

## **Response to Office Action**

Applicant, Pool Pay, Inc. ("Applicant") respectfully submits this Response to the Office Action issued on December 10, 2019 against Application Serial No. 88603747 for the POOL mark (the "Mark").

### **MERE DESCRIPTIVENESS REFUSAL**

The Examining Attorney has refused registration on the ground that the Mark is merely descriptive of Applicant's services, under 15 U.S.C. § 1052(e)(1). Applicant respectfully requests that the refusal be withdrawn as the Mark is not merely descriptive, but rather is inherently distinctive.

### **The Mark Is Inherently Distinctive**

The Mark is inherently distinctive because it is suggestive of the services listed in the Application, given that the Mark requires consumers to exercise imagination, thought, and perception to reach a conclusion about the nature of Applicant's services. Further argument to support this position is provided below.

The fact that the Mark is not merely descriptive in connection with Applicant's services is underscored by the existence of no fewer than four third-party registered marks that are similar in substance and in the services provided in connection with those third-party marks. These third-party marks are identified and discussed at length below.

### **The Mark Is Not Merely Descriptive Because It Is Suggestive**

The Mark is not merely descriptive because it is suggestive of the services listed in the Application, and therefore it is inherently distinctive. Applicant's POOL Mark requires consumers to exercise imagination, thought, and perception to reach a conclusion about the nature of Applicant's services (TMEP § 1209.01(a)).

The average consumer, when confronted with Applicant's Mark, would not immediately understand it to be a description of the services listed in the Application. Were Applicant's Mark a slightly modified mark, for instance "JOINT MONEY ACCOUNTS", then admittedly the average consumer would view such a mark as merely describing a feature of Applicant's services. But the term POOL, as applied to Applicant's services listed in the Application, does not readily and immediately evoke an impression and understanding of Applicant's services.

To reach a conclusion about the nature of Applicant's services, the average consumer would first have to process a range of alternative meanings associated with the term POOL—both in noun and verb forms—including, most notably, the meanings of a small body of water and a form of billiards, which are common usages of the term. But it would not end there.

The concept of a POOL in the sense of a collection of things (in the noun form) or the act of collecting things (in the verb form) embraces much more than simply a collection of money, a fact that is illustrated in the dictionary definitions provided by the Examining Attorney. This meaning is associated with a supply of vehicles or goods available for use when needed, a group of people available for work when required or considered as a resource, the collective amount of players' stakes in gambling, and a group of contestants who compete against each other in a tournament—just to name a handful.

The suggestive nature of Applicant's Mark is confirmed by the fact that the USPTO has accepted a number of similar marks in connection with similar services to those of the Applicant, as described in some detail below.

### **Third-Party Registrations Support Applicant's Position**

That the Mark is not merely descriptive in connection with Applicant's services is demonstrated by the USPTO's acceptance of similar marks for similar services as distinctive enough to merit registration on the Principal Register. The USPTO has registered at least four marks that contain nearly the same word that the Examining Attorney objected to as descriptive. The fact that the USPTO registered those marks without requiring proof of secondary meaning shows that the USPTO does not consider the word, as used in connection with similar services, descriptive (see *Borinquen Biscuit Corp. v. M.V. Trading Corp.*, 78 U.S.P.Q.2d 1454, 443 F.3d 112, 119-20 (1st Cir. 2006)).

Four of these marks are identified below, along with explication of why they support Applicant's position.

#### **POOLSPARK – Reg. No. 5819774**

The mark POOLSPARK, registration number 5819774, was registered in international class 042 for the following services:

Providing temporary use of on-line downloadable software for collecting money from individuals, for tracking contributions of individuals, and for making electronic funds transfers; Providing temporary use of on-line non-downloadable software for sending money, for requesting money, and for processing electronic funds transfers; Providing temporary use of on-line non-downloadable software for creating web pages for use in collecting money from individuals, pooling money, and making electronic funds transfers.

Notably, the USPTO did not issue an office action to POOLSPARK based on mere descriptiveness during the prosecution of the application for that mark. The fact that the USPTO registered this mark is compelling evidence that the USPTO does not consider the word “pool” as used in connection with group finances to be descriptive.

#### **THE WEALTH POOL – Reg. No. 466559**

The mark THE WEALTH POOL, registration number 4664559, was registered in international class 042 for the following services: “Application service provider (ASP) featuring software for use in financial planning and money management.” The USPTO did not issue an office action based on mere descriptiveness during the prosecution of the application for that mark. This is significant because, unlike Applicant's POOL Mark here, the THE WEALTH POOL mark features descriptive information—namely, the word “wealth”—that would signal to a consumer that the services relate to finances. The fact that the USPTO registered this mark is compelling evidence that the USPTO does not consider the word “pool” as used in connection with group finances to be descriptive.

#### **MONEYPOOLS – Reg. No. 3515797 (cancelled)**

The mark MONEYPOOLS, registration number 3515797, was registered in international class 009 for the following services: “computer software for use in financial planning and money

management.” Registration has since been canceled because the registrant did not file an acceptable declaration under Section 8. In any event, the USPTO did not issue an office action to this application based on mere descriptiveness during the prosecution of the application for that mark. This is significant because, unlike Applicant’s POOL Mark here, the MONEYPOLS mark features descriptive information—namely, the word “money”—that would signal to a consumer that the services relate to finances. The fact that the USPTO registered this mark is compelling evidence that the USPTO does not consider the word “pool” as used in connection with group finances to be descriptive.

#### PAYPOOL – Reg. No. 5764011

The mark PAYPOOL, registration number 5764011, was registered in international classes 036 and 042 for the following services, respectively:

Payment processing services, namely, invoice management and automated electronic and paper processing in the fields of accounts payable

Software as a service (SAAS) services featuring software for use in accounts payable automation namely, software that enables business to manage invoice transactions in a cost effective and efficient manner, for use in document entry, access and visibility, management, maintenance and invoices for routing, approval, payment and reporting; Computer services, namely, accounts payable automation, namely, invoice management, automated electronic and paper processing and streamlining data feed integration in the fields of accounts payable.

The USPTO did not issue an office action based on mere descriptiveness. This is significant because, unlike Applicant’s POOL Mark here, the PAYPOOL mark features descriptive information—namely, the word “pay”—that would signal to a consumer that the services relate to finances. The fact that the USPTO registered this mark is compelling evidence that the USPTO does not consider the word “pool” as used in connection with group finances to be descriptive.

The foregoing marks demonstrate that the USPTO does not consider the word “pool” to be descriptive when used in connection with group finances. Accordingly, the Mark is not merely descriptive and the Examining Attorney's refusal should be withdrawn and the Application allowed to proceed to publication.

#### **Response to Examining Attorney’s Request for Information**

Enclosed with this response is additional information about Applicant’s services, as requested by the Examining Attorney. This additional information is in the form of several screenshots taken of Applicant’s website, which is still in a very early stage of development. Should the Examining Attorney require additional information from Applicant in order to permit proper examination of the application, Applicant is more than willing to provide such information upon request.

#### **CONCLUSION**

Because Applicant's Mark is inherently distinctive and any doubts as to descriptiveness must be resolved in favor of Applicant (see *In re Box Solutions Corp.*, 79 U.S.P.Q.2d 1953, 2006 WL 1546499, at \*2 (T.T.A.B. 2006); *In re Shutts*, 217 U.S.P.Q. 363, 1983 WL 51780, at \*3 (T.T.A.B. 1983)), Applicant submits that the Mark is not merely descriptive as used in

connection with the services identified, and accordingly, is entitled to registration on the Principal Register.

Applicant respectfully requests that the Examining Attorney withdraw the refusal to register Applicant's Mark and approve the Application for publication. If a telephone call will assist in the prosecution of this Application, the Examining Attorney is invited to call 206-485-3275.

Respectfully submitted,

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