

**UNITED STATES DEPARTMENT OF COMMERCE PATENT AND TRADEMARK
OFFICE**

In Re the Application of:

Applicant: Offline Ventures, LLC

Mark: **OFFLINE**

Serial No. 88786599

Filed: February 5, 2020

Cl. 36: Venture capital financing; venture capital services, namely, providing financing to emerging and start-up companies; Incubation services, namely, providing financing to freelancers, start-ups, existing businesses and non-profits; venture capital investment consultation and investment management services

Trademark Law Office 106
Examining Attorney:
Martha L. Fromm

OFFICE ACTION RESPONSE

Applicant, Offline Ventures, LLC (“Offline”) has filed for the mark OFFLINE in connection with “Venture capital financing; venture capital services, namely, providing financing to emerging and start-up companies; Incubation services, namely, providing financing to freelancers, start-ups, existing businesses and non-profits; venture capital investment consultation and investment management services” in International Class 36 (hereinafter “Applicant’s Mark”).

In the office action issued May 1, 2020, the Examining Attorney refused registration of Applicant’s Mark on the Principal Register under Section 2(e)(1). Applicant respectfully traverses the Examiner’s refusal. Applicant’s Mark is a suggestive, not descriptive term. The term “offline” is not a term of art within the field of venture capital and it is sufficiently ambiguous such that consumers, without more, would not immediately understand the meaning of the term in the context of Applicant’s applied-for services.

As discussed in detail below, consumers would understand Applicant’s Mark as suggestive of being authentic, back to one’s own self, and living in “real life” as opposed to living a digital online life and the stressors and falsity that can come with being constantly connected. Because of the nature of venture capital services, how investments are made, the type of businesses that comprise venture capital portfolio companies, the types of returns that are expected of those portfolio companies, and how those portfolio companies are supported,

consumers would not understand or assume that OFFLINE means that Applicant's VC firm operates "offline" or that it is investing in brick and mortar companies.

1. Applicant's Mark is Suggestive and Sufficiently Distinctive for Registration on the Principal Register.

As stated in the Trademark Manual of Examining Procedure (TMEP), a designation does not have to be devoid of all meaning in relation to the goods/services to be registrable. TMEP § 1209.01(a). In fact, it is acknowledged that "there must be some description in almost any suggestion or the suggestion process will not take place." J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, West Group 2000, §11.64; Q-Tips, Inc. v. Johnson & Johnson, 98 U.S.P.Q. 86, 88 (TTAB 1953).

It is for this reason that the Trademark Trial and Appeal Board ("Board") focuses on whether terms in fact given an "*immediate*" idea of an ingredient, quality, characteristic, function, or feature" of the services. For example, in the case of J.S. Paluch Co. v. Irwin, 215 U.S.P.Q. 533 (T.T.A.B. 1982) the Board reviewed the mark LOGOS DESIGN for religious bulletins and custom printing of religious literature. Although the Board acknowledged that the term "Logos" has a specific meaning in the religious field as referring to the "Word" or "Word of God," the Board did not agree that the mark, when applied to the goods and services, had a "particular, immediately recognizable, descriptive significance." Id. at 536. Indeed, to reach any conclusion as to the possible significance of the designation LOGOS DESIGN, one must "use thought, imagination, and mental gymnastics." Id.

Similarly here, the Examining Attorney has stated that the term "offline" refers to "in-person" or "brick and mortar" services and that the term is therefore descriptive because it is likely that Applicant's services are provided "offline" and/or are offered to "offline businesses." The very fact that the Examiner has proposed two alternative meanings show that the term "offline" for venture capital services is indeed ambiguous and does not, and cannot, have a "particular, immediately recognizable, descriptive significance."

As evidence for the refusal, the Examiner has provided a printout from a 2018 blog entry by a Mr. David Bishop of Wealthy Affiliate, that states "offline business is conducted off of the internet" but then goes on to say that many "offline businesses" do in fact have a hybrid model of having a physical local presence with an online presence and encourages "offline" businesses to have an online presence. Similarly, the Examiner has provided a blog printout from WAHM.COM, which is the online magazine for work-at-home moms, and which describes "key differences

between an offline and online small business,” among them being that “offline businesses generally target a specific locality.” The Examiner has also provided an article from Ondeck.com, which describes seven businesses types that thrive offline, namely: radio, the jewelry business, real estate (meaning buying a home), pop-up retail stores, fitness, personal training and weight loss coaching, bookstores and food service.

None of these articles actually show that the term “offline” would, when read in context of Applicant’s venture capital services, be understood as meaning that Applicant offers its services in an offline manner (especially not in comparison to the “offline” businesses detailed by Ondeck.com) or that venture capital firms invest in offline businesses.

Mr. Bishop’s and the WAHM.COM articles are just general articles about businesses that do not have an online marketing presence and should have one while OnDeck.com lists seven types of businesses that bloom offline, but does not include VC firms. If Applicant’s Mark were “offline marketing” for marketing services then it would be descriptive. However, as the Board has previously stated, “the question of whether a particular term is merely descriptive within the meaning of Section 2(e)(1) of the Act must be determined not in the abstract but in relation to the goods or services for which registration is sought, the context in which it is used, and the significance it is likely to have to the average purchaser as he encounters the goods or services in the marketplace.” In re Tennis in the Round Inc., 199 USPQ 496, 498 (TTAB 1978).

Consumers viewing the term “offline” for venture capital services would not assume that Applicant provides its services “offline” or that Applicant would be investing in “offline” business without an internet presence because the venture capital model, by its very nature, is not localized and involves the investment of significant amounts of money into startups that will grow, scale, and provide a large return on investments. (See **Exhibit A**, which defines venture capital and discusses investments by VC firms in companies with high-growth potential.)

It is simply not possible to have the type of growth required for venture capital investments without having a digital presence, on both ends. Venture capital firms are not localized businesses that only serve their local neighborhood in the manner of a local coffee shop or convenience store. VC firms have an online presence and look for potential investments either within the US or globally. Likewise, the targeted companies are those that have high growth potential or have demonstrated high growth. If we go back to Mr. Bishop’s article, he would say that a company simply cannot grow without an online presence, and we agree. In fact, his entire article is to encourage “offline” businesses to have an online digital presence.

If we go back to the original dictionary definition of “offline” provided by Examining Attorney, we can see that “offline” is defined as “not controlled by or directly connected to a

computer or external network.” As shown in the articles attached here as **Exhibit B**, the term “offline” has a lifestyle significance in that it is used and understood as a counter to the state of being “plugged-in.”

To be “offline” is to experience the real-world without being connected to any influence besides the tangible, physical world that a person is actually living in. Offline also means authenticity, as it means not being curated by a written online narrative, a highlights reel of pictures, or filters. The term “offline” is therefore suggestive of real-life connections, focus, and not being controlled by technology, e-mail, social media and the slew of pings, notifications and constant updates that all vie for attention and demand an immediate response.

Living life “offline” can mean many different things to different people, be it returning to nature, connecting with family and friends in your physical surroundings, or even just taking a mental break from the constant urgency of technology. It is this concept of “offline,” and the authenticity and freedom that the term suggests, that is behind Applicant’s selection of its mark. Consumers, when viewing Applicant’s Mark in context of the applied-for services, will understand that Applicant has something to do with an “offline” life but will not, without more, have an “immediate” understanding of what the term means. Instead, consumers will appreciate the term for what it is: the name of Applicant’s VC firm.

2. Request for Information

In response to the Examining Attorney’s request for information, Applicant respectfully responds as follows:

(1) Are the applicant’s services provided, in whole or in part, offline?

As with all venture capital businesses, Applicant works together with limited partners to create a fund, search for potential investment opportunities, and provide funding to startups businesses. Applicant’s services, by their nature, are not localized, do require the use of technology, and also require that Applicant be connected to others and to the network. Applicant’s VC firm is simply not an “offline business” of the type contemplated by Mr. Bishop or WAHM.COM.

(2) Are the applicant’s services directed towards, in whole or in part, offline businesses?

Applicant intends on focusing on IT and health care related startups, none of which would be “offline” businesses that are devoid of an internet presence.

(3) If the answer to questions (1) and (2) above is “no”, then what is the significance of the term “OFFLINE” comprising the proposed mark?

Applicant has selected the term OFFLINE because it is suggestive of living a true and authentic self in real life. Applicant hopes to invest in worthwhile businesses that will help support and improve real life. This can include businesses from any sector, including general consumer brands to healthcare, education, real estate, childcare and many more. This can also include digital networks and communities, physical products and new forms of science and technology.

3. Conclusion

As detailed above, the term OFFLINE, when applied to Applicant’s services, does not have a “particular, immediately recognizable, descriptive significance.” Instead, it is suggestive of the real-world (however a person may define that) and authenticity (being free of the artificial façade of the digital world). Applicant’s Mark meets that hallmark test of suggestive marks, in that it requires “imagination, thought, or perception to reach a conclusion as to the nature of those goods or services.” TMEP §1209.01(a).

The Board has previously stated that in situations involving the descriptiveness of a term, any doubt in the matter should be resolved in the applicant’s behalf, and the mark should be published for opposition. See *In re J. Ray McDermott & Co., Inc.*, Serial No. 314,105, 170 U.S.P.Q. 524, (T.T.A.B. 1971) (“We have carefully considered the arguments of both applicant and the examiner; but we are not completely persuaded by either one. In situations such as this involving the question of the descriptiveness of a term, we believe that any doubt in this matter should be resolved in applicant’s behalf, and the mark be published for opposition purposes in accordance with Section 12(a) of the statute.”)

For these reasons, Applicant respectfully requests that the Examining Attorney withdraw the refusal and approve this application for publication.