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

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Files: CHI consumers1.jpg, CHI consumers2.jpg, Bet on the Weather.jpg, CHI consumers4.jpg, CHI member def.jpg, Member Firm AH.jpg, 77199918.doc

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 77199918 MARK: CHI	
CORRESPONDENT ADDRESS: TATYANA V GILLES NORVELL IP LLC 1776 ASH STREET NORTHFIELD, IL 60093	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 CORRESPONDENT E-MAIL ADDRESS: officeactions@norvellip.com	

The trademark examining attorney has carefully reviewed applicant's 4th request for reconsideration issuing from a request for remanded and is denying the request for the reasons stated below. See 37 C.F.R. §2.64(b); TMEP §§715.03(a)(2)(B), (a)(2)(E), 715.04(a). The refusal made final in the Office action dated October 5, 2012 and last refused reconsideration on July 14, 2014 and is maintained and continued as FINAL. See TMEP §§715.03(a)(2)(B), (a)(2)(E), 715.04(a).

In the present case, applicant's request for remand of August 8, 2014 has not resolved all the outstanding issues, nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issues in the final Office action. Accordingly, the request is denied.

EXAMINING ATTORNEY'S SUPPLEMENTAL APPEAL BRIEF

Final refusal of the applicant's specimens of use issued on October 5, 2012 because the specimens failed to function as a service mark for the services recited in the application. Trademark Act Sections 1, 2, 3 and 45, 15 U.S.C. §§1051-1053, 1127. The following addresses materials provided by the applicant with a request for remand filed August 8, 2014.

FACTS

The applicant seeks registration of the mark, CHI, for use in connection with "Investment services, namely, providing futures, options contracts related to hurricanes for trading on an exchange."

The specimens provided for reconsideration on December 9, 2013 were regarded by the examiner as untimely; however, the Trademark Trial and Appeal Board accepted the specimens and has deemed the materials to be part of the record. The examiner asserted that the evidence was not properly submitted. The issue is obviated by the applicant's provision of a verified statement regarding use of the specimens in commerce in the materials submitted in this request for remand.

The specimens provided on December 9, 2013, several Chapters from the CME Rulebook, were found objectionable because they were not understood to be acceptable to show use of the mark in advertising or marketing materials or other material provided to consumers for the services that shows

the mark used in the actual sale, rendering or advertising of the services. TMEP §1301.04 *et seq.* The applicant's statements regarding who are the consumers for the applicant's services and statements regarding how the substitute specimens are used by the consumers for the services remain at issue.

ARGUMENTS

The originally provided specimens, submitted on February 7, 2012, comprised advertising for the services, and established the consumers for the applicant's services. In the first page of the marketing material specimens, "Market Participants" were described as "Insurance and reinsurance companies, Hedge funds, Energy companies, Pension funds, State Governments, Utility companies." The examiner attaches additional marketing material from the applicant's website, found at <http://www.cmegroup.com/trading/weather/files/weather-products-brochure.pdf>, that further describes other main users of the applicant's weather futures and options contracts and that expands the users of the services to include "Local Distribution Companies, Construction, Manufacturing, Agriculture, Retailers and "Transportation" sectors. See the attached marketing material from CME GROUP entitled WEATHER PRODUCTS (in two pages) used to show who are the consumers for the services. Note that the services are not characterized as CHI Futures or CHI Options contracts in any of these materials. See also an attached additional article by a third party, *Can You Get Rich Betting on the Weather*, that explains weather futures for the layman and describes who participates in the weather futures markets, found at <http://mentalfloss.com>.

At the bottom of the *second page* of the specimens submitted by the applicant on February 7, 2012, a page entitled "CME HURRICANE INDEX FUTURES AND OPTIONS CONTRACTS," the applicant provided the following guidance in very small lettering:

Futures trading is not suitable for all investors, and involves the risk of loss. Futures are a leveraged investment, and because only a percentage of a contract's value is required to trade, it is possible to lose more than the amount of money deposited for a futures position. Therefore, traders should only use funds that they can afford to lose without affecting their lifestyles. And only a portion of those funds should be devoted to any one trade because they cannot expect to profit on every trade.

This guidance that appears in very small print at the bottom of the page, while accompanied by a reference to the CME Group rules, does not specify where those rules (The CME Rulebook) can be found. The text also suggests that the applicant recognizes that all consumers for these contracts are not necessarily sophisticated financial product consumers. This warning to consumers is followed by the equally small claim of trademarks and a statement that further information about CME Group and its products can be found at www.cmegroup.com. Following that statement is copyright protection information.

None of these materials purport to offer the CME Rulebook as additional marketing information or as a user reference for making a purchasing decision or for managing futures and options contracts. The examiner does not find such a reference in any of the marketing materials.

In the request for reconsideration of December 9, 2013, the applicant has asserted that the *Members* of the Chicago Mercantile Exchange are the consumers for the services, and that *Members* use the CME (Chicago Mercantile Exchange) Rulebook that were provided as the substitute specimens. This statement was not verified or supported by evidence, and nothing in the record provides a nexus

between the consumers described in the advertising materials, and the CME *Members* who use the CME Rulebook specimens. The CME Rulebook, Chapter 4 Rules of Enforcement, 400, General Provisions, defines the term *Members*, and explains that *Members* are deemed to know, consent to and be bound by all Exchange Rules. It is not indicative of the *Members* being the primary consumers for the applicant's futures and options contracts. While it may be that *Members* are allowed to buy and sell for their own benefit (this is not addressed in the materials provided by the applicant), the applicant's marketing materials suggest that the primary consumers for the futures and options contracts are those noted above in the marketing materials, and not the CME *Members*.

Attached find a definition of "Exchange Members," from *The Free Dictionary by Farlex, Farlex Financial Dictionary*. © 2012 Farlex, Inc. that defines EXCHANGE MEMBERS as "a person, normally a broker, who has membership on a stock exchange. This means that he/she is allowed to make trades on the floor of that exchange. Most exchanges do not allow firms to be members, so the membership for a member firm formally belongs to one or more of its employees."

The applicant's Rulebook allows for Member Firms. A MEMBER FIRM is a broker-dealer firm in which at least one of the principal officers is allowed to trade on the floor of an exchange. To become a member one needs to purchase a membership or a seat on the exchange. *The Free Dictionary by Farlex, Farlex Financial Dictionary*. © 2012 Farlex, Inc. *The American Heritage Dictionary of the English Language*, 4th Ed., ©2000 by Houghton Mifflin Co., Updated 2009, defines a "Member Firm" as "A securities firm with officers or partners who are members of an organized exchange."

The advertising materials provided by the applicant do not invite *membership* on the CME, but appear to be directed to persons and entities with hurricane exposure who may be interested in investing in the futures and options contracts to hedge against weather induced financial losses in the conduct of their businesses. The examiner has not found, and the applicant has not shown, that these two groups (those with hurricane exposure and *Members* of the CME) are the same consumers, or that *Members* are the primary or end consumers for the applicant's futures and options contracts. The definitions of "exchange members" and "member firms" indicate that the role of exchange members is that of a broker, and not that of the end consumer. It is for this reason that the applicant's specimens from the CME Rulebook, submitted December 9, 2013 in a Motion to Suspend and provided with this most recent Request for Remand on August 8, 2014 are not viewed as acceptable to show use of the mark in advertising or marketing materials or other material that shows the mark used in the actual sale, rendering or advertising of the services in a manner that the consumers for the services would encounter the mark and understand the mark to identify the source of the applicant's services. TMEP §1301.04, *et seq.*

The Examiner asserted that the chapters from its CME Rulebook, provided as substitute specimens on December 9, 2013 and again August 8, 2014, Chapters 423, 423A, 427 and 428, appear in the CME Rulebook that has, when printed, a seven to eight page *index* of chapters. This index was made available for consideration with this request for remand. The examiner characterized the material as "buried". Finding use of the mark in this information, particularly as the chapters do not appear to be referenced in the marketing materials, is tedious. It is also noted that the chapter titles do not reference CHI Futures or CHI Options, but rather: Chapter 423 CME Hurricane Index Futures, Chapter 423A Options on

CME Hurricane Index Futures, Chapter 427 CME Hurricane Index Seasonal Futures, and Chapter 428 CME Hurricane Index Seasonal Maximum Futures.

As stated previously in brief, while the proposed mark CHI appears to identify the source of the index services used for establishing the *value* of the applicant's futures and options contracts, the proposed mark does not serve to identify the source of the investment services for which the applicant seeks registration in *this* application. Again, it is noted that this mark has subsequently been registered for "Compiling, providing and updating a financial index measuring potential damage from a hurricane," U.S. Registration No. 4315763. The specimens accepted for registration of the mark for the indexing services are some of the same specimens submitted for consideration in this application.

CONCLUSION

For these reasons, and in view of the evidence, refusal to register the mark is CONTINUED and MAINTAINED as FINAL because the specimens fail to function as a service mark *for the services recited in the application*. Trademark Act Sections 1, 2, 3, and 45, 15 U.S.C. §§1051-1053, 1127.

Resumption of the Appeal

The applicant has already filed a timely notice of appeal with the Board, and briefs have been filed. The Board will be notified to resume the appeal. See TMEP §715.04(a).

Respectfully submitted,

/Linda A. Powell/

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 **CME Group**

WEATHER PRODUCTS

CME Group launched the first weather derivative contracts in 1999 to help businesses manage their exposure to temperature-based risk. Weather's overall impact on the United States Gross Domestic Product (GDP) is \$5.3 billion annually. To help manage that impact on consumers and corporations, CME Group's product slate has grown to meet customer needs by offering multiple risk management opportunities related to temperature, snowfall, frost, rainfall and hurricanes in more than 50 cities worldwide.

Weather futures and options are available for block trading, which are privately negotiated futures, options, or combination transactions. Futures contracts are also available to be traded on CME Globex, and options contracts are available via open outcry on the CME trading floor.

Benefits

- Manage weather-related price risk
- Stabilized cash flow
- Transparent prices on CME Globex-listed electronic futures products
- Opportunity to hedge risk associated with weather uncertainty
- Centralized clearing and counterparty credit guaranteed by CME Clearing

Cross-Sector Opportunities

Utilities and energy companies were the main users of our weather futures and options when CME Group first introduced weather derivatives, but the expanded product slate has captured the interest of a diverse set of market participants across several sectors:

- Energy Companies
- Local Distribution Companies (LDC)
- Construction
- Utility Companies
- Hedge Funds
- Insurance and Reinsurance Companies
- Manufacturing
- Agriculture
- Retailers
- Transportation



WEATHER PRODUCTS SLATE

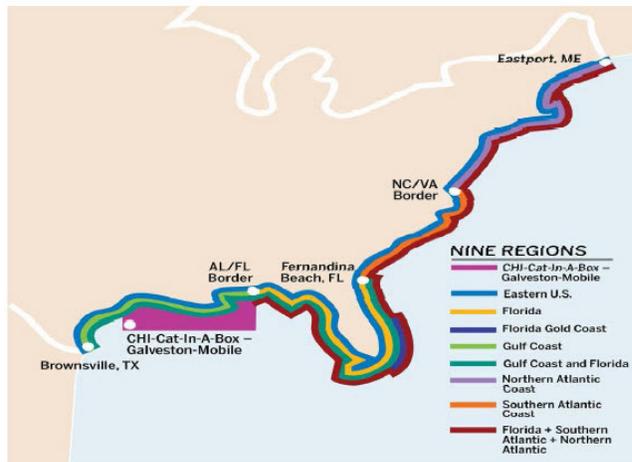
TEMPERATURE-BASED PRODUCTS

City Locations	Index Used – Winter	Index Used – Summer	Time Frames for Contracts
United States	HDD	CDD	Weekly, Monthly, Seasonal Strip: A customized season of two to seven consecutive months within the same general season – October through April for Winter, April through October for Summer
Canada	HDD	CAT, CDD	Monthly, Seasonal Strip: Same as U.S. contracts
Europe	HDD	CAT	Monthly, Seasonal Strip: Same as U.S. contracts
Asia Pacific	CAT*	CAT*	Monthly, Seasonal Strip: A customized season of two to seven consecutive months within the same general season – October through April for Winter, April through October for Summer
Australia	HDD	CDD	Monthly, Seasonal Strip: Same as U.S. contracts

HURRICANE-BASED PRODUCTS

CME OFFERS SEVERAL HURRICANE-BASED CONTRACTS TO MEET YOUR RISK MANAGEMENT NEEDS:

- Hurricane futures, options and binary options – Cover actual named hurricanes making landfall in the United States Atlantic basin
- Hurricane Seasonal futures, options and binary options – Focusing on the total number of hurricanes that occur within a specific location or geographic area between January 1 and December 31
- Hurricane Seasonal Maximum futures, options and binary options – Focusing on the largest hurricane to make landfall within a specific location or geographic region between January 1 and December 31





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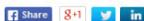
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CME to Launch Hurricane Futures and Options on Futures Contract

CME-Carvill Hurricane Index to be Available for 2007 Hurricane Season



CHICAGO and LONDON, Feb. 14 /PRNewswire/ -- CME, the world's largest and most diverse financial exchange, announced today that it will expand its weather derivatives product line with a scheduled launch of CME-Carvill Hurricane Index futures and options on futures contracts March 12. The underlying indexes will be calculated by Carvill, a leading independent reinsurance intermediary in specialty reinsurance that tracks and calculates hurricane activity. "These new CME Hurricane contracts will provide an additional way to help address the needs of the insurance industry and other markets," said Felix Carabello, CME Director of Alternative Investment Products. "Following the devastating 2005 hurricane season that caused an estimated \$79 billion in damage, it became apparent that there was limited capacity to insure customer claims. With these hurricane contracts, insurers and others will be able to transfer their risk to the capital markets and thereby increase their capacity to insure customers." In addition to insurers, other customers such as energy companies, pension funds, state governments and utility companies will be able to hedge their risk of hurricanes striking in the United States in five areas defined as the Gulf Coast, Florida, the Southern Atlantic Coast, the Northern Atlantic Coast and the Eastern U.S. "We are excited about our joint venture with CME," said John Cavanagh, Joint CEO of the Carvill Group. "CME is the clear market leader in weather derivatives and we believe this new product will offer a wider range of catastrophe solutions to our customers. The convergence of the insurance markets and the broader financial community continues at a rapid pace, and our products, particularly in the catastrophe areas, are becoming more commoditized in order to appeal to a more diverse range of capital providers. An exchange traded derivative product for catastrophic hurricane risk is a natural progression to this trend." Dr. Steve Smith, Senior Vice President of ReAdvisory, the analytical arm of Carvill said, "The challenge was to develop an index that met the needs of both the derivative trading community and the insurance market. We needed an index that is easily understood, simple to calculate and based on publicly verifiable data -- in short, an index which is transparent. Most importantly for the trading community was the requirement that the index could be calculated and settled within hours of an event taking place." Using publicly available data from the National Hurricane Center of the National Weather Service, the Carvill Hurricane Index (CHI(TM)) uses the maximum wind velocity and size (radius) of each official storm to calculate the potential for damage. The front contract expires when a hurricane makes landfall with the expiration pegged to the CHI. The contract tick size is 0.1 CHI point, which is equivalent to \$100. Hurricane futures will trade on CME Globex(R) from 5:00 p.m. to 3:15 p.m. the following day Chicago time and options on hurricane futures will be available for trading 8:30 a.m. to 3:15 p.m. Chicago time on the CME trading floor. CME currently lists weather contracts based on aggregate temperatures on 35 cities around the world as well as snowfall and frost indexes. CME introduced weather derivatives in 1999. In 2006, traded CME Weather derivatives had a notional value of \$22 billion. For more information on the hurricane contracts, please go to <http://www.CME.com/hurricane>. CME (<http://www.cme.com>) is the world's largest and most diverse financial exchange. As an international marketplace, CME brings together buyers and sellers on the CME Globex(R) electronic trading platform and on its trading floors. CME offers futures and options on futures in these product areas: interest rates, stock indexes, foreign exchange, agricultural commodities, energy, and alternative investment products such as weather, real estate and economic derivatives. CME is a wholly-owned subsidiary of Chicago Mercantile Exchange Holdings Inc. (NYSE, Nasdaq: CME), which is part of the Russell 1000(R) Index and the S&P 500(R) Index. Statements in this news release that are not historical facts are forward-looking statements. These statements are not guarantees of future performance and involve risks, uncertainties and assumptions that are difficult to predict. 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Exchange members

See: Member firm, seat

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Exchange Member

A person, normally a broker, who has membership on a stock exchange. This means that he/she is allowed to make trades on the floor of that exchange. Most exchanges do not allow firms to be members, so the membership for a member firm formally belongs to one or more of its employees. Memberships are bought and sold at market price because most exchanges have a finite number. See also: Seat.

Member Firm

A broker-dealer firm in which at least one of the principal officers is allowed to trade on the floor of an exchange. To become a member, one needs to purchase a membership or a seat on the exchange, which can be very expensive. There are usually a set number of memberships to an exchange; for example, on the New York Stock Exchange, there are 1,366 seats, which may cost up to \$1 million each, and which may be bought or sold to different firms. Most exchanges do not recognize member firms, only individual members; that is, they consider members to be the brokers or dealers on the floor, rather than the firms they represent.

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References in periodicals archive: a CME/ Chicago Board of Trade Company, is expected to transform global derivatives markets, creating operational and cost efficiencies for customers and exchange members, while delivering significant benefits to shareholders. Chicago Mercantile Exchange Holdings Inc. and Chicago Board Of Trade... by Agri Marketing. Will links to exchange members and to non-members be allowed? BB's Operational and Risk Implications by Freeman, Emily Q. / Financial Executive. dealers, exchange members and other professionals in financial institutions. VOLTERS KLUMER PURCHASES COMPLIANCE INTERNATIONAL, INC by Business Publisher. More results >>

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member firm

n A securities firm with officers or partners who are members of an organized exchange.

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