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Subject: U.S. TRADEMARK APPLICATION NO. 77199918 - CHI - 13271-364 - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 77199918

MARK: CHI



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: CHICAGO MERCANTILE EXCHANGE INC.

CORRESPONDENT'S REFERENCE/DOCKET NO:

13271-364

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EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has appealed the trademark examining attorney's refusal to register the service mark "CHI" on the grounds that it identifies a process or system, and that it does not function as a service mark to identify and distinguish applicant's recited services from those of others and indicate the source

of those services. Trademark Act Sections 1, 2, 3, and 45, 15 U.S.C. §§10510-1053, 1127. The refusal on the ground that the mark identifies a process or system is withdrawn. The remaining issue on appeal is that the mark fails to function as a service mark to identify and distinguish applicant's recited services from those of others and indicate the source of those services.

FACTS

Following a refusal under Section 2d of the Trademark Act that the applicant has overcome, the mark was published for opposition, and a statement of use provided. The statement of use was refused on the ground that the mark identifies a process or system, and it does not function as a service mark to identify and distinguish applicant's services from those of others and indicate the source of those services. Trademark Act Sections 1, 2, 3, and 45, 15 U.S.C. §§10510-1053, 1127. Request for reconsideration was denied because the request failed to provide specimens that showed use of the mark as a source identifier for the services in the application, and because the mark was used to identify a system or process. The refusal based on use of the mark to identify a process or system is withdrawn in deference to the applicant's registration of the same mark for indexing services. The issue remaining on appeal is whether the mark serves as a service mark to identify and distinguish the applicant's service from those of others and to indicate the source of those services.

ARGUMENT

FAILURE TO FUNCTION AS SERVICE MARK FOR RECITED SERVICES

Registration was refused because the applied-for mark, as used on the specimen of record, does not function as a service mark to identify and distinguish applicant's services from those of others and to indicate the source of applicant's recited services. Trademark Act Sections 1, 2, 3 and 45, 15 U.S.C. §§1051-1053, 1127; see *In re Moody's Investors Serv., Inc.*, 13 USPQ2d 2043 (TTAB 1989); *In re The Signal Cos.*, 228 USPQ 956 (TTAB 1986); *In re Hughes Aircraft Co.*, 222 USPQ 263 (TTAB 1984); TMEP §§904.07(b), 1301.02 *et seq.* The specimen of record, along with any other relevant evidence of record, is reviewed to determine whether an applied-for mark is being used as a service mark. See *In re Volvo Cars of N. Am., Inc.*, 46 USPQ2d 1455, 1458 (TTAB 1998). A designation cannot be registered unless purchasers would be likely to regard it as a source-indicator for the services. *Id.*; see *In re Moody's Investors Serv. Inc.*, 13 USPQ2d 2043, 2047-49 (TTAB 1989).

The applicant characterizes the issue as whether the specimens show use of the proposed "CHI" mark *in connection with* the futures and options contracts related to hurricanes. The examiner would agree that the mark, "CHI", is used *in connection with* the applicant's futures and options contracts in that the mark is used on *indexes* used for valuation of futures and option contracts. This is not the issue for which registration was refused.

The mark is *not* used in the specimens of record to identify the *source* of the applicant's "*investment services, namely, providing futures, option contracts* related to hurricanes for trading on an exchange" (emphasis added) and distinguish the services from those of others. The characterization of the services

and whether the mark used on the specimens is used to indicate the source of the services *recited in the application* is at issue in this case.

The “CHI” mark is consistently used in the specimens of record to identify an *index* used in the valuation of investment contracts. In telephonic conversations with the applicant, the examining attorney noted that the applicant's use of the acronym CME (a different mark from the mark at issue) on the applicant's specimens is consistent with a mark used as a source identifier for the applicant's investment services. The examiner encouraged the applicant to seek examples of the “CHI” mark used in a similar manner to identify the source of the *investment services* rather than used to specifically reference the *index* used in valuation of the applicant's investment contracts. It is noted that during the prosecution of this application, the applicant sought registration for “CHI” used with the indexing services referenced by the examining attorney in telephonic conversations. It is also noted that the “CHI” mark *registered* in the later filed application for the services of “compiling, proving and updating a financial *index* measuring potential damage from a hurricane” (emphasis added). It is also noted that the specimens provided for the “CHI” registered mark are identical to the specimens provided in this application in which the specimens are refused for failing to serve as source identifying indicia for the applicant's *investment services*.

The applicant argues that use of the TM symbol signals to third parties that the applicant claims use of the term “CHI” as a mark. That is not at issue. The issue is whether the mark is used to identify the source of the particular services recited in this application. The applicant argues that its activities function as a service. The examining attorney is in agreement that the recited activities are services, and that the record supports the provision of these services in trade, and has not raised this as an issue in

the prosecution of this application. Clearly, the specimens reflect that the applicant is rendering the services in the application. At issue is whether the “CHI” mark serves to indicate the source of the investment services. The examiner does not dispute that a mark may be used to identify a process as well as a service, and this is evidenced by the applicant’s U.S. Registration No. 4315763 for use with indexing services.

The specimens of record (and discussed in the applicant’s Brief) include a reference to “CHI-Cat-In-A-Box - Galveston-Mobile” followed by a geographic reference. In this case, the proposed mark, “CHI” does not match the term CHI-Cat-In-A-Box, and for that reason is not acceptable to show use of the mark in connection with the services. Furthermore, it is not clear that the “CHI-Cat-In-A-Box - Galveston-Mobile” is the name of a futures or futures option contract. 37 C.F.R. §2.51(a); TMEP §807.12(a). The second specimen referenced in the applicant’s brief (and earlier made of record) states “The CME Hurricane Index (CHI) was developed to provide a quick and *easy-to calculate estimate of hurricane damage* and is used by all of our Hurricane futures and option on futures contracts.” This is a reference to the indexing services used to establish the value of the futures and options” (emphasis added by the examiner). The third specimen referenced in the applicant’s brief states “This high level of detail and responsiveness, plus the ability to update frequently using publicly available data, make the CHI an ideal choice *as the basis* for the suite of hurricane futures, options, and binary contracts traded at CME.” Again, the reference to “*the basis*” is a reference to the means of determining the risk related value of the hurricane related contracts. The applicant’s specimens of record are all found unacceptable for the same reasons as those referenced herein.

While the examiner does not dispute that the “CHI” mark is used to identify both a process and a service, it is used to identify the *indexing* process and services, and not to identify the *source* of the *investment* services. The mark in this application appears to be properly registered for the services with which it is used in U.S. Registration No. 4315763. In summation, the specimens of record do not show use of the mark to identify the source of the applicant’s investment services, namely providing futures [and] options contracts related to hurricanes for trading on an exchange.

CONCLUSION

For the foregoing reasons, the refusal to register on the basis of Sections 1, 2, 3, and 45 of the Trademark Act, 15 U.S.C. §§10510-1053, 1127, for the reason that the specimens of record fail to function to identify the source of the applicant’s services for which registration is sought, should be affirmed.

Respectfully submitted,

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