

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK EXAMINING DIVISION**

APPLICANT:	Snap Inc.	)
		)
TRADEMARK:	SNAP	) Regina C. Hines
		) Trademark Examining Attorney
SERIAL NO.:	87/983,411	) Law Office 114
		)
CLASS:	42	)

**RESPONSE TO OFFICE ACTION**

Applicant Snap Inc. (“Snap”), by and through counsel, responds to the Office Action issued on October 20, 2020 (the “Office Action”).

**I. INTRODUCTION**

In the Office Action, the Examining Attorney contends the mark on the specimen submitted on August 18, 2020 (the “Specimen”) disagrees with the mark on the drawing because the Specimen displays the SNAP mark with the non-distinctive term “PUBLISHER”. For the reasons set forth below, Snap respectfully submits that the Specimen shows the SNAP mark in use in connection with the applied-for services.

**II. ARGUMENT**

Snap respectfully disagrees with the Examiner’s position that the trademark depicted on the Specimen does not support the applied-for SNAP mark because inclusion of the term PUBLISHER does not alter the SNAP mark’s commercial impression and serves no source-identifying function.

**A. The Specimen Is Acceptable Because a Distinct Commercial Impression Attaches to SNAP *per se*.**

The applied-for mark is SNAP and the Specimen shows SNAP alongside the non-distinctive term “publisher” which refers to the variety of Snap’s services, including the ability

for users to “publish” videos. As the Specimen shows, “publisher” is used in connection with other descriptive terms like “choose”, “customize”, and “publish”—all of which describe steps in Snap’s offerings related to content managing and sharing in Class 42. Use alongside these other descriptive terms reinforces the lack of source-identifying significance of “publisher” in this context. Because SNAP is the dominant element that conveys the commercial impression, and because that commercial impression is not materially altered by the presence of the “publisher” term, the mark as depicted in the Specimen agrees with that on the drawing and the Specimen should be accepted.

**1. *The SNAP Mark is Not Mutilated Because SNAP Conveys the Dominant Commercial Impression—Separate and Distinct from “Publisher.”***

Although the Office Action does not explicitly state so, the Examiner’s argument is essentially one of trademark mutilation: “When the representation on a drawing does not constitute a complete mark, it is sometimes referred to as ‘mutilation’ of the mark. This term indicates that essential and integral subject matter is missing from the drawing.” TMEP § 807.12(d). Snap respectfully disagrees with the Examiner’s assertion because essential and integral subject matter is not missing from the drawing; instead, the mark on the drawing is a substantially exact representation of the mark as used on the Specimen albeit with an additional non-distinctive term, in accordance with 37 C.F.R. § 2.51(b) and TMEP § 807.12:

The question of whether an applicant has “mutilated” its trademark and attempted to register only a part is usually resolved by the “separate commercial impression test:” does the designation sought for registration create a commercial impression separate and apart from other material appearing with it?

3 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 19:59 (4<sup>th</sup> ed. 2013) (hereinafter “MCCARTHY”). Moreover, “an applicant has some latitude in selecting the mark it wants to register. **The mere fact that two or more elements form a composite mark does not**

necessarily mean that those elements are inseparable for registration purposes. An applicant may apply to register any element of a composite mark if that element presents, or will present, a separate and distinct commercial impression apart from any other matter with which the mark is or will be used on the specimen.” TMEP § 807.12(d).


*In re Miami University* is instructive. 123 U.S.P.Q.2d 1075, 2017 WL 3485664 at \*2 (T.T.A.B. 2017). In that case, the University of Miami sought registration of its mascot, Sebastian the Ibis, as shown on the left, with the specimen shown on the right:





The Trademark Examining Attorney refused registration on the ground that the University of Miami’s specimen did not show use in commerce of the mark depicted in the drawing. *Id.* at \*1. In reversing the Examining Attorney’s refusal to register, the Trademark Trial & Appeal Board (the “Board”) found that the design of the ibis created a “separate and distinct commercial impression” from letters and wording such as “U” and “MIAMI” as depicted on the specimens because “the overall display on the specimens creates the commercial impression of the [applied-for] personified ibis.” *Id.* at \*4. With respect to other graphical amendments, such as the absence of stripes on the ibis’ sweater in the drawing depicted on the specimen, the Board concluded this to be a “minor alteration that does not create a new and different mark with a different commercial impression from the matter show in the specimens.” *Id.*

In reaching this decision the Board reviewed other cases where the presence of additional wording in the specimen was held not to create a different commercial impression from the applied-for mark. *Id.* at \*3. A few of these examples are below.

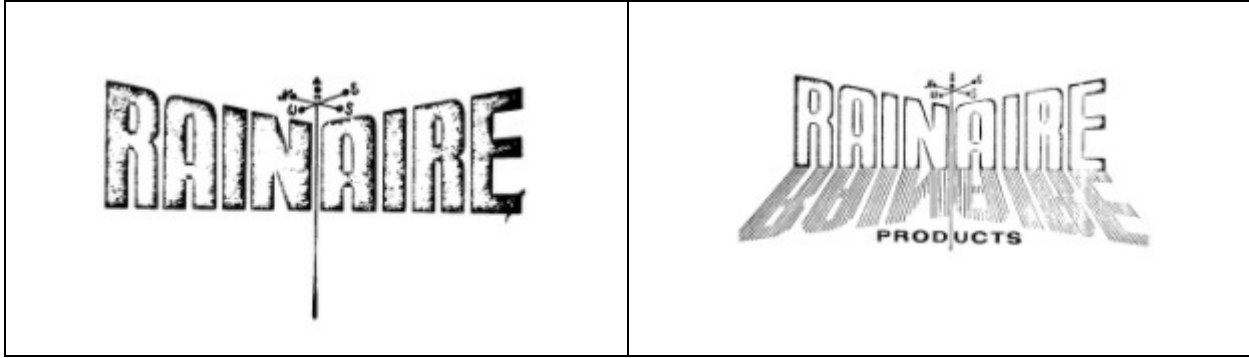


- Specimen showing  supported registration of PSYCHO, *In re Big Pig Inc.*, 81 U.S.P.Q.2d 1436 (T.T.A.B. 2006) (holding word PSYCHO registrable apart from accompanying words and designs in specimen);



- Specimen showing  supported registration of , *In re Sterno, Inc.*, 137 U.S.P.Q. 328 (T.T.A.B. 1963) (finding subject matter of application creates a commercial impression separate and apart from applicant's word mark STERNO and other matter appearing on label in specimen).

*In re Schecter Brothers Modular Corporation* is also instructive. 182 U.S.P.Q. 694, 1974 WL 19961 (T.T.A.B. 1974). In that case, applicant Schecter Brothers sought to register the mark RAINAIRE as shown on the left, with the specimen shown on the right:



The Trademark Examining Attorney refused registration on the ground that separating “the shadow image of the word portion . . . creates a separate commercial impression than as actually used.” *Id.* at \*1. The Board reversed the Examining Attorney’s refusal, explaining that “purchasers of the goods are not likely to repeat that word mark or be impressed thereby only if it is repeated in the shadow image form.” *Id.* The Board also explained that the applicant’s existing registration for RAINAIRE as a plain word mark was “indicative of what applicant basically considers its mark to be.” *Id.* Thus, the Board considered “what [was] sought to be registered and the matter shown in the specimens [as] basically the same marks creating the same impressions.” *Id.*

Snap submits that it has not applied to register a “mutilated” version of its mark and that SNAP creates a commercial impression separate and apart from the “publisher” term appearing with it on the Specimen. Snap uses and has registered SNAP alone as its house mark, as well as in connection with SNAP-formative marks for a variety of its offerings. Representative examples of Snap’s family of SNAP marks include without limitation: SNAP ORIGINALS subject of US Reg. No. 5,773,967; SNAP CHANNEL subject of US Serial No. 4,967,313; SNAP PUBLISHER subject of US Reg. No. 5,578,626. True and correct copies of the registration certificates for the forgoing registrations are attached hereto as **Exhibit A**.

Snap has extensively promoted and distributed its mobile application and related goods and services in connection with its SNAP mark. In support of these offerings, Snap has registered its SNAP house mark for a variety of goods and services including without limitation in Classes 9, 38, 41, and 45. *See e.g.*, Reg. Nos. 4,345,533; 6,096,795; 5,771,270; and 4,111,564. True and correct copies of the registration certificates for the forgoing registrations are attached hereto as **Exhibit B**. As a result of Snap’s extensive use and promotion of SNAP in connection with its various offerings, the SNAP house mark is understood by consumers as the singular source of SNAP-branded goods and services. Accordingly, the inclusion of a descriptive term—including “publisher”—does not alter that commercial impression.

In *In re University*, the ibis element to be registered was held to convey a separate and distinct commercial impression such that other elements depicted in the specimen, *e.g.*, U MIAMI and various design variations, because such “minor alteration[s]” did not vary the commercial impression. *See* 2017 WL 3485664 at \*2. Here, the element to be registered—SNAP—creates a separate and distinct commercial impression such that the term “publisher”, particularly as used in the context of the Specimen, does not vary the commercial impression. Thus, the Specimen supports registration of SNAP.

Indeed, Snap’s *multiple* existing registrations and use of SNAP as its company name and house mark demonstrate what Snap “considers its mark to be”. Because Snap has latitude to select the mark it wants to register, this SNAP *per se* filing is yet another instance of Snap taking active steps, *i.e.*, applying to register, its house mark. This was also the case in *In re Schecter Brothers*, where registration of RAINAIRE was found appropriate despite inclusion of PRODUCTS and a shadow design depicted in the specimen. *See* 1974 WL 19961.

Because inclusion of the non-distinctive term “publisher” does not result in mutilation of the SNAP mark, the Specimen should be accepted and the application approved for publication.

**2. *The Specimen Should Be Accepted Because Use of the Mark Alongside Non-distinctive Matter Shows Use of the Mark in Commerce.***

Both the Board and courts routinely reject arguments that a trademark owner’s use of its mark alongside non-distinctive matter prevents accrual of trademark rights because such use can show use of the mark in commerce. For example, in the *Plus Prods. v. Pharmavite Pharm. Corp.* opposition, the Board rejected an abandonment counterclaim where the word “PLUS” in the marks PROTEIN PLUS and YEAST PLUS was both “the dominant part of opposer’s trade name” and “the basic common element of opposer’s trademarks, either . . . by itself or in combination with other terms to form marks such as ‘PROTEIN PLUS’ and ‘YEAST PLUS.’” 221 U.S.P.Q. 256, 259 (T.T.A.B. 1984). In *Plus Products*, offerings “sold under the ‘PLUS’ trademark [had] been extensively promoted and advertised,” *id.*, with PLUS continuously used and registered as a trademark—without inclusion of the non-dominant “PROTEIN” and “YEAST” terms. In rejecting the abandonment counterclaim, the Board held that because PLUS was the dominant part of the mark and the basic common element in the marks at issue, the counterclaimant’s use of PLUS would lead consumers to view even the PLUS-formative marks as emanating from the same source. *Id.*

*In re Raychem Corp.* informs as similar conclusion. 12 U.S.P.Q.2d 1399, 1399-1400 (T.T.A.B. 1989). In *Racyhem*, the Board held that a specimen depicting TR06AI-TINEL-LOCK-RING 07/22/87 supported registration of TINEL-LOCK because the alpha-numeric part number and “generic designation” of “Ring” were “not essential to the commercial impression of ‘TINEL-LOCK’ as a trademark . . . and play[ed] no integral role in forming the portion of applicant’s mark which distinguishes applicant’s goods from those of others.” *Id.* Therefore, it

was acceptable for the applicant to leave those numbers off the drawing of mark, because consumers would look to the dominant TINEL-LOCK term as the source identifier. *Id.* The same is true here, where the Specimen shows publishing offerings *made available* as part of Snap’s suite of SNAP offerings.

Furthermore, both the Board and federal courts have routinely held that where a term is purely descriptive, it adds little to the commercial impression because descriptive matter by default does not act as a source identifier—functionally rendering a mark with the descriptive term a legal equivalent of a mark without the descriptive term. In *Am. Security Bank v. Am. Security & Trust Co.*, 571 F.2d 564, 567 (C.C.P.A. 1978), the marks AMERICAN SECURITY and AMERICAN SECURITY BANK (disclaiming “BANK”) were held as legal equivalents because “the word “bank” is purely descriptive and adds nothing to the origin-indicating significance of the source-indicating term. *Id.* The court also reasoned that “the fact that both are used for banking services” weighed in favor of finding the marks AMERICAN SECURITY and AMERICAN SECURITY BANK legal equivalents, *id.* at 556, and that [c]ustomers using the services would know they were dealing with a bank” upon seeing AMERICAN SECURITY *without* BANK appended, in part because consumers were familiar with banking services being offered under the AMERICAN SECURITY mark. *Id.* at 557.

In short, descriptive terms lack origin-indicating significance. *See Am. Sec. Bank v. Am. Sec. Trust & Co.*, 571 F.2d at 567. Because “publisher” is descriptive, it renders SNAP PUBLISHER the legal equivalent for SNAP—as held in *American Security Bank*, where AMERICAN SECURITY was deemed the legal equivalent of AMERICAN SECURITY BANK. *See id.* There, consumers were familiar with the banking services offered by American Security, regardless of the term BANK. *Id.* Here, consumers associate SNAP-branded offerings with



SNAP, with or without descriptive matter. Indeed, consumers that encounter SNAP as used on the Specimen are likely to associate the offerings with Snap because they are seeking out Snap's content management and sharing services, implying a certain degree of recognition and trust in the SNAP brand. The relevant consumer knows the SNAP brand; they know Snap's offerings; they want to use Snap's *specific* SNAP publishing services under this brand.

Likewise in *Nat'l Bakers Service, Inc. v. Hain Pure Food Co.*, the Board found that HOLLYWOOD and HOLLYWOOD HEALTH FOODS were legal equivalents because purchasers "would perceive both marks as HOLLYWOOD and would not be deterred from this perception by the descriptive words 'health foods.'" 207 U.S.P.Q. 701, 707 (T.T.A.B. 1980). The Board took into consideration whether inclusion of the descriptive term "alters to any substantial degree the nature and character of the dominant portion" of the mark, namely HOLLYWOOD. *Id.* Because it did not, the terms were legal equivalents that point to the same source.

Here, SNAP is the foundational element of Snap's trademarks, by itself and as the distinctive component of Snap's family of marks, including marks such as SNAP ORIGINALS, SNAP CHANNEL, SNAP KIT, and others. Snap's composite marks do not impair its ample rights in the SNAP mark alone.

As in the cases described above, SNAP is the dominant common element of the use shown on the Specimen. *See Plus Prod.*, 221 U.S.P.Q. at 259. As in *Plus Products*, the applicant uses its *dominant* stand-alone term in extensive promotion and advertisement, Snap uses its dominant stand-alone term in extensive promotion and advertisement. *See Exhibit B; Plus Prod.*, 221 U.S.P.Q. at 259. As in *Raychem*, where the extraneous terms included in the specimen were "not essential to the commercial impression" of the core mark, "publisher" is not

essential to the commercial impression formed by SNAP. *Id.* Thus, leaving the non-distinctive term “publisher” off the drawing is appropriate, because just like in *Raychem*, consumers will see the dominant SNAP term as the source identifier.

In sum, SNAP is the dominant term as shown on the Specimen. It creates a commercial impression separate and apart from the non-distinctive term “publisher”—which does not have source-identifying significance. Thus, SNAP forms the relevant commercial impression, and the Specimen should be accepted and the Application approved for publication.

**B. The Specimen Demonstrates Use of the Mark in Connection with Claimed Services Because it Shows Use in Connection with Class 42 Digital Content Management and Sharing Services.**

In light of the foregoing, Snap respectfully disagrees that the “the specimen does not show the mark in the drawing in use in commerce” in Class 42. The Specimen shows Class 42 services, including provision of “web facilities for managing and sharing online photographs, videos, text, music and digital content” for others.

Furthermore, elsewhere in this office action response, Snap has submitted an alternative specimen (“Alternative Specimen”). See **Exhibit C** (<https://kit.snapchat.com/> and <https://kit.snapchat.com/docs>) (accessed April 14, 2021). The Alternative Specimen shows the mark SNAP, used in connection with numerous other “kit” formative offerings, including but not limited to Bitmoji Kit, Login Kit, Creative Kit, Story Kit, and Ad Kit, all of which reinforces the lack of source-identifying significance of “kit” in this context. These programs constitute application service provider (ASP) offerings, among other Class 42 offerings as listed in the SNAP Application.

Thus, because the Specimen and Alternative Specimen show use of the applied-for Class 42 offerings under SNAP, the Specimen and/or the Alternative Specimen should be accepted and the SNAP application approved for publication.

### **III. CONCLUSION**

As described herein, inclusion of the non-distinctive term “publisher” (disclaimed in Snap’s filing for SNAP PUBLISHER) does not alter the mark’s commercial impression, with SNAP forming the dominant impression. Furthermore, the Specimen does indeed show use of SNAP in commerce in Classes 42—as does the Alternative Specimen. Based on the foregoing, the Specimen should be accepted and the application approved for publication.