

Remarks in Response to Section 2(e)(1) Refusal

The Examining Attorney has refused registration of Applicant's Mark "INTEGRATOR" on the grounds that Applicant's Mark is merely descriptive of the applied-for goods and services, which are listed below, and generally relate to business growth, business improvement, management improvement, free market economic science, entrepreneurship, and start-up ventures. For the reasons discussed below, Applicant submits that the §2(e)(1) refusal should be withdrawn.

- **Class 9**

- Downloadable software for providing consulting services, business development services, and business advisory services to others in the fields of free market economic science, entrepreneurship, and start-up ventures;
- Downloadable software for creating and sharing strategic business road maps, conducting online collaborative meetings, facilitating project management, documenting company processes, tracking open tasks and issues, tracking goals and goal progress, tracking employee responsibilities, tracking employee performance, and providing entrepreneurial business tools for business growth;
- Downloadable publications for entrepreneurial business growth, business improvement, and management improvement;
- Downloadable e-books and publications in the fields of business growth, business improvement, management improvement, free market economic science, entrepreneurship, and start-up ventures.

- **Class 35**

- Business services, namely, providing consulting services, business development services, and business advisory services to others in the fields of business growth, business improvement, management improvement, free market economic science, entrepreneurship, and start-up ventures;
- Business services, namely, arranging and conducting special events in the fields of business growth, business improvement, management improvement, free market economic science, entrepreneurship, and start-up ventures.

- **Class 41**

- Educational and training services, namely, conducting seminars, classes, conferences, and workshops in the fields of business growth, business improvement, management improvement, free market economic science, entrepreneurship, and start-up ventures;
- Educational services, namely, providing educational speakers in the fields of business growth, business improvement, management improvement, free market economic science, entrepreneurship, and start-up ventures for educational events;
- Educational services, namely, providing non-downloadable webinars and online non-downloadable videos in the fields of business growth, business improvement, management improvement, free market economic science, entrepreneurship, and start-up ventures;

- Providing a website featuring blogs in the fields of business growth, business improvement, management improvement, free market economic science, entrepreneurship, and start-up ventures;
 - Arranging and conducting business conferences, and professional workshops in the fields of business growth, business improvement, management improvement, free market economic science, entrepreneurship, and start-up ventures;
 - Providing speakers in the field of business for business events;
 - Business training services, namely, providing business executive coaching services;
 - Providing non-downloadable webinars and online non-downloadable videos in the fields of business growth, business improvement, management improvement, free market economic science, entrepreneurship, and start-up ventures.
- **Class 42**
- Providing temporary use of online nondownloadable software for consulting services, business development services, and business advisory services in the field of free market economic science, entrepreneurship, and start-up ventures;
 - Providing temporary use of online nondownloadable software for creating and sharing strategic business road maps, conducting online collaborative meetings, facilitating project management, documenting company processes, tracking and solving open tasks and issues, tracking goals and goal progress, tracking employee responsibilities, and tracking employee performance;
 - Providing temporary use of online nondownloadable software for training business coaches;
 - Providing temporary use of online nondownloadable software that provides access to business tools for business growth, business improvement, and management improvement.

For a mark to be “merely descriptive,” it must directly convey some knowledge of the characteristics of a product or service. *In re MBNA America Bank, N.A.*, 67 U.S.P.Q.2d 1778 (Fed. Cir. 2003) (emphasis added). Use of the word “merely” in the Act has been interpreted to mean “only.” *In re Quik-Print Copy Shops, Inc.*, 205 U.S.P.Q. 505 (C.C.P.A. 1980). If the mark does not clearly tell the potential customer only what the goods are, their function, characteristics, use or ingredients, then the mark is not “merely descriptive” (emphasis added).

In support of the assertion that Applicant’s mark INTEGRATOR is allegedly descriptive of Applicant’s goods and services, the Examining Attorney has provided several articles that purport to demonstrate that “INTEGRATOR” is a descriptive term. The definitions are provided below:

- **Harvard Business Review** (see pp. 6-30 of the Non-Final Office Action)
- “[I]ntegration is the achievement of unity of effort among the major functional specialists in a business. The integrator’s role involves handling the nonroutine, unprogrammed problems that arise among the traditional functions as each strives to do its own job. It involves resolving interdepartmental conflicts and facilitating decisions, including not only such major decisions as large capital investment but

also the thousands of smaller ones regarding product features, quality standards, output, cost targets, schedules, and so on.”

- **EOS Blog** (see pp. 31-32 of the Non-Final Office Action)
 - o “An Integrator is the person who is the tie-breaker for the leadership team, is the glue for the organization, holds everything together, beats the drum (provides cadence), is accountable for the P&L results, executes the business plan, holds the Leadership Team accountable, and is the steady force in the organization. The Integrator also creates organizational clarity, communication, and consistency; typically (but not always) operates more on logic; drives results; forces resolution, focus, team unity, prioritization and follow-through; is the filter for all of the Visionary’s ideas; harmoniously integrates the Leadership Team; and helps to remove obstacles and barriers.”
- **Devex website** (see pp. 33-34 of the Non-Final Office Action)
 - o “[T]hose who understand multiple specialties, how they impact each other, and can foster these collaborations...”
- **Holly Chantal website** (see p. 35 of the Non-Final Office Action)
 - o “Well, if you are a visionary entrepreneur, then you know the struggle of having a big idea and trying to get it into the tangible world. A business integrator is someone who can help you do that.”

These definitions ambiguously refer to things such as conflict resolution, fostering collaboration, and executing “big ideas.” Respectfully, none of these are descriptive of Applicant’s goods and services that are listed above, and as a result Applicant’s use of the mark INTEGRATOR does not directly and immediately describe Applicant’s goods and services. On the contrary, Applicant’s mark is suggestive in that it requires a certain degree of imagination, thought, and perception to reach a conclusion as to the nature of the goods and services. *Stix Prods., Inc. v. United Merchants & Mfrs, Inc.*, 160 U.S.P.Q. 77 (S.D.N.Y. 1960). The imagination test set forth by Judge Weinfeld in the Stix case requires “mature thought or follow a multi-stage reasoning process” to determine attributes of the goods. The Ninth Circuit held in *Rodeo Collection, Ltd. V. West Seventh*, 2 U.S.P.Q.2d 1204 at 1206 (9th Cir. 1987): “If a consumer must use more than a small amount of imagination to make the association [or product attribute], the mark is suggestive and not descriptive.” An example often used is the use of the mark “Greyhound” for bus services. To receive any information about the nature of bus services from the word “Greyhound,” one must know what a greyhound is and what the attributes are before the mind makes any connection between the word and any alleged characteristics of the services. This kind of mental leap is precisely what is required by Applicant’s INTEGRATOR mark. The consumer is required to pause and use a degree of mature thought before one can detect the suggestiveness of Applicant’s mark.

Consider, for example, that INTEGRATOR is not descriptive of Applicant’s services for “arranging and conducting business conferences, events, and workshops”, “providing speakers for business events”, or “providing business coaching services”, or any form of training. Nor is INTEGRATOR descriptive of software “for creating and sharing strategic business road maps, conducting online collaborative meetings, facilitating project management, documenting company processes, tracking and solving open tasks and issues, tracking goals and goal progress, tracking employee responsibilities, and tracking employee performance,” or any other of Applicants goods and services.

Applicant's mark INTEGRATOR is suggestive of business growth, business improvement, management improvement, free market economic science, entrepreneurship, and start-up ventures. "Suggestive marks are those which require imagination, thought or perception to reach a conclusion as to the nature of the goods or services. Thus, a suggestive term differs from a descriptive term, which immediately tells something about the goods or services." TMEP §1209.01(a) (citing *In re Shutts*, 217 U.S.P.Q. 363 (T.T.A.B. 1983) SNO-RAKE held not merely descriptive of a snow removal hand tool); *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) (BIASTEEL for steel belted bias tires held only suggestive, not descriptive, as a composite term). To be characterized as "descriptive," the mark must directly give some reasonably accurate or distinct knowledge of the characteristics of the product or service. If information about the product or service given by the mark is indirect or vague, then this indicates that the mark is being used in a "suggestive," not descriptive, manner.

In the case at hand, Applicant's mark INTEGRATOR provides only indirect and/or vague information about Applicant's goods and services. The ambiguous definitions put forth by the Examining Attorney support Applicant's position on this point. When considered in relation to Applicant's goods and services, the mark fails to immediately describe an ingredient, quality, characteristic, function, feature, purpose or use. INTEGRATOR is suggestive in that it requires imagination, thought, and perception to reach a conclusion as to the nature of the goods and services. See *In re Aid Laboratories, Inc.*, 233 U.S.P.Q. 357 (T.T.A.B. 1984). Clearly, a mark that is suggestive is registrable on the Principal Register. See *In re Quik-Print Copy Shop, Inc.*, 203 U.S.P.Q. 624 (T.T.A.B. 1979). See also *In re Shutts*, 217 U.S.P.Q. 363 (T.T.A.B. 1983).

It is noted that a search of the Office records failed to uncover any registered or pending marks that would bar registration of the present mark. In view of the foregoing amendments and remarks, Applicant respectfully submits that the present application is in condition for publication.