation of the prefix CRYPTO + the word KIT into CRYPTOKIT creates a unique and distinctive term that is at most suggestive of a software development tool for various authentication and encryption-related operations.

Applicant's other KIT formative marks Have been Registered

Applicant again reminds the Examiner that the USPTO has approved over 25 of Applicant's KIT marks covering the same or similar goods and/or services without a descriptiveness refusal. (See **Exhibit 4.**) Consistent with the USPTO's examination of those marks, Applicant respectfully requests that the Examiner withdraw the descriptiveness refusal here and allow CRYPTOKIT to register on the Principal Register as well.

USPTO Policy Calls for Publication of the Application

In view of the above arguments, Applicant believes that the proposed mark is not *merely* descriptive and is therefore entitled to registration on the Principal Register. The Examining Attorney is

respectfully reminded that because of the thin line between suggestive and descriptive marks it is the practice of the Trademark Trial and Appeal Board to resolve doubt in Applicant's favor and approved for registration. See, *In re Morton-Norwich Products, Inc.*, 209 USPQ 791 (TTAB 1981); and, *In re Grand Metropolitan Foodservice Inc.*, 30 USPQ2d 1974, 1976 (TTAB 1994). The Examiner has not provided sufficient evidence that the public would consider the composite mark, CRYPTOKIT, *merely* descriptive, and the Applicant has provided evidence showing that it should be considered *suggestive*.

Conclusion

For the foregoing reasons, Applicant requests that the Examiner withdraw the current 2(e)(1) descriptiveness refusal and approve CRYPTOKIT for publication and registration.

Dated: September 24, 2020

Respectfully submitted,

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