

U.S. Application No. 88261375
Mark: GENERATION AI NEXUS and Design
Classes: 41 and 42
SK Ref: 2272.2300000/TGD/JDS

In a non-final Office Action sent April 16, 2019, the Examining Attorney indicated that the identification of services was indefinite and could include services classified in more than one class. The Examining Attorney also requires a disclaimer for the wording GENERATION AI, allegedly, because it is not inherently distinctive. Applicant addresses each of these issues in turn below.

I. Amendment to the Identification of Services

The Examining Attorney has objected to the identification of services on the grounds that is vague, and/or could include services in more than one class. As indicated in the TEAS Response form, Applicant has amended the identification of services to recite the below:

Class 41: Coordination services, namely, organizing and arranging educational programs focusing on teaching Artificial Intelligence (AI), Machine Learning (ML), and Deep Learning (DL) software development, planning, and programming skills; consulting services related to curricula, teaching methods, and educational materials for teaching the principles and application of AI, ML, DL, data science, statistical analysis and modeling, and related fields; research and development of software programming teaching methods; research and development of teaching methods and course development in the fields of AI, ML, DL, data science, statistical analysis and modeling and related fields; and

Class 42: Consulting services in the field of the design of computer software for use in the education industry, specifically software with Artificial Intelligence (AI) Machine Learning (ML) and Deep Learning (DL), data science, and statistical analysis and modeling capabilities; consulting services in the field of design, planning, and implementation project management of computer software testing for use in the education industry; consulting services in the field of design, selection, implementation and use of computer software systems for others; consulting services related to designing, creating, implementing and maintaining computer software for academic professionals to conduct research within an academic institution; custom design and development of computer software for use in the education

industry; development of computer software platform recorded on data media designed for use in education; custom design and development of AI, ML, DL, statistical analysis and modeling software for teaching and education purposes; design, maintenance, development and updating of computer software; electronic storage of information related to educational programs focused on AI, ML, DL, data science, statistical analysis and modeling, and related fields; hosting online web facilities for others for sharing and communicating information related to educational programs focused on AI, ML, DL, data science, statistical analysis and modeling, and related fields; hosting online web facilities for others for sharing of software, code, and algorithms, and technical information for AI, ML, and DL applications, data science, statistical analysis and modeling and related fields.

Together with this Response, Applicant submits an additional filing fee for the newly added services in Class 41. As the amended identifications are within the scope of the application as filed, entry of the amendment is respectfully requested.

II. The wording GENERATION AI is not merely descriptive of the services of the application (no disclaimer required)

As amended by this paper, Applicant seeks to register the GENERATION AI NEXUS and design mark for a variety of services in Classes 41 and 42 relating to different types of automated learning, data science, statistical analysis, and modeling. The Examining Attorney is requiring a disclaimer for the wording “GENERATION AI,” allegedly, because it is not inherently distinctive. Office Action, at 2. In support of this requirement, the Examining Attorney refers to two pieces of evidence (a *TechCrunch* article and an IEEE page), which allegedly show that the wording at issue “refers to the generation of people growing up with artificial intelligence technologies,” and that the wording immediately describes a feature of the services that pertains to or is targeted to this group of people. *Id.* Applicant respectfully disagrees, and requests that the requirement for disclaimer be withdrawn.

A. Applicant’s mark should be treated as a unitary phrase

As an initial matter, Applicant asserts that the wording of its GENERATION AI NEXUS and design mark is a unitary phrase that should not be dissected for disclaimer purposes. Each of the terms of Applicant’s GENERATION AI NEXUS design mark may, arguably, give some general or abstract suggestion about the nature of Applicant’s services. But consumers encountering the mark, even in connection with the applied-for services, would not read, hear, or otherwise perceive the mark in pieces, or as separate terms or wording.

A unitary phrase derives its meaning when viewed as a whole, with the combination of components having a distinct commercial impression that is independent of the constituent elements. *Dena Corp. v. Belvedere Int'l, Inc.*, 950 F.2d 1555, 1561, 21 USPQ2d 1047, 1052 (Fed. Cir. 1991). Even where it includes an otherwise unregistrable component, a unitary phrase as a whole will have "some degree of ingenuity in its phraseology as used in connection with the goods; or [say] something a little different from what might be expected to be said about the product; or [say] an expected thing in an unexpected way." *Ex parte Mooresville Mills, Inc.*, 102 USPQ 440, 441 (Comm'r Pats. 1954). Here, the very terms of Applicant's mark suggest that they should be linked together and considered as a whole or as a unitary phrase. More particularly, the term NEXUS implies a tie, link, or connection. The use of such a term inherently results in the consumer tying or considering the wording of Applicant's mark together as a unitary phrase, such that dissection of the mark for disclaimer purposes is improper. For this reason alone, Applicant submits that a disclaimer for the wording GENERATION AI is not required.

B. The wording GENERATION AI is Suggestive, Not Merely Descriptive

The Trademark Trial and Appeal Board (TTAB) uses a multi-pronged test for determining whether a mark is descriptive. *No Nonsense Fashions, Inc. v. Consolidated Foods Corp.*, 226 USPQ 502 (TTAB 1985). A mark is considered descriptive if it:

- (1) conveys to consumers an immediate idea of the ingredients, qualities or characteristics of the goods and/or services;
- (2) has been used so frequently by others that consumers are unlikely to perceive the term when used in the manner of a trademark as indicating source or origin; or
- (3) deprives competitors of an apt description of their goods and/or services.

Id. at 507. These three tests are also referred to as: (1) the degree of imagination test; (2) the competitor's use test; and (3) the competitor's need test. The Examining Attorney has not shown that Applicant's GENERATION AI wording is descriptive under any of these three tests.

1. Degree of Imagination Test

The degree of imagination test was set forth in *Stix Products, Inc. v. United Merchants & Mfrs., Inc.*, 160 USPQ 777 (SDNY 1968):

A term is suggestive if it requires imagination, thought, and perception to reach a conclusion as to the nature of the goods. A term is descriptive if it forthwith conveys an immediate idea of the ingredients, qualities, or characteristics of the goods. *Id.* at 785 (emphasis added). See also *In re Bed & Breakfast Registry*, 229 USPQ 818 (Fed. Cir.

1997); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). To be deemed descriptive, it is not sufficient that a mark merely convey some information about a product or service. Both descriptive and suggestive marks do that. Rather, a merely descriptive mark must immediately convey some particular and clear idea about the goods or services. See, e.g., *In re Hutchinson Technology*, 7 USPQ 1490 (Fed. Cir. 1988); *In re The House Store, Ltd.*, 221 USPQ 92 (TTAB 1983). If a mark requires some imagination to determine the true nature of the services, it is not descriptive.

The Board routinely applies the principles outlined above when determining whether a mark should be characterized as merely descriptive or suggestive. In *No Nonsense Fashions*, the Board held that the mark SHEER ELEGANCE was not merely descriptive of the applicant's goods --panty hose-- because the mark did not immediately convey a quality or characteristic of the goods and the mark was not so descriptive as to prevent it from indicating a source. 226 USPQ 502 (TTAB 1985). In another case, the Board found that the mark THE MONEY SERVICE was not suggestive of financial services pertaining to the transfer of funds from remote locations, because although the mark suggested some form of monetary service, it did not in any way describe the Applicant's actual services. In that case, the Board stated:

The [mark] suggests a number of things, but yet falls short of describing applicant's services in any one degree of particularity. To effect a readily understood connection between the applicant's mark and its services requires the actual or prospective customer to use thought, imagination and perhaps an exercise in extrapolation. *In re TMS Corp of the Americas*, 200 USPQ 57, 59 (TTAB 1978).

The same is true, here, in the instant case for the following reasons.

First, while the word GENERATION, individually, may have one meaning, and the wording ARTIFICIAL INTELLIGENCE, individually, may have another, the phrase GENERATION AI has no readily understood or particular meaning and is, therefore, suggestive of the applied-for services. Indeed, the wording GENERATION AI does not appear in any dictionary consulted by Applicant. See, Exhibit A, sample print-out of online dictionary search for the wording GENERATION AI, yielding no results. Surely if such wording were merely descriptive, as the Examining Attorney asserts, GENERATION AI would appear in a dictionary.

Second, even though the wording GENERATION and ARTIFICIAL INTELLIGENCE, have meanings as individual terms, the consumer must still engage in a multi-step process before he or she is able to glean anything particular from the wording GENERATION AI about the nature, characteristics, or intended consumers of the Applicant's services. The term "generation" generally means:

- the entire body of individuals born and living at about the same time;

- the term of years, roughly 30 among human beings, accepted as the average period between the birth of parents and the birth of their offspring;
- a group of individuals, most of whom are the same approximate age, having similar ideas, problems, attitudes;
- a group of individuals belonging to a specific category at the same time.

See, online dictionary definition for “generation” attached as Exhibit B. Thus, the word “generation” brings to mind the idea of people who were all born at or living in the same time, age, or period in history. This very human/people-specific term is in stark contrast with “artificial intelligence” --the terms for which AI is an initialism--, which refers to computers, software programs, and machines. These two words are not only conceptually different, but are incongruent --joining a human condition to a machine-based concept--, which is the very hallmark of suggestiveness. See, TMEP § 1213.05(d) (if two or more terms are combined in a mark to create an incongruity, the mark is unitary and no disclaimer of nondistinctive individual elements is necessary).

Upon encountering the phrase GENERATION AI, Applicant asserts that the consumer must (1) determine what the letters or initials AI refer to (as these letters or initials could also refer to “airborne intercept,” “artificial insemination,” “*ad interim*,” etc.), (2) consider what the term “generation” means, and (3) reconcile the meaning of the very human/people-specific term “generation” with the very scientific or machine-like “AI” initialism, before he or she is able to discern anything about the nature, purpose, or intended consumer of the applied-for services. Applicant further asserts that the consumer cannot even begin to reconcile the terms “generation” and “AI” (the third step), until he or she first harken-backs to the meaning of similarly constructed phrases such as “Generation X” or the “Postwar Generation.” But none of these mental steps are *immediate, nor do they function to render the wording GENERATION AI immediately descriptive of anything, with any degree of particularity*, including Applicant’s services. (“If information about the product or service given by the term used as a mark is indirect or vague, then this indicates that the term is being used in a ‘suggestive,’ not descriptive manner.” 4 *McCarthy* § 11:19. “If the mental leap between the word and the product’s attributes is not almost instantaneous, this strongly indicates suggestiveness, not direct descriptiveness.” *Id.* at §11:67. A mark (or term) “should be characterized as ‘descriptive’ only if a *substantial portion* of prospective customers recognize it as such.” 4 *McCarthy* § 11.20 (emphasis added).)

As a consumer encountering the wording GENERATION AI would have to use imagination, thought, and perception to determine anything about the nature or characteristics of Applicant’s services, with particularity, Applicant submits that this wording simply does not fit the classic formulation of mere descriptiveness. *Id.*

As to the evidence in support of the requirement for disclaimer, Applicant asserts that the *mere two* references attached to the Office Action do not show what the Office purports. Turning to the *TechCrunch* article, of which the Office references/attaches

only an excerpt, Applicant notes that this excerpt does not even use the wording “Generation AI.” It instead uses the wording “Generation I,” which is hyperlinked to an article about middle children of the information age, as shown in the excerpt reproduced from the Office Action attachment, below.

human ways, while still bringing to bear the enormous benefits of big data.

In 2016, many believe we are at the beginning of the next generation of computing — an “AI revolution.” Assuming the Age of Artificial Intelligence will succeed the Age of Mobile, what does that mean for the children who will succeed “Generation I”? What will it mean to grow up in the Age of AI? And how can we as a society facilitate the transition, ensuring at the same time that this progress will be put to good use?

Current debates on automation already demonstrate the conflict we are in.

The second piece of evidence, a page from the IEEE website, details what the wording might mean in the larger context of artificial intelligence. But if consumers readily understood the meaning of the wording GENERATION AI, such a detailed discussion would not be needed.

In summary, the evidence attached to the Office Action does not support the finding that the wording GENERATION AI is merely descriptive and should be disclaimed. Additionally, a *scant two references* is insufficient to prove anything, including that the wording GENERATION AI is descriptive. If anything, the references support that the wording is suggestive/inherently descriptive, and not subject to disclaimer.

2. The Competitor’s Use Test

The Examining Attorney has the burden of proving that Applicant's mark is merely descriptive of the goods it identifies. TMEP ¶ 1209.02 (an Examining Attorney must support a refusal to register on descriptiveness grounds with appropriate evidence). TTAB precedent likewise recognizes this well-established rule. *See, e.g., In re Ohmite Manf. Co.*, 13 USPQ 30 (TTAB 1962) (reversing refusal to register the mark “V.T.” because the Examining Attorney provided no evidence of any sort demonstrating public recognition of “V.T.” as an abridgement of “variable transformers”). The TTAB will consider a mark merely descriptive of the goods/services if the evidence establishes that competitors use the mark to describe the same type of goods/services. *In re Engineering Sys. Corp.*, 2 USPQ2d 1075 (TTAB 1986). If the term has been frequently used by competitors, then consumers will likely consider it to merely describe the goods in question, rather than indicate the source thereof.

In this case, the Examining Attorney has not met her burden of proving that the wording GENERATION AI is frequently used by providers of the applied-for services, or by

consumers of such services, to describe or understand the same. Indeed, the record contains only two, allegedly supporting, Internet references, and one of these references is to “Generation I,” rather than “Generation AI.”

The evidence attached to the Office Action not only supports Applicant’s arguments *supra* on the degree of imagination required to understand anything about the wording of Applicant’s mark, they also show that the GENERATION AI wording of Applicant’s mark is not used by competitors to describe the applied-for services.

3. The Competitor’s Need Test

Just as the few references cited by the Examining Attorney are insufficient to show that competitors **use** the wording GENERATION AI to describe the applied-for services, so too are they insufficient to show that competitors **need** to use such wording. Accordingly, the evidence of record fails to support the third prong of the mere descriptiveness test – competitor need.

C. There are numerous GENERATION-formative marks on the Principal Register without a disclaimer for at least the word GENERATION

Applicant’s review of the USPTO database reveals that there are numerous GENERATION-formative marks on the Principal Register for similar educational and training services in Class 41, as well as other service classes, that do not contain either a disclaimer for at least the term GENERATION, or a 2(f) claim of acquired distinctiveness. A sampling of such marks appears in the chart below, and TESS records for the corresponding registrations are attached as Exhibit C.

Mark	Reg. No. Reg. Date	Owner	Class(es)	Disclaimer for
GENERATION M: MILLENNIAL, MULTICULTURAL & MOBILE	5152043 February 28, 2017	NBCUniversal Media, LLC	41	MILLENNIAL, MULTICULTURAL, & MOBILE
GENERATION M	5009499 July 26, 2016	NBCUniversal Media, LLC	41	(None)
GENERATION S	5519310 July 17, 2018	Nana's Network, Inc.	41	(None)
GENERATION T	5711157	LF, LLC	41	(None)

Mark	Reg. No. Reg. Date	Owner	Class(es)	Disclaimer for
	March 26, 2019			
GENERATION E	5337971 November 21, 2017	Generation E Institute	41	(None)
GENERATION E	4860787 November 24, 2015	Boccuzzi, Francesco	41	(None)
GENERATION W	4389058 August 20, 2013	GENERATION W, INC.	25 and 41	(None)
GENERATION CODE	5221175 June 13, 2017	Strayer Education, Inc.	41	CODE
GENERATION TECH	5465653 May 8, 2018	JPMORGAN CHASE BANK, NA	41	TECH
GENERATION Y NOT	5169332 March 28, 2017	Thomas Brag dba Generation Y Not	41	(None)
GEN X RADIO	4344592 June 4, 2013	Clear Channel Broadcasting, Inc.	38	RADIO
GEN Y PLANNING	4516667 April 15, 2014	Gen Y Planning, LLC	36	PLANNING

Even the GEN X RADIO and GEN Y PLANNING marks, for radio broadcasting and financial planning services, respectively, were not found to be merely descriptive of the related services, or of the consumers to which such services are rendered or intended.

Applicant asserts that for the same reason(s) that the above GENERATION-formative marks were found to be inherently distinctive, so, too, is the GENERATION AI wording of Applicant's mark inherently distinctive (suggestive) of its services, and not subject to disclaimer.

In light of the foregoing, and recognizing that any doubts as to the descriptiveness of the wording of Applicant's mark must be resolved in its favor, Applicant respectfully requests that the Examining Attorney withdraw the requirement for disclaimer for the

wording GENERATION AI. *In re Micro Instrument Corp.*, 222 U.S.P.Q. 252, 255 (TTAB 1984).