

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Mark: ARC

Application No.: 88373100

Applicant: Baker Tilly Virchow Krause, LLP

Applicant's Services: Class 42: Software as a service (SAAS) services featuring software for managing business processes, measuring and reporting employee performances, and optimizing revenue cycle operations

The following remarks are in response to the office action issued on May 8, 2020. The Examining Attorney states the Mark “is only shown as an acronym for the descriptive wording ‘Advance Revenue Cycle’ platform” and the specimen does not show use of the Mark in commerce. Applicant disagrees with Examining Attorney’s assessment regarding both matters.

First, acronyms are protectable trademarks under certain conditions. According to Trademark Manual of Examining Procedure (TMEP) § 1209.03(h), “As a general rule, an acronym or initialism cannot be considered descriptive unless the wording it stands for is merely descriptive of the goods or services, **and** the acronym or initialism is readily understood by relevant purchasers to be ‘substantially synonymous’ with the merely descriptive wording it represents,” emphasis added. See *Baroness Small Estates, Inc. v. Am. Wine Trade, Inc.*, 104 USPQ2d 1224, 1230-31 (TTAB 2012) (holding CMS not substantially synonymous with the grape varieties cabernet, merlot, and syrah and therefore not merely descriptive for wine). ARC is not substantially synonymous with “Advance Revenue Cycle.” It is a unique acronym coined and exclusively used by Applicant. Thus, the Mark is protectable.

Second, the specimen does indeed show use of the Mark in commerce. The specimen shows the Mark in use in commerce in connection with Applicant’s Services. While the

Examining Attorney's shortcut for finding source-indicating service marks by looking to the top left corner of websites is efficient, it is not always accurate and it is certainly not accurate in this case. The specimen prominently shows the Mark on Applicant's website promoting Applicant's Services. In one instance, on page two, the Mark is even prominently displayed alone (i.e., apart from "Advance Revenue Cycle") – "How does ARC improve your process?" TMEP § 1301.04 states that a specimen "must show proper use in commerce of the mark, which may be established by (1) showing the mark used or displayed as a service mark in the sale of the services, which includes use in the course of rendering or performing the services, or (2) showing the mark used or displayed in advertising the services, which encompasses marketing and promotional materials." The specimen shows the Mark used or displayed on Applicant's promotional and marketing materials for Applicant's Services. The specimen meets the threshold as described in TMEP.

Finally, the Examining Attorney further states that page two of the specimen does not sufficiently show the Mark being used as a service mark because "a consumer would understand 'ARC' to merely be an abbreviation for 'Advanced Revenue Cycle'". Applicant disagrees with this argument. First, Applicant's use of "Advanced Revenue Cycle" in its marketing material actually supports Applicant's position that ARC is a protectable trademark because it "suggest[s] that the writer would not expect readers to understand the acronym without explanation," i.e., that purchasers don't view ARC as "substantially synonymous" with "Advanced Revenue Cycle," *In re Life Cycle Engineering, Inc.*, Serial No. 85692710 (August 4, 2014) [not precedential] (reversed refusal to register RBAM because examples of third-party use "never show the expression RBAM alone unless it has earlier appeared in the form 'risk-based asset management (RBAM)'"'). Second, if the Examining Attorney's argument bars the Mark from

registering, then essentially no acronym would be allowed to register as most often acronyms are presented with the words they shorten. However, as discussed above, since TMEP § 1209.03(h) provides sufficient guidance that if there is no evidence that the Mark is readily understood by relevant purchasers to be "substantially synonymous" with "Advanced Revenue Cycle," the Mark is protectable and should be allowed to register.

Applicant respectfully requests the Mark be allowed to register.